This is a digital copy of a book that was preserved for generations on library shelves before it was carefully scanned by Google as part of a project to make the world's books discoverable online.

It has survived long enough for the copyright to expire and the book to enter the public domain. A public domain book is one that was never subject to copyright or whose legal copyright term has expired. Whether a book is in the public domain may vary country to country. Public domain books are our gateways to the past, representing a wealth of history, culture and knowledge that's often difficult to discover.

Marks, notations and other marginalia present in the original volume will appear in this file - a reminder of this book's long journey from the publisher to a library and finally to you.

Usage guidelines

Google is proud to partner with libraries to digitize public domain materials and make them widely accessible. Public domain books belong to the public and we are merely their custodians. Nevertheless, this work is expensive, so in order to keep providing this resource, we have taken steps to prevent abuse by commercial parties, including placing technical restrictions on automated querying.

We also ask that you:

+ *Make non-commercial use of the files* We designed Google Book Search for use by individuals, and we request that you use these files for personal, non-commercial purposes.
+ *Refrain from automated querying* Do not send automated queries of any sort to Google's system: If you are conducting research on machine translation, optical character recognition or other areas where access to a large amount of text is helpful, please contact us. We encourage the use of public domain materials for these purposes and may be able to help.
+ *Maintain attribution* The Google "watermark" you see on each file is essential for informing people about this project and helping them find additional materials through Google Book Search. Please do not remove it.
+ *Keep it legal* Whatever your use, remember that you are responsible for ensuring that what you are doing is legal. Do not assume that just because we believe a book is in the public domain for users in the United States, that the work is also in the public domain for users in other countries. Whether a book is still in copyright varies from country to country, and we can't offer guidance on whether any specific use of any specific book is allowed. Please do not assume that a book's appearance in Google Book Search means it can be used in any manner anywhere in the world. Copyright infringement liability can be quite severe.

About Google Book Search

Google's mission is to organize the world's information and to make it universally accessible and useful. Google Book Search helps readers discover the world's books while helping authors and publishers reach new audiences. You can search through the full text of this book on the web at `http://books.google.com/`

CL
ASB
DUA

TRADE MARKS.

TRADE MARKS

THEIR REGISTRATION AND PROTECTION IN THE UNITED KINGDOM AND ABROAD

ALSO

THE MERCHANDISE MARKS ACT, 1887

BY

JOSEPH SEYMOUR SALAMAN

SOLICITOR OF THE SUPREME COURT AND PATENT AGENT

LONDON

KEGAN PAUL, TRENCH, TRÜBNER & CO. LTD.

1891

To

THE HONOURABLE MR JUSTICE ROMER

THE FOLLOWING WORK IS,

BY HIS KIND PERMISSION,

Respectfully Dedicated

BY

THE AUTHOR.

PREFACE.

For twenty years the writer of the following pages has been closely and continually engaged in the registration of Trade Marks, advising as to their registration, and their protection in Courts of Law.

In the year 1871 the writer assisted some well-known Trade Mark owners, in conjunction with the Council of the Associated Chambers of Commerce, to form an organisation, having for its main object the promotion of an Act of Parliament for the registration of Trade Marks.

For many years previously the commercial community had clamoured for such an Act, which it was supposed would serve to prevent the forgery of Trade Marks. Bills were prepared by the Chambers of Commerce, and by leading solicitors acting for large manufacturers, and were at length, in 1861, introduced into the House of Commons. These consisted of Bills dealing with the question of false marking, and for the registration of Trade Marks, and they were referred to a Select Committee, who examined many witnesses, but a resolution proposed by the late Mr Roebuck, that a "system of registration for Trade Marks be adopted," was negatived by the Committee.

The "Merchandise Marks Act, 1862," was, however, passed, but still the agitation was renewed for an Act to deal with the subject of the registration of Trade Marks.

The subject was admittedly one of very great difficulty, as will be seen from a perusal of the minutes of evidence taken before the Select Committee. There were plenty of able persons examined, consisting of manufacturers of the greatest eminence, solicitors and officials, who could point out the difficulties, and some few proposed remedies, but nothing was done.

The organisation above referred to was started in 1871, and at the request of the Council of the Associated Chambers of Commerce, the writer, as solicitor to the Association, was requested to formulate a Bill for the registration of Trade Marks.

This was prepared and settled by Mr John Cutler, of the Chancery Bar, submitted to the Council of the Associated Chambers of Commerce, and by them to the Board of Trade, in whose department the subject was being considered.

Some time in the year 1873 the Board of Trade prepared a Bill for the registration of Trade Marks, consisting of some fifty-eight sections, which was submitted to the writer, through the Council of the Associated Chambers of Commerce, and very considerable alterations and amendments were made in the Bill, and submitted to the Board of Trade.

One important principle which the writer con-

tended for was, that the registration should be *compulsory*, whereas in the Bill it was *permissive*, and that all *labels and wrappers* should be treated as Trade Marks; and there were many other objections to the measure, one of the principal ones being the imposition of *an annual fee* for renewal of the Trade Mark in the Registry, which would have been a matter of much inconvenience, annoyance, and expense.

The writer attended with a deputation of the Council of the Associated Chambers of Commerce, and submitted their united views to the Department of the Board of Trade.

The Bill never became the subject of discussion in the House of Commons, as in consequence of the lateness of the season it dropped, and the Government was soon after changed, and was succeeded by the administration of Mr Disraeli.

The Act of 1875, a short Act of ten sections, was then introduced into the House of Lords, but again there was omission of *labels and tickets* from the Definition Clause, although the Government had adopted the *compulsory* principle.

The writer again pressed his views on certain influential members who had charge of the Bill (Mr Sampson Lloyd, Mr Whitwell, and Mr Monk), and notwithstanding that time was again of the utmost importance, these gentlemen succeeded in introducing amendments, which were of the most useful description, including the addition of *labels*

and *tickets*, to the Definition Clause, thus introducing upon the Register many thousands of Trade Marks which would otherwise have been excluded.

When the Act was passed, it was decided by the organisation above mentioned that the experience which had been gained of the Trade Mark question should be applied to another purpose, namely, that of assisting subscribers and others to register their marks under the new Act.

The writer under this system assisted in registering some *ten thousand* marks, in all trades, and for some of the most important firms and traders in the United Kingdom, besides registering *many thousands* in America, the Australian Colonies, and every country in Europe where a system of registration then existed.

He has also been concerned in contesting a large number of opposed registrations, involving important points which soon arose under the 1875 Act, and cases of infringement of Trade Marks.

A hundred of these cases have been conducted successfully by the writer for many of the most important manufacturers, brewers, wine and spirit, soap, tobacco, and general merchants and traders. In the Table of Cases he has marked in italics the cases which the writer has himself conducted. In the Sheffield trade, the writer assisted in registering nearly nine-tenths of the Sheffield marks on the Register, within the first few years of the passing of the Act.

The writer thinks he may therefore, without

presumption, lay claim to some special knowledge of the subject upon which he has ventured to treat in the following pages. He has no intention to write a law book for lawyers, that work having been successfully accomplished by Mr Sebastian in his most exhaustive treatise, and it may safely be said that no better work has ever emanated from any text writer.

The writer has only aimed to make a very difficult subject, and one which grows in importance every year, interesting to the commercial community, and to aid them, it may be, in obtaining proper and valid registration of their marks, and in understanding the right principles upon which alone the Court will give them effective protection against unlawful imitation and infringement of their just rights.

J. SEYMOUR SALAMAN.

65 AND 66 CHANCERY LANE,
1891.

CONTENTS.

CHAPTER I.

PAGE

WHAT IS A TRADE MARK? 1

Antiquity of subject—Aldine Classics—King of Saxony's Marks—Sheffield Marks—French definition—American definitions—"Merchandise Marks Act, 1862"—"Merchandise Marks Act, 1887"—"Patents, Designs, and Trade Marks Acts, 1883-88"—Name of individual—Invented word—Descriptive or Geographical—Added matter—Disclaimer.

CHAPTER II.

NATURE OF TRADE MARKS CAPABLE OF REGISTRATION . 6

Marks as defined by the Act of 1888—Name printed in a distinctive manner—Autograph—Device—Mark—Heading—Label—Definition of new Mark—Label containing special devices—Use of word "Trade Mark"—The "Apollinaris" case—Colour—*Re* Worthington—*Ex parte* Bass—Sir George Jessel's judgment—Court of Appeal—Colour important in infringement cases—Ticket—Invented words—"Æilyton"—Words essential to certain trades—Fancy word—Descriptive words—Geographical—The "Valvoline" case—Sir George Jessel's judgment—The "Satinine" case—Mr Justice Kay's judgment—The "Glenfield" Starch case—Lord Westbury's judgment—Things not registerable—"Blakey and Latham"—The "Dome" Black Lead case.

CHAPTER III.

REGISTRATION OF TRADE MARKS 32

Duration of registration—Foreign registration—Necessity of registration—Acts of 1875, 1883, 1888—Sir George Jessel's decisions—Procedure—Appeal to Board of Trade—Series of

PAGE

Marks—Trade Marks assignable with good will—Trade Marks identical—Calculated to deceive—"Fruit Salt" case—Common device—Disclaimer—Essential particulars—Common to the trade—"Three Mark Rule"—Registration equivalent to public user—Hudson's case—Prior adoption—Rectification of Register—Spencer's case—Person aggrieved—Hyde's case—Match label—Clerical errors—Word "Registered."

CHAPTER IV.

OPPOSITION TO REGISTRATION 57

Notice of opposition—Form of same—Counter statement—Evidence—Statutory declarations—Appeal to Board of Trade—Practice—Reference to the Court—Abandonment of opposition—"Gem" Air-gun case.

CHAPTER V.

INFRINGEMENT OF A TRADE MARK 64

Remedies—Action for deceit—Chancery remedy—Criminal remedy—"Merchandise Marks Act, 1887"—Fraudulent intention—Lord Cranworth's definition of the principle—American definitions—Lord Kingsdown's definition—Early English case; 22 Elizabeth—Interlocutory injunction—Delay to be avoided—Acquiescence—Plaintiff's knowledge of defendant's acts—Notice to defendant—The "Two Elephants" case—The "Osman" Turkish Towel case—Lord Langdale's definition—"Tovril" and "Bovril" case—Rodgers and Rottgen—Actual deception—Lord Cranworth's definition—"Dog's Head" Beer—Ford's "Eureka" Shirts—Name "*publici juris*"—Lord Justice Mellish's definition—"Worcestershire Sauce," "Reading Sauce," "Harvey's Sauce," "Yorkshire Relish."

CHAPTER VI.

CONSEQUENTIAL RELIEF 84

Account of profits—Damages—Costs—*Leather Cloth Company* v. *Hirschfeld*—American cases—*Lever* v. *Goodwin*—"Sunlight" Soap Wrapper case—Practical suggestions—Costs—Notice to infringer—Advertisement of injunction.

CHAPTER VII.

PAGE

MATTERS AFFECTING THE RIGHT TO SUE 92

Invalidity of plaintiff's Mark—Behrens and Whittaker, Manchester cotton marks—Dunn's Trade Mark—Eno's "Fruit Salt"—The "Dry Monopole" case—Heidsick's Marks—Mr Justice Kay's judgment—Spencer's case—"Diamond Cast Steel," false representation in mark—Use of the word "Patent," Cheavin and Walker's filter case—Sir G. Jessel's judgment—Tobacco trade—Foreign label on British or German goods—American case—*Wood* v. *Lambert*—*Newman* v. *Pinto*.

CHAPTER VIII.

DEFENCES 108

As to the amount of imitation—"Eyesight" cases—Is the plaintiff's Trade Mark valid?—When name has become *publici juris*—Acquiescence—*Fullwood* v. *Fullwood*—User by defendant of same mark—*Oakey* v. *Dalton*, "Wellington" Knife Polish—"Hole-and-Corner" user, defendant putting his own name on Trade Mark—"Sunlight" Soap Wrapper case—Trade Mark not used as registered—The "Guinea Gold" tobacco case—Milachrino and Milachrino.

CHAPTER IX.

CASES OF IMITATION OF MODE OF PUTTING UP GOODS . . 116

American cases—"Angostura" Bitters case—"Sunlight" Soap Wrapper—*Lever* v. *Goodwin*—Mr Justice Chitty's judgment—Court of Appeal—American decisions—French decisions.

CHAPTER X.

FRAUDULENT USE OF A NAME BY A PERSON OF SAME NAME . 127

Burgess v. *Burgess*—*Holloway* v. *Holloway*—*Levy* v. *Walker*—Circumstances of fraud—Freeman's Baking Powder—Mr Justice North's judgment—Warner's Safe Cure—Evidence of fraudulent acts—*Turton* v. *Turton*—*Hendricks* v. *Montague*—*Tussaud* v. *Tussaud*.

PAGE

CHAPTER XI.

NAME BECOME "PUBLICI JURIS" 140

Applies to patented articles—"Home Washer"—Wheeler and Wilson's case—The "Singer" cases—The "Linoleum" case—Lord Justice Mellish, test of name becoming *publici juris*—"Taylor's Patent Solid-Headed Pins"—Practical suggestions.

CHAPTER XII.

SHEFFIELD MARKS 149

Cutlers Company Marks—Mode of registering.

CHAPTER XIII.

"THE MERCHANDISE MARKS ACT, 1887" 152

Intent to defraud—*Onus* on defendant—"Yorkshire Relish" case—Forgery of Trade Marks defined—Falsely applying—Sellers of goods with forged Trade Mark—Punishment—Artificer's saving clause.

CHAPTER XIV.

THE BOTTLE QUESTION 160

Using other person's bottles—*Burgess* v. *Wood*—Question settled—Prosecution by proprietor of "Yorkshire Relish."

CHAPTER XV.

REGISTRATION AND PROTECTION OF BRITISH TRADE MARKS ABROAD 165

Foreign Treaties—The International Convention of 1883-4—The "Monobrut" case—France, Roederer's case—Germany, decision on English cases—America—Holland—Spain—Portugal—Austria—Italy—Russia—Sweden—Norway—Switzerland—Brazil—Turkey—Denmark—Australian Colonies—Australian decisions—Non-European countries—Venezuela—India—Hong Kong—Canada—Japan—General summary.

TABLE OF CASES CITED.

	PAGE
Abbot *v.* Bakers and Confectioners' Tea Association	122
American Cloth Company	67
Apollinaris Company's Case	50
Arbenz, Re	62
Australian Wine Importers	40
Barlow *v.* Johnson	72
Behrens v. *Whittaker*	49
Boord, Re	55
Burgess *v.* Burgess	127
Californian Fig Syrup Company's Trade Mark	168
Cheavin v. *Walker*	99
Christiansen's Trade Mark	52
Cook *v.* Stärkweather	124
Croft *v.* Day	73
Dixon Crucible Company *v.* Guggenheim	81
Dunn's Trade Mark	40
Ellis and Ruthin Soda Water Company	115
Eno *v.* Davis	191
Eno v. *Stephens*	94
Eno *v.* Hogg	190
Ford *v.* Forster	77
Freeman v. *Freeman*	129
Fullwood *v.* Fullwood	111
Gillott *v.* Esterbrook	178
Goodall v. *Hutchins*	80
Graham *v.* Plate	85
Hendricks *v.* Montague	137
Holloway *v.* Holloway	128
Hostetter *v.* Vowinkle	85
Hudson, *Re*	45
Hyde, Re	52
Jelley, Son & Jones, Re	35
Kuhn, Re	41
Lea *v.* Wolf	123
Leather Cloth Company *v.* Hirschfield	84

PAGE

Leonardt, Re 41
Lever v. *Goodwin* 74
Linoleum Manufacturing Company *v.* Nairn . . 142
Lorin *v.* Palmer 101
Melachrino *v.* Melachrino 115
Newman *v.* Pinto 104
Oakey *v.* Dalton 111
Orr-Ewing *v.* Johnston 71
Palmer, *Re* Bryant & May 97
Perry Davis—Pain-Killer 48
Phillips and Ogden 114
Richards *v.* Butcher 48
Riviere, *Re* 50
Rodgers *v.* Rottgen 74
Seixo *v.* Provezende 76
Siegert *v.* Findlater 112
Singer Company *v.* Wilson 109
Singer Company *v.* Loog 141
Southern *v.* Howe 68
Spencer's Trade Mark 96
Steinway v. *Henshaw* 74
Taylor & Company's Patent Solid-headed Pins . . 147
Turton *v.* Turton 134
Tussaud *v.* Tussaud 139
Vignier, *Re* 168
Warner *v.* Warner 131
Wheeler *v.* Wilson 141
Wood *v.* Burgess 162
Wood *v.* Lambert 103
Worthington's Trade Mark, Re 14
Wotherspoon *v.* Currie 112

TRADE MARKS.

CHAPTER I.

WHAT IS A TRADE MARK?

TRADE MARKS, considered as symbols of authenticity, are of very ancient origin. *Seals* were no doubt used in this way as distinguishing marks of ownership, and are even now an essential part of a deed. *Signboards* upon taverns, the *water-mark* upon paper, and the devices used upon ancient pottery, are so many distinguishing Trade Marks denoting origin.

An early instance of the use of a Trade Mark, which is well known to bibliophiles, and denotes to the practised eye the presence of a classical treasure, consisting of the dolphin wound round an anchor, is affixed to the early editions of the *Aldine* Classics. **Aldine Classics.**

It appears from a notice affixed to the edition of *Alder's* Livy, published in 1518, that even in those early days a case of colourable infringement of a Trade Mark was perpetrated, very similar to those which constantly occur in these days.

In the preface to the book may be found the following:—"Lastly, I must draw the attention of

the student to the fact that some Florentine printers, seeing that they could not equal our diligence in correcting and printing, have resorted to their usual artifices. To Alder's 'Institutiones Grammaticæ,' printed in their offices, they have affixed our well-known sign of the dolphin wound round the anchor. But they have so arranged it, that any person who is in the least acquainted with the books of our production cannot fail to observe that this is an impudent fraud; for the head of the dolphin is turned to the left, whereas that of ours is well known to be turned to the right."

This would not be a safe way of calling attention to an act of similar piracy in these days!

Many others of the early printers or booksellers, in place of putting their names on the title-pages of their books, adopted a certain mark or sign; and hence a knowledge of these marks is of use in distinguishing different editions of works.

Some of the marks for which registration was claimed in England are of ancient date, one for which registration was claimed—that of Kopke's port wines—dating as far back as 1638.

The King of Saxony's marks date from the year 1733, and the largest number of marks for which very old use is claimed are Sheffield marks, of which the oldest are those of George Wostenholm & Sons, Limited, dating from 1694, Messrs Joseph Rodgers & Sons, Limited, from 1764, and many others between 1694 and 1777.

The groceries of Messrs Farquarson of Aberdeen carry a label bearing the date of 1694. Many of the tobacco labels are also of very great antiquity.

A Trade Mark has been defined in many ways, and by many writers upon the subject. The best and simplest definition is that of a German writer on Trade Marks—Klostermann:—"By Trade Marks are understood those marks which are applied to manufactures brought into the market as proceeding from the original producer or dealer."

German definition.

The French law defines a Trade Mark to be the characteristic sign by means of which commerce distinguishes the product of one's manufacture as the object of commerce.

French definition.

Mr Coddington, in his comprehensive book on American Trade Mark Law, defines a Trade Mark to be "a name, symbol, figure, letter, form, or device, adopted and used, by a manufacturer or merchant, to designate the goods he manufactures or sells, and to distinguish them from the goods of another."

Coddington on Trade Marks, definition.

Another learned American author on Trade Marks, Mr Upton, has defined a Trade Mark as the name, symbol, figure, letter, form, or device, adopted and used, by a manufacturer or merchant, in order to designate the goods that he manufactures or sells, and to distinguish them from those manufactured or sold by another; to the end, that they may be known in the trade as his, and thus enable him to secure such profits as result from an established reputation for superior skill, industry, or enterprise, which sign, label, symbol, or words others have not an equal right to employ for the same purpose.

Upton on Trade Marks, definition.

The first parliamentary definition of a Trade Mark is to be found in the "Merchandise Marks Act, 1862," wherein a Trade Mark is defined to

The "Merchandise Marks Act, 1862," definition.

include any name, signature, word, letter, device, emblem, figure, sign, seal, sketch, diagram, label, ticket, or other mark lawfully used by any person to denote any chattel, or (in Scotland) any article of trade, manufacture, or merchandise, to be an article or thing of the manufacture, workmanship, or production, or merchandise of such person, or to be an article or thing of any peculiar or particular description, made or sold by such person.

"Merchandise Marks Act, 1887," definition.

The "Merchandise Marks Act, 1862," is repealed by the "Merchandise Marks Act, 1887," and by that Act a Trade Mark is defined to mean a Trade Mark *registered in the Register of Trade Marks kept under the "Patents Design and Trade Marks Act,* 1883," and the following is the last definition of a Trade Mark which is protected by law in England under the Consolidation Act of 1888.

"Patent Designs and Trade Marks Act, 1883-1888," definition.

A Trade Mark must consist of, or contain, at least one of the following essential particulars:—

Name of individual.

A *name* of an individual or firm, *printed*, *impressed*, or *woven* in some particular and distinctive manner.

A written signature, or copy of a written signature, of the individual or firm applying for registration thereof as a Trade Mark.

A *distinctive* device, mark, brand, heading, label, or ticket.

Invented word.

An invented word or invented words, or

Word not descriptive or geographical.

A word or words having no reference to the *character* or *quality* of the goods, and not being a *geographical* name.

Added matter.

There may be added to any one or more of the *essential* particulars mentioned in this section any letters, words, or figures, or combination of letters,

words, or figures, or any of them; but the applicant is required to state in his application the *essential* particulars of the Trade Mark, and must *disclaim* in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer is entered on the Register.

Disclaimer.

Then there follow two provisions, the effect of which will be explained later on, and are very important to be understood by applicants for registration.

Name not to be disclaimed.

A person is not to disclaim his own name, or the foreign equivalent of it, or his place of business; but no entry of any such name affects the right of any owner of the same name to use it, or the foreign equivalent of it.

Saving of special or distinctive words.

Then follows the proviso saving the rights of persons who have used any *special* or *distinctive* word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a Trade Mark, before the 13th August 1875, to be allowed to register the same as a Trade Mark.

CHAPTER II.

NATURE OF TRADE MARKS CAPABLE OF REGISTRATION.

PERHAPS the most important question which affects a Trade Mark owner desiring to protect his Trade Mark is as to the nature of the Trade Mark he is using, or intends to use—in other words, what is capable of being registered; and as the mark, or proposed mark, if a new mark (that is to say, one which has not been used before the 13th August 1875, the date of the passing of the "Trade Marks Registration Act, 1875"), must fall within one or other of the descriptions as defined by the 10th section of the Consolidation Act of 1888, it is proposed to explain the nature of each of the things of which the Trade Mark must consist to obtain registration.

Marks as defined by the Act of 1888. Name of individual.

Name of an Individual or Firm.—It is evident that the mere name of an individual, or of a firm, cannot be admitted to registration as a Trade Mark, because a monopoly would be thereby granted to the owner of a particular name, to the exclusion of all other persons of the same name.

There are some manufacturers or dealers whose names are so well known in connection with a particular manufacture, or as general merchants, that it almost appears as if they ought of right to monopolise the name, and so in fact they do without registration. For instance, "Joseph Rodgers

& Sons," in connection with cutlery; "J. & R. Morley," as regards hosiery; and as a general dealer, who has not heard of "Wm. Whitely"? But suppose a man's name to be "Smith" or "Jones," whose manufacture or wares may be equally celebrated; it is clear that there may be other persons of the same name, who may have a perfect right to manufacture and sell the same class or description of goods, and no monopoly by registration could be granted to any particular "Smith" or "Jones."

Name must be printed, &c., in distinctive manner.

So that the last Registration Act provides that no name of an individual or firm can be registered, unless *printed, impressed,* or *woven* in some particular and *distinctive* manner—that is to say, placed on the goods themselves or the wrapper, or other covering in which the goods are enclosed, or impressed on steel or iron goods, or woven into textile fabrics, in such a manner that the name becomes in fact a *device,* or a *mark* or a *brand.*

It is thus seen that it is not the name by its sound which is protected, but the name in the form of a device. The law affords other protection to the owner of a name when used by another person of the same name fraudulently, and this subject will be commented upon hereafter.

Autograph signature.

Written Signature.—This is, of course, a good Trade Mark, consisting as it does of the *autograph signature* of the applicant for registration, but it will be found in practice unwise to trust entirely to the use of a signature, except in conjunction with some other essential characteristic of a Trade Mark, as part of a label, or on a wrapper, or accompanying a device.

Distinctive device. *Distinctive Device, Mark, Brand, Heading, Label, or Ticket.*—The first three are of the same nature, the third, "*brand*," is only the mode in which a "device" or "mark" is placed upon the goods, namely, by "branding," or burning the Trade Mark upon casks and other woodwork with hot iron. "*Device*" and "*Mark*" appear to be very much of the same nature, and include all symbols or emblems, however unmeaning in themselves, such as representations of animals, birds, fishes, or in fact anything in nature, or art, or imagination, which is not in use by any other person, and may serve to distinguish the goods of the person using the device or mark from similar goods of another person, and whether used by a trader who selects or deals in, certain goods not of his own manufacture.

"Mark." The word "*Mark*" includes some of the Trade Marks used as Sheffield Corporate Marks, which may not be strictly called devices.

Heading. *Heading* is a technical expression known to the Manchester trade, and is the term given to the bordering at the end of each piece of goods, composed of threads of different colours, placed more or less at wider spaces from each other.

It is surprising that in a few cases which have been decided since the Act of 1875 was passed, the word "heading" has been suggested as signifying something quite different—in one case, a word at the head of a label; but it is quite clear that the expression is used in the different acts in the technical sense above referred to. The proper meaning was given to the word in a case before the passing of the "Trade Marks Registration Act, 1875."*

* Harter *v.* Souvozolue, W. N., 175, p. 11.

This kind of Trade Mark, from its very nature, cannot be represented in the *Trade Marks Journal*, and, therefore, it is deposited at the Patent Office, and may be inspected there, like other Cotton Marks, of which there is a large collection, occupying many volumes.

Label.

Label.—A very numerous class of traders use labels, more or less distinctive—that is to say, some are distinguished by the use of different colours, some by the peculiarity of their design, and others appear to consist principally of the name of the article, of the manufacturer, and of letterpress descriptive of the article and directions for use. A great number of labels and wrappers have been registered since the passing of the first Registration Act in 1875, and under the Act of 1883, but the framers of the Act of 1888 must have become aware that a great number of labels and wrappers had been admitted to registration which contained no proper elements of a distinguishing Trade Mark; consequently the applicant for registration must now state in his application the *essential* particulars of his Trade Mark, and must disclaim any right to the exclusive use of added matter, which he is still allowed to place upon his label or wrapper, consisting of letters, words, or figures, or combinations of the same, or any of them.

A copy of the statement and disclaimer is entered in the Register, and it thus becomes of the greatest importance that the applicant should be properly advised what he should claim, and what he should disclaim. In regard to a complicated label or wrapper, which may comprise all the different characteristics of a Trade Mark combined, the

greatest care should be used, seeing that the papers filed by the applicant are open to public inspection, and advantage may be taken by an unscrupulous trader of an improper or unwise application and disclaimer; it may also seriously affect the application, when contested before the Comptroller.

Definition of a "New Mark."

These remarks, of course, apply to application for registration of labels and wrappers not used before the passing of the Act of 1875 (the 13th August 1875), which, as before observed, are technically called *New Marks.* With regard to labels and wrappers which were previously used, protection is still afforded to any *special* and *distinctive* word or words, letter, figures, or combination of letters or figures (numerals), or of letters and figures used as a Trade Mark before the 13th August 1875.

Label containing special device.

A practical remark may also be made here with regard to the registration of a label of a certain design, which contains an emblem or device, to which the Trade Mark owner attaches particular value, and which is quite distinctive of his goods. Such persons have been accustomed to draw attention to the particular device by applying to it the words "Trade Mark," thus implying an intent to lay claim to the particular portion of the combined label as the "Trade Mark," although attaching equal value to the whole label. This circumstance has given rise to colourable imitations of the label, although registered, merely changing the emblem or device. Trade Mark owners will be properly advised to register not only the label or wrapper as a whole, but each component part of it separately, although, of course, difficulties may arise as to

whether the device has been, in the case of an old mark, used separately on the goods as a Trade Mark.

A still more important consideration arises with reference to the use of the words "Trade Mark," attached to a particular portion of a registered label, and which was illustrated with great force by the Court of Appeal in the *Apollinaris* case, a Trade Mark having been removed from the Register, on account of the use of the words "Trade Mark" against a portion of a label.

Use of words "Trade Mark" to a portion of a label.

The circumstances of the case were of a peculiar and complicated nature, and it would be impossible to say how far the judgment of the Court was influenced as to this particular point by the other facts of the case; but the decision should nevertheless be taken into serious account by all new and old Trade Mark owners with reference to proposed registrations, and as to those already on the Register bearing this latent defect.

It may be useful to show how the question arose in this case.

"The Apollinaris Case."

The *Apollinaris* Company registered in 1885, in Class 44, as a new mark (*i.e.*, not used before 13th August 1875), for use on bottles of Friedrichshall Water, a large and laudatory label, containing a red disc in the centre, under which was printed the words "Trade Mark."

A motion had been made by a rival company, the *Vichy* Company, to remove this mark from the Register, which Mr Justice Kekewick had declined to do; on appeal the order was reversed, and the mark taken off the Register.

Lord Justice Fry delivered the judgment of the

Court upon the whole of the appeals, of which there were ten, the result of a long litigation between the contending companies. As to this particular appeal, his Lordship said:—"With regard to the Mark number 45,096, several objections were raised by the Attorney General. One was that the mark was calculated to mislead, inasmuch as the whole label is registered as a Trade Mark, and yet contains the assertion that the red disc, the most conspicuous part of the whole label, is the 'Trade Mark,' an assertion leading to the conclusion that it, and it alone, is the Trade Mark, and therefore that the label, as a whole, is not. An owner of a registered Trade Mark may put it on a registered label, but not so as to mislead a reader of the label, and induce him to believe that the only thing registered is the distinctive mark."

As before observed, the circumstances of this case doubtless influenced the Court of Appeal, for there can be no question that no intention to deceive, or mislead, can be attributed to some of the most important firms in the United Kingdom, who have done exactly the same thing, namely, put the words "Trade Mark" against a particular device, forming a portion of a combined label.

The explanation is simple. These firms, before the passing of the first Trade Mark Registration Act, the Act of 1875, had used a distinctive device, symbol, or emblem, as a Trade Mark. These may, or may not, have formed a portion of a label, but it was the device, symbol, or emblem which was considered of importance, so that attention was called to it by affixing the words "Trade Mark" to this essential feature of the label, which in other

respects might be very similar in shape or design to any other label in use for the same trade. When it became necessary to register every label which had been in use before the 13th of August 1875, these labels were sent in for registration still bearing the words "Trade Mark" to a particular feature of the label, but in this there was no intention to deceive or mislead anyone. The only danger which was then foreseen was that danger to which attention is called at the opening remark on this subject, that some designing person might try to register a somewhat similar label, but with an entirely different special feature, and this was in fact done in many cases.

Persons were well advised to register every essential feature, if used separately.

Colour.

Colour.—Whilst discussing the question of a combined label, printed in one or more different colours, other than black and white, it becomes of the greatest importance to understand what can be claimed with regard to colour, and what value is attached to it by the Act of Registration.

The last Registration Act of 1888 provides that a Trade Mark may be registered in any colour (or colours), and that registration, subject to the provisions of the Act, confers on the registered owner the exclusive right to use the same in that or any other colour (or colours). No mention was made of colour under the previous Act of 1875, and as the representation of the Trade Mark appeared in the official journal (the *Trade Marks Journal*), simply in black and white, whilst the application papers comprised a representation of the label or wrapper as actually used, it became a question what importance the

Court, in an infringement case founded on an imitation of the label or wrapper, would attach to such alleged imitation, if produced in totally different colours.

The first case of great importance arose on a contested registration, under the Act of 1875, in which a firm of brewers applied to register a skeleton triangle enclosing a representation of a church, and this of course appeared in the official journal in black and white.* Messrs Bass & Co. opposed the registration of this device on the ground that the Trade Mark consisted of a triangle, and although the opponents' triangle was used as an opaque red triangle, the applicants' might at some time or other be coloured red and the church being obscured, it might lead to deception and confusion. The late Master of the Rolls, Sir George Jessel, before whom the case first came, took this view, and registration was refused.

Sir Geo. Jessel's judgment.

Sir G. Jessell commenced his judgment as follows:—"Probably there is no one on the Bench or at the Bar, who is more familiar with Trade Marks than I am, and I am sorry to say that my experience as regards the efforts of traders to obtain as new marks well-known established marks, belonging to well-known and highly respected businesses, is, that they are anything but creditable to the great number of traders who make those attempts. At first I thought there might be some want of invention on the part of the owners of businesses who required new marks, but the attempts are so constant and so similar, that the conviction has forced itself

upon my mind, rather reluctantly, that there is a general desire on the part of new traders, or of persons requiring new marks, to run as near as the law will allow them to the old marks. . . . Colour is not protected by the Act. These gentlemen (the defendants), therefore, may colour their triangle red, which, of course, will have the effect of obscuring the church. That being so, would it be calculated to deceive? I have no doubt or hesitation in saying that I entirely agree with the gentlemen who swore it would."

The applicants appealed to the Court of Appeal, when the Lords Justices confirmed the decision of the Master of the Rolls, and a great deal of learning was displayed by the learned counsel who appeared in the case.*

Judgment of Court of Appeal.

Lord Justice James said:—"Now the proposed Trade Mark of Messrs Worthington, no doubt, as it stands in black and white, seems to be very substantially different from that of Messrs Bass & Co. But then I think we must look at this, that the Trade Marks Acts say nothing about the colour, and the appellants (Worthington) might use exactly the same colour upon their Trade Mark which Messrs Bass have used upon theirs; that is to say, each of the marks might be a mass of red, on one of which masses of red there would be a design of a church, of what colour I do not know. It might be red of the same shade, or a different red; but there might be a mass of red with a design on it which would be, with that difference, the same as Bass's triangle, a mass of red. . . . I cannot help thinking that the

* Mr (Now Mr Justice) Chitty for Messrs Bass & Co., and Sir Horace Davy for the applicants.

same kind of thing would happen as to this device, we are told happened as to the signature of the great Lord Protector of this country, that the *Oliver* was getting to be written very large, and the *Cromwell* was getting to be written very small, so that the *Cromwell* was disappearing in the *quasi* regal *Oliver.*"

Lord Justices Brett and Cotton gave judgment to the same effect, and for the same reasons, entering very minutely into the question; but Lord Justice Cotton expressed himself with great doubt as to the correctness of the decision.

From a careful perusal of several cases which afterwards arose, in which the question of colour was discussed, up to the passing of the Act of 1883, it would appear that considerable difficulty was experienced in regard to the registration of labels of distinctive colour being admitted to registration. But no such difficulty can now be experienced, as the applicant is not bound to any particular colour which he may be using when he registers, and no person can possibly allege that he has a right to use the applicant's mark by simply changing the colour or colours.

Colour important in infringement cases.

In piracy cases, colour becomes a most important element; and when the same colours are used to a similar design, the question of a fraudulent intent is greatly strengthened, and there can be no doubt that if a design is not materially altered, but the colours are the same, such imitation of colour is an important ingredient as denoting an intent to deceive.

As a learned American writer * observes on this

* Brown on Trade Marks, 1873.

question, but written before the first English Registration Act was passed, "If by simply changing the hue one man could take the same sign as his rival in trade, there would not be much safety; the sign, which was originally black, might by exposure to the atmosphere become black or grey, and a blue might darken into a black."

Ticket.

Ticket.—The same remarks apply to a ticket which applies to labels, and perhaps greater difficulty must arise as to deciding what is a distinctive ticket, which, as a rule, is a square or oblong paper mark, and contains very few elements or characteristics of a Trade Mark. Great care will therefore be required in applying for registration of a ticket, bearing in mind the fact of the applicant having to state the essential particulars, and his disclaimer of that which is not essential, and may be common words. Many tickets would, under these conditions, consist simply of a square or oblong piece of cardboard or paper.

Invented words.

An invented word or invented words, or a word or words having no reference to the character or quality of the goods, and not being a geographical name.—Of all the difficult questions which have arisen since the registration of Trade Marks was sanctioned by an Act of Parliament, none have perhaps given rise to so much litigation, trouble, expense, and annoyance as those which arose under the Trade Marks Registration Act of 1883, which for the first time enabled Trade Mark owners to register a word, or words, as a Trade Mark.

Under the Act of 1875 it was not possible to register as a new mark (*i.e.*, introduced since 13th August 1875) a word or words simply, without the

addition of any other matter, such as a label, or a device, or an autograph signature, or the like.

Soon after the passing of the "Trade Marks Registration Act, 1875," namely, in 1876, Mr H. C. Stephens ("Stephens' Inks") applied for registration of the word "Aeilyton," printed in capital letters, which he had stated was used by him as a distinctive device for certain particular inks manufactured by him. This was refused, on the ground that it was not a Trade Mark within the meaning of the definition clause, and the question came before Sir George Jessel on motion. Mr Chitty, Q.C., in support of the motion, stated the combination of letters was a "device" within the meaning of the section, and he stated the word "Excelsior" had long been used as a Trade Mark for the "Excelsior Soap," and quoted Longfellow, who had called the word a "device":—

> "The shades of night were falling fast,
> As through an Alpine village passed
> A youth, who bore, 'mid snow and ice,
> A banner with the strange device—
> Excelsior!"

The Master of the Rolls did not appear to recognise the eloquent poet as an authority on Trade Marks, as he observed: "I think the device there was the emblem, which made the youth go higher and higher." His Lordship refused to consider the combination of letters anything more than a word, which could not be registered as a new Trade Mark.

If a word or words formed a portion of a composite Trade Mark, even although used for the first time, it became a question whether such word or

words were protected if taken by another trader as a portion of a differently-constructed label, or with a different device or signature. For certain trades, however, a word or words would appear to be about the best Trade Mark that a person could adopt, and, if a properly selected word, was always protected by the Court before any Act was passed for the registration of marks.

For the trade of a tobacconist, or a vendor of patent medicines, or a soap manufacturer, a word or words constituted the very best Trade Mark; such as "Myrtle Grove," "Infant Plant," "Three Castles," and the like, apart from the design of the wrapper enclosing the tobacco designated by the title. What, for another instance, could be a better Trade Mark than "Sunlight" for soap, which has become a word of world-wide celebrity? For the purpose of advertising nothing could be better than a word. Yet for some years after the passing of the first Registration Act, the commercial community were without this convenient and useful mode of distinguishing their goods; and for some time after the passing of the Act of 1875 it was a question whether a perfectly novel and valid word, or words of the like nature, could be added to a label or wrapper, without the risk that some other person could adopt such word or words added to a label or wrapper of a different description.

Patents, &c., 1883. "Fancy word."

At length the Patent Designs and Trade Marks Act, 1883, was passed, and it was provided that, in addition to a distinctive device, mark, brand, heading, label, or ticket, should be added "*a fancy word or words not in common use.*" Then it became a question what this sentence meant. There being

no comma after fancy word, did the words at the beginning of the definition "a distinctive" only refer to "fancy word," or did "fancy" refer to "words not in common use"?

Another most material point arose was, as to whether "words in common use" meant words in common use in the English, or any other language, or words not in common use as regards the class or description of goods, upon which the proposed Trade Mark was intended to be used.

It may be readily understood, that a considerable crop of litigation at once arose, and the minds of the ablest men at the bar, and on the bench, were exercised to elucidate these puzzling questions. Unfortunately, a good many persons had been allowed to register a word or words, which they were led to believe were valid Trade Marks, and after using the same for considerable periods, spending doubtless large sums of money, in divers ways, to gain a reputation for their goods, had ultimately to defend the Trade Mark in one Court and another, at great expense, with the ultimate result, that the Trade Mark Register was ordered to be rectified by the omission of the so-called Trade Mark.

Descriptive words—geographical.

Many of these words were taken off the Register because they were decided to be descriptive—such as "*Electric*" for velvet, "*Alpine*" for embroidery, "*Gem*" for an air-gun. Others were decided to be invalid on account of their defect as geographical words, such as "*Melrose*" for a hair restorer, and a great many others.

This state of things continued for a few more years, until the Act of 1888 was passed, and a new

definition was decided upon, which it is hoped will now settle the question; although, as will be presently mentioned, some of the decisions upon the old section will be still useful, in the event of questions arising as to the meaning of the new *form* of words.

An Invented Word or Invented Words.—This can only mean a newly coined word or newly coined words, letters put together in a manner which have never previously been so arranged (such as "Aeilyton"), so as to form a new word or words, not to be found in any dictionary; but here again it may be understood that such word or words must be

Invented word.

"*A Word or Words having no reference to the character or quality of the goods, and not being a Geographical Name.*" This is the second clause of the new definition which it is necessary fully to consider.

Word must not have reference to character or quality of goods, or geographical.

Long before the passing of any Trade Mark Registration Act in this country, it was always a question with reference to a Trade Mark, consisting of a word, in an action for an injunction to restrain the use of a similar word, whether such word was what is called a *descriptive* word, or a *geographical* name. There are many early decisions as to words such as "*Excelsior*" for soap, "*Pessendede*" (Turkish for warranted) for watches, "*Anatolia*" for liquorice. Each of these words were at that time decided to be lawful Trade Marks. Of later days, and since the passing of the Trade Marks Registration Act of 1875, there have been a numerous list of decisions, and perhaps the "*Valvoline*" case before Sir G. Jessel (*re* Horsburgh) explains better than any other case, what is the original meaning of

The "Valvoline" case.

the word descriptive, as applied to a Trade Mark, because it is Latin for valve oil, and other persons dealing in such an article must not be prevented from so doing, by granting a monopoly, or the exclusive use of it, to another. As Sir G. Jessel said: "A man who sells valve oil cannot have a right to prevent other people using the word 'Valve,' because that is common property to all the world; and it would give him the advantage of representing, that he was the only seller of valve oil, if he could so exclude other people from selling it;" and again: "It is only one act of many instances which I have seen, in which tradesmen endeavour by making an epithet, adjective, or description of some kind or other, a portion of their Trade Mark, to prevent their brother tradesmen selling goods under that same well-known description."

Sir G. Jessel's judgment.

This word "Valvoline" falls particularly within the restrictive words above set forth, because it is a word "having reference to the character of the goods" on which it was intended to be used.

The question as to whether a word has reference to the character or quality of the goods, will still be an extremely difficult one, because of the conflicting decisions which are to be found in the books. If the writer may venture to express an opinion, it appears to be difficult to see why a word should be deemed descriptive, because being composed of different elements, some indirect meaning may possibly be gathered as to the character, or ultimate use, or nature of the goods. "*Valvoline*" doubtless is a bad Trade Mark, so would be "*Satinine*" for starch, but it appears difficult to see how any other person can be injured by the use of some of the

words which have recently been decided to be descriptive.

With regard to "Satinine," a case recently decided by Mr Justice Kay (since Lord Justice Kay), Meyerstein, carrying on business in starch and soap, applied in 1886 to register "Satinine" in Class 47, containing soap and laundry preparations, and in Class 48, which contains perfumed soap. It was contended that "Satinine" was an invented word.

It was refused by the Comptroller; appealed to the Board of Trade, and referred to the Court; and it had to be held over pending the further legislation on Trade Marks, and came on to be heard after the passing of the Act of 1888.

Mr Justice Kay's judgment.

Mr Justice Kay said: "This is a word which describes the quality of the goods, and there is marvellously little invention in the matter, because the only invention is putting at the end of a common word 'Satin,' which brings to every man's mind in a moment the notion of a glossy surface, the common conclusion 'ine,' which you will find in 'saline,' 'saccharine,' and half a hundred other English words. Certainly if that is inventing a word, it is the easiest mode of invention that you can possibly conceive. . . . This word 'Satinine' is a word descriptive of a glossy surface. Now it is to be applied, amongst other things, to starch and blue, and things of that kind used by washerwomen. Every one knows that the effect of the use of starch is, that goods which are washed and starched, and then ironed or calendered, have a much more glossy surface than the same articles would have if they were ironed or calendered without being starched; that is common experience. We all know that, and

it would be a recommendation of starch that it should produce a more glossy surface than other starch. If you speak of starch, or describe starch by a name which suggests to the mind at once the production of a glossy surface, you are using a descriptive word."

There appears to be no doubt that a common word in the English or any other language is a good Trade Mark, if it is used fancifully, that is to say, has no reference to the quality or character of the goods, and is not geographical.

This was so under the definition clause of the Act of 1883, and the new definition clause as to an invented word, and so forth, is not understood as making any difference in the practice in this respect.

In the case of *Van Duzer*, having reference to the word "Melrose," decided to be geographical and not a valid mark, Lord Justice Lopes distinctly stated that all geographical names were not to be excluded from the category of fancy words. Nor was any word to be found in a dictionary to be *ipso facto* disqualified. Lord Justice Lindley said that necessarily all geographical names were not to be excluded, and he instanced a name which no Englishman had ever heard of, such as "Penj Deh." It conveys no meaning to an Englishman, and such a geographical name might be a fair and proper fancy word.

This decision was followed by Mr Justice Kay, in a case in which he decided that a certain name used to designate Manilla cigars ("*Cavite*") having been used before the 13th August 1875, and not in common use, was a "special and distinctive" word,

Compagnia General v. Rehder.

although it was contended it was the name of a district.

The Act of 1888 was however passed since these cases were decided, and probably with regard to a new mark, great care will be requisite before appropriating a word or words as a Trade Mark, to ascertain whether they would fall within the ordinary meaning of the word "geographical," and it may still be necessary to refer to former cases, such as the *Glenfield Starch* case, when it may be required to take the name of a manufactory or an estate, although such name may be found in a glossary.

The "Glenfield" Starch Case.

The famous *Glenfield Starch* case was first decided by V.-C. Malins in 1870, whose decision was reversed by the Court of Appeal, consisting of Lord Justice James; and the House of Lords, in 1872, reinstated the decision of V.-C. Malins, the Lords being Lord Chancellor Hatherley, Lord Chelmsford, and Lord Westbury.

The case appears to comprise some of the first principles relating to the use of geographical names, although doubtless the judges were much impressed by the nature of the case, shewing an evident fraudulent intention on the part of the defendants, to reap the benefit of the great reputation acquired by the plaintiffs. It will doubtless, notwithstanding the recent Act excluding geographical names from registration, be often referred to, in support of the right of a manufacturer to claim the exclusive use of the name of his own manufactory, even when such name may be found in a glossary. It has been deemed useful to quote a few of the expressions of opinion in such a case, made by the eminent Law Lords who ultimately decided the case.

The circumstances were these:—Wotherspoon, in 1847, purchased from Fulton & Co. their business and works at Glenfield, which were well known starch works, together with the name "Glenfield's Patent Double Refined Powder Starch." Wotherspoon continued for some time to manufacture starch at the works at Glenfield, but afterwards removed his manufactory to Manwelton, near Paisley, and such works had ever since been known as the "Glenfield Starch Works." The starch was made up into packets bearing the above words.

The defendant, John Currie, who kept a shop in Paisley, and had been a workman of Messrs Fulton, at Glenfield, in 1869, commenced to make starch, enclosed in similar paper packets of the same colour as the plaintiff's, and with similar coloured labels, bearing the words "Royal Paris Starch, Currie & Co., Starch Manufacturers, Glenfield," the word "Glenfield" being printed in large and conspicuous letters, and it was sold by retail dealers as "Glenfield Starch." The defendant had hired of Messrs Fulton a small building belonging to them at Glenfield, at a rent of £12 a year, with a view to commence the manufacture of starch, but only two or three hands were employed there, and the plaintiff alleged, the sole object of the defendant was to give colour to the use of the word "Glenfield" on the defendant's labels.

Glenfield was neither a town, a hamlet, nor a village, nor had it a post office, but it was merely a field, in which two or three manufactories were situate, and about fifty persons were residing there.

Counsel on behalf of the defendant contended,

that no person can acquire a monopoly in the name of a place, so as to prevent any other person, who is *bona fide* carrying on his business at that place, from putting the name of the place on his goods.

V.-C. Malins' judgment.

V.-C. Malins decided that notwithstanding the defendant manufactured his starch at Glenfield, he was not entitled to use that name, so as to avail himself of the reputation of the plaintiff.

Lord Justice James reverses judgment.

The defendant appealed, and Lord Justice James dissolved the injunction which had been granted, and in the course of his judgment he said: "Glenfield, although it is not a place as big as London, Glasgow, or Paisley, or not even a post town or a market town, a village, or a place which has an actual existence as the site of some manufactory, is yet a place consisting of some few houses, and it is a place which was known as the original place at which the plaintiff's starch was manufactured." . . . His Lordship then stated what the defendant had done, and proceeded—"They have a right to establish themselves at Glenfield"—and the rest of his judgment is based upon the assumption, the defendant had a right to do what he did, and no deception would follow.

House of Lords reverses Lord Justice James decision.

The plaintiff appealed to the House of Lords, who reinstated the judgment of V.-C. Malins. Lord Hatherley commences with a few observations which are of great practical value, with reference to a common mode of putting up goods. "Packets of needles," his Lordship says, "are often done up in much the same way as the packets of starch in this case were, viz., in dark blue paper with a green label. In a case of that description which came before me, I took occasion to remark, that when

there is so much similarity, it does become more necessary to take care that the mark which is to distinguish the article shall be really distinguishing, and that, when you have got all the other combinations, so that persons do not look at the shape of the packet, or at any other *indicia* than the particular distinguishing mark" [in this case the name of the manufactory or the fancy name of the article], "those things should, by people who wish to deal honestly by each other, be kept very distinct."

Lord Hatherley then showed that it was the name "Glenfield" which attracted people to the starch, who had never heard of the name of the maker, and that the defendant had taken the name in order to pass off his goods as the plaintiff's.

Lord Westbury's judgment.

Lord Westbury's judgment was to the effect that long antecedently to the operations of the defendant, the word "Glenfield" had acquired a secondary signification, or meaning, in connection with a particular manufacture, in that it had become the trade denomination of the starch made by the plaintiff. It was wholly taken out of its original meaning, and in connection with starch, had acquired that peculiar secondary signification to which he referred.

There is no doubt the principles laid down in this case will still guide Courts in coming to a decision as to the use of a geographical name, when the circumstances are the same, notwithstanding the Act of 1888.

Pictorial representation of article not registerable.

Things not Registerable as Trade Marks.—A pictorial representation of the article upon which it is proposed to place a Trade Mark cannot be registered. There is no case which has been decided in

England, which has so decided, but such is the practice at the Patent Office.

Blakey's case. Representation of sole of boot as a Trade Mark.

In the case of *Blakey & Latham*, before Mr Justice Chitty, the plaintiff, the manufacturer of boot protectors, had used in his trade, cards, upon which was a representation of a sole of a boot or shoe, with representations of the boot protectors placed upon different portions of the sole of the boot or shoe, as they would be placed in use, and he had registered this as a Trade Mark. Exception being taken by the defendant, who had imitated this Trade Mark, that it was a representation of the article itself, Mr Justice Chitty decided against the objection, and upheld the registration, but admitted that the representation of the article itself could not be registered as a Trade Mark.

A case of considerable importance on this subject was the case of *James & Parry*, before Mr Justice Pearson (in 1886), and afterwards before the Court of Appeal.

The "Dome" Black Lead case — James & Parry.

The plaintiff, some years before, designed a new shape for black lead blocks, namely, a short cylinder, rounded, or "domed," at one end. The name of "dome," or "dome-shaped," was applied to black lead of the plaintiffs' manufacture, and they registered the shape as a design in 1861, under an Act then in force, which had since been repealed.

In 1877 they registered the Trade Mark which was the subject of the action. It consisted simply of a representation in black of the shape in which their article was made up.

The action was brought to restrain the defendant from infringing the plaintiffs' Trade Mark. The defendant moved to have the plaintiffs' Trade Mark

removed from the Register of Trade Marks, on the ground that it was not the proper subject of a Trade Mark.

Mr Justice Pearson held that a pictorial representation of the actual article to which a Trade Mark is applied, is not a proper subject of a Trade Mark, and he said the plaintiffs' mark must be removed from the Register.

The Court of Appeal reversed the decision. Lord Justice Cotton said that Mr Justice Pearson had treated the case as an attempt to register a picture of the article which was sold. But it was not really that. It was true that the plaintiffs sold their black lead in the shape of a dome, but they impressed the mark on the article as their Trade Mark. Lord Justice Lopes said that the "dome" was a distinctive mark, if the plaintiffs sold the article in the shape of a square. Why was it the less a distinctive mark because the article was sold in the shape of a dome?

It is very difficult exactly to understand the true principles upon which their Lordships decided this case, so that at present there cannot be said to be any decision against the principle, and it would be unsafe to rely upon a distinct representation of the article as a Trade Mark.

A Trade Mark must be actually applied to a vendible article in the market, so that you cannot have a Trade Mark to denote a particular mode of carrying goods by railway, or to denote the work of a printer, and the like.

The well-known Trade Mark, universally known by all railway travellers to denote Messrs Taylor's Depositary and their carrying department, was

registered for waggons in which the firm dealt, and they were allowed to register the representation of a locomotive and waggon attached.

When the Trade Mark Act of 1875 was passed, many persons were desirous of registering a representation of their goods as packed in a peculiar way, as Trade Marks, but these were all disallowed, and properly so. It was supposed that by so doing, the peculiar mode of packing would be protected. But this is not the object of Trade Mark registration. If such mode of packing is distinctive of a particular person's goods, there are other means of protecting it against an infringement, which will be considered later on.

CHAPTER III.

REGISTRATION OF TRADE MARKS.

Registration compulsory.

REGISTRATION in England is *compulsory*, that is to say, no person can sue for infringement of a Trade Mark, or take proceedings under the Merchandise Marks Act, 1887, unless the Trade Mark has been registered under the Trade Marks Registration Act of 1875, or some later Act.

Registration endures for fourteen years from the date of application, and can be renewed at the expiration of such period, on notice and payment of certain renewal fees.

The Merchandise Marks Act of 1887 defines a Trade Mark in respect of which proceedings can be adopted under that Act, to mean a Trade Mark registered under the Patents, Designs, and Trade Marks Act, 1883, and persons who have registered under the 1875 Act will be considered to have rights which can be enforced under the Merchandise Marks Act, as the same register is continued. It is supposed that Trade Marks registered under the 1888 Act will also be protected under the Criminal Act, as it will be the same Register as is kept under the 1883 Act.

With regard to the necessity of registration in England, it may be here mentioned, that in most foreign countries it is a condition precedent, that

the Trade Mark should have been registered in England, and a certificate of such registration has to be forwarded to the authorities. The Conventions which exist between England and many foreign countries, recognise in those countries the same Trade Marks, which are protected in the country of origin, but it must be shown that they are so recognised, and there is no better proof than a certificate of registration, until the Trade Mark is removed from the Register, when it is apprehended the foreign registration also loses its validity.

The practice as to the registration of Trade Marks, and the general principles which regulate it, have varied very little under the different Acts of 1875, 1883, and 1888, and the function of the Comptroller (in the Act of 1875 called "The Registrar") are the same; and it has been settled by several decisions, that his functions are discretionary with respect to the registration of a Trade Mark on the first application, subject to an appeal to the Board of Trade, who may refer the appeal to the Court.

The same principle holds good, whether the Comptroller refuses to register upon some ground which appears to him to be a proper one, or whether the application has been opposed by some other party, having been accepted and placed in the official journal.

When the Act of 1875 came into operation, numerous questions arose as to principle and *procedure*, there being nothing in the whole range of English law and practice which bore in the slightest degree any analogy to the registration of

a Trade Mark. The Act, consisting as it did of only ten sections, followed by rules, had to be construed, and certain main principles settled. One of the first questions was as to the classes and description of goods, seeing that all old marks had to be brought in, and many were known to be identical in certain trades, or very similar to each other.

Some of the classes were very comprehensive,—for instance, the hardware class, and the food class (42), including an immense variety of articles; so that it became necessary for the owner of a Trade Mark to be careful to state in his application, the particular description of goods upon which he had used his mark, and this gave rise to a great deal of trouble in many instances.

The case was different with regard to a new mark (not used before 13th August 1875), since a person who was about to adopt a new mark could take the whole class.

As will be seen from some of the cases which have come before the Courts, persons have suffered from a faulty registration, and after being on the Register for many years, have been taken off, and incurred considerable expense by the process.

Reference is here particularly made to the *Braided Fixed Star* case (Bryant & May) and the *Diamond Cast Steel* case (Spencer's case), *Edwards & Dennis*, and many others.

A great many of these difficult points were brought before Sir G. Jessel, the late Master of the Rolls, and were settled by that most eminent Judge, in a decisive fashion, and also as to the mode of procedure in bringing some of these matters before the Court.

Gradually, and in course of time, all these difficult matters were dealt with, and by other Judges, and the Court of Appeal, under the subsequent Acts of 1883 and 1888, until it may now be said that there are few points which can arise in regard to Trade Mark law and practice which have not been dealt with by authority. Those questions which have not been so dealt with are, however, of great importance, and the writer has ventured to refer to a few of them in the following pages.

To exemplify one instance, the case of *Jelley, Son & Jones* was a very apt illustration. It was decided by Sir George Jessel two years after the Act of 1875 came into operation.

Jelley, Son & Jones were ironmongers, dealing in a multifarious class of similar goods, and they applied to register the design of a dog eating out of a porridge-pot. This was shown in the case to be a very old sign and Trade Mark, connected with the applicant's premises in the Blackfriars Road. They wanted the mark in Class 5 for fencing wire; in Class 12, as a new mark for a large number of articles, such as files, edge-tools, and other things; and in Class 13, as an old mark for a number of other things.

They were opposed by J. & Riley Carr of Sheffield, who had registered a device of a pointer dog with the word "Staunch" in Class 5, in Class 12 for cutlery and edged tools, and in Class 13, in respect of metal goods not included in other classes.

The applicants had used their device for twenty-five years, in respect of the goods for which they required to register it in Class 13, but had not applied it to goods comprised in Class 12.

The Master of the Rolls allowed the applicants to register in Class 13, because it was an old mark, and there was no question, both parties were entitled to register, and his Lordship again promulgated the rule he had already laid down in other cases, called the "Three Mark Rule."

With regard to Class 5, Sir G. Jessel allowed registration for fencing wire only, but would not allow the mark to be registered as a new mark in the other class, because it was too similar to the opponent's mark.

His Lordship said: "If a man wants a new mark for his own goods, he must invent something for himself, and not adopt a mark which comes so near other peoples' marks that it may deceive. . . . I must say what I always say in these cases, if you want a new mark to distinguish your goods, the best thing for you to do is to invent a very distinct mark. . . . I have always had regard in these cases of registrations of new marks, to the question of *distinctiveness;* that is a very different question to the question of distinction as regards old marks, because a man who wants to sell new goods, which he has not sold before, ought to want to distinguish his goods from those of other manufacturers; and therefore if a man is an honest man, the more distinctive the mark, the better it must be for himself."

Application for registration.

PROCEDURE TO OBTAIN REGISTRATION.—In the first place, the applicant having decided upon a Trade Mark which he desires to register, has to make *application* in a form set forth in the Schedule to the Act.

The application must be accompanied by a

representation of the mark, and the applicant must state the particular goods, or classes of goods, in connection with which he desires the Trade Mark to be registered.

Statement of goods.

In the case of an old mark, great care is still requisite as to the statement of the goods, and some of the most difficult points, in many cases entirely imperilling the validity of the Trade Mark, have arisen with regard to the selection of the goods.

In Lamplough's *Pyretic Saline* case, it may be that the Court was impressed by the fact, that the applicant had stated the goods upon which he intended to use the words, as "Pyretic Saline," and the words were deemed descriptive.

In the *Linoleum* case,* which will be presently referred to in dealing with the question of names not protected after a patent has expired, Mr J. Fry, who decided the case, was evidently much impressed by the same fact, that the applicant had called the goods "Linoleum" on which he used the label or ticket, which was registered, bearing the same word.

Hearing before Comptroller.

As before observed, if the Comptroller refuses registration, which takes place after the applicant has had an opportunity of being heard before the Comptroller, the applicant can *appeal to the Board of Trade*, who may decline to hear the appeal, and at once refer the applicant to the Court.

Series of Trade Marks.

A *series* of Trade Marks may be registered, which resemble each other in the material particulars, but differ as to the statement of the goods, numbers, price, quality, or names of places.

These may be registered by one registration, and

* See chap. xi.

are assignable, and transmissible as a whole, but protection is given to each Trade Mark separately.

Certificate of registration for foreign countries.

Difficulty has been experienced in this mode of registration, when the applicant requires a certificate of registration for foreign countries, in which the authorities would not accept a certificate of the whole, as a registration of each portion, so that if the applicant has any intention of registering abroad where this difficulty may arise, he would probably be advised to register each mark *separately*.

When the Comptroller has accepted the mark, it may be after one or more hearings, it will be advertised in the *Trade Marks Journal*, and then arises the practice as to opposition, by any person who may object to the Trade Mark, the practice respecting which will be separately explained.*

Trade Mark assignable only with good-will.

A Trade Mark, when registered, *is assignable only in connection with the good-will of the business* concerned in the particular goods, or classes of goods, for which it has been registered, and is determinable with such good-will.

It appears probable, seeing that the Registration Acts have been in force for fifteen years, most old marks have been registered, although a few old marks appear to be still applied for. It may be useful, therefore, to call attention to a few pro-

* The writer cannot help expressing an opinion, that when the Trade Mark has been accepted by the Comptroller, and advertised in the *Trade Marks Journal*, this should be considered as a final acceptance on the part of the authorities, all matters with regard to the Act, and the rules having been complied with, and the applicant having gone to the expense of blocks, and so forth, should be relieved of all further annoyance and expense, except opposition be raised by the public.

visions, which evidently have reference to old marks.

Trade Marks claimed by several old Trade Mark owners.

The Comptroller may refuse to register the same Trade Marks, claimed by *several persons*, until the Court has determined as to their rights, and he may himself submit, or require the claimants to submit, their rights to the Court.

Trade Mark identical with one registered not to be registered.

Except where the Court has so determined, that two or more persons are entitled to be registered as proprietors of the same Trade Mark, the Comptroller must not register in respect of the *same goods*, or *description of goods*, a Trade Mark identical with one already on the Register, with respect to the same goods, or description of goods.

Or having resemblance calculated to deceive.

And in the same case, the Comptroller cannot register with respect to the same goods, or description of goods, a Trade Mark, having *such resemblance* to a Trade Mark already on the Register, with reference to such goods, or description of goods, as to be calculated to deceive.

Words calculated to deceive.

Another provision which has given rise to a great deal of difficulty, and which has been the subject of some important decisions, is one which prohibits the registration as part of, or in combination with, a Trade Mark, any words, the exclusive use of which would, by reason of their being calculated to deceive, or otherwise, be deemed disentitled to protection in a Court of justice, or any scandalous design.

Sir G. Jessel's construction of similar clause in 1875 Act.

Sir G. Jessel (*re Horsburgh*) said, with regard to similar words in the Act of 1875: "It is not competition between two Trade Marks which is referred to; it means a thing deceptive in itself, representing the goods to be what they are not for the purpose

of deception. Such are not to be registered at all."

Mr Justice Kay's construction of clause in Australian Wine Importers case.

Mr Justice Kay, however, in another and more recent case since the passing of the Act of 1888 (*Australian Wine Importers*), construed the words in that Act, which are very similar to the same section as the former Acts, to have reference to resemblance between the marks, or portions of them, in fact to mean the same thing as the preceding clause which has been referred to.

The Court of Appeal confirmed the decision of Mr Justice Kay, refusing registration of the mark in question, but based the decision on Section 72, Lord Justice Cotton stating that Section 73 did not apply to the present case, "that this section is with reference to an objection to certain words, part of a Trade Mark, which the section says shall not be registered as part of a Trade Mark, if they are words which would, by reason of their being calculated to deceive, be deemed disentitled to protection in a Court of justice. That applies to a case where there is some misrepresentation in particular words of the Trade Mark, or some other matter which is scandalous, or some words which of themselves are not entitled to the protection of the Court."

Eno's Fruit Salt case, *re* Dunn.

In the more recent case of *re Dunn*, in which Mr Eno opposed a Trade Mark which comprised the words "*Fruit Salt*" Baking Powder, the learned Judges of the Court of Appeal, Cotton, Lindley, and Fry, L.J.J., again differed as to whether the section in question (Section 73) had reference to resemblance of marks or to inherent defects in the marks themselves, so that at present it appears doubtful which view is the correct one.

The Comptroller is empowered to enter on the Register as an addition to any Trade Mark used before the 13th August 1875, any distinctive device, mark, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, or figures, though the same is common to the trade in the goods with respect to which the application is made.

Common devices, &c., used before 13th August 1875.

If the Trade Mark has not been used before the 13th August 1875, any *distinctive* word, or combination of words, common to the trade, can be added to the Trade Mark; but in this case the applicant must disclaim any right to the exclusive use of the same, and a copy of the *disclaimer* is entered on the Register.

Disclaimer if not used before 13th August 1875, as to words, &c.

This carries out by legislative enactment a practice which was originally initiated by the late Master of the Rolls (Jessel) in several cases which arose under the Act of 1875. In *re Leonardt* (*Birmingham Steel Pens*) the Register was rectified on the application of the applicant, by ordering a disclaimer to be entered on the Register, of elements in certain steel pen labels which were proved to be common to the trade.

A similar order was made in regard to steel pen labels used by the well-known firm of Carl Kuhn & Co. (*Brandauer Pens*), and in Mitchell's case, and has since been followed by other Judges on similar applications in regard to other trades.

It has already been stated, that an applicant must now state in his application, the *essential particulars* of the Trade Mark, and must *disclaim* any right to added matter, and it has been pointed out how important it is, that the applicant should understand what it is he claims, and what he disclaims.

Essential particulars.

In a recent case, after a registered owner had relied upon certain words which he was led to believe designated his goods, and had threatened other manufacturers, it was discovered that he had disclaimed the use of the very words upon which he relied.

"Common to the trade."

With regard to the definition of the expression, "*Common to the trade,*" it is provided, that if more than *three persons* have, before the 13th August 1875, publicly used on the same, or similar description of goods, the same device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words, or figures, they are to be deemed common to the trade.

The "Three Mark Rule."

This enactment confirms what is called the "*Three Mark Rule,*" laid down by Sir Geo. Jessel, soon after the 1875 Act came into operation. It was found that many persons had been using the same or similar marks in the same trade, and when each of them applied to register, it was necessary to adjudicate as to their respective rights. It was, therefore, decided that *three* persons could register the same, or similar marks, if proof of user before the 13th August 1875 could be made, but if *four* had been using the same mark, it was decided to be common to the trade. The user must have been a substantial user, and known to the others. *A foreign user* is not sufficient.

This difficulty, which was so easily disposed of by Sir George Jessel, with regard to the steel pen trade, was in fact one of those which doubtless delayed Trade Mark registration for so many years. In the Manchester trade alone, there were hundreds, and perhaps thousands of Trade Marks, some com-

posed of devices simply, and some of combination marks, more or less identical or similar, which had been used concurrently for years by bleachers, merchants, manufacturers, and shippers, — some with the knowledge of each other, some probably without such knowledge, but the difficulty of proof in either case would have been very great.*

It was found, indeed, after the Act of 1875 had been in operation for some time, that the difficulties could not be got over without special rules being passed, the outcome of which was the establishment of the Manchester Committee of Experts, who had to decide from an exhibition of the "devices, marks, headings, labels, tickets, letters, words, or figures, or combination of letters, words, or figures, used in the cotton trade," which were common marks, and which were special marks, entitled to registration.

The difficulties spoken of must have been very great, and the duties of the Committee, composed of some of the first merchants and manufacturers in Manchester, very onerous, seeing that their labours were not terminated until 1883.

The same state of things was soon seen to exist in the needle trade of Redditch in particular. A private organisation dealt with this trade, which of course was not so extensive as the Manchester trade.

* The writer was deputed to visit Manchester for the purpose of judging of the difficulties surrounding the question. He has seen at some large manufacturers and merchants many books thicker than post-offices directories, and as large as ledgers, filled with thousands of marks and labels, so that he can well appreciate the labours of the Committee and the kind of duties they had to perform.

Registration equivalent to public use.

REGISTRATION EQUIVALENT TO PUBLIC USER.—It is conceived that these words comprise one of the principal objects of registry, and tend more to convey an impression of the usefulness of the Acts for the registration of Trade Marks, in all of which this section appears, than any other portion of their contents.

The Registration Act of 1875 practically compelled all persons whose Trade Marks were of the slightest value, to register their existing marks, and as a necessary consequence, all persons who intend to adopt a new mark would at once do so. It is well known, however, that one of the principal difficulties which attended the question of registration of Trade Marks, and also as to the protection which was afforded by courts of law and equity, was what is called "lawful user." Frequently has a court of equity in the olden times compelled a plaintiff suing for infringement of his Trade Mark to establish his right and title to the mark in a court of law before granting him relief in equity; and in all cases he was bound to prove a certain period of user as a condition precedent to obtaining an injunction. At common law, the Trade Mark to become legal and to vest an exclusive right in the person adopting it, must have been so long in use as to be known and recognised in the market. There was no property in a Trade Mark *per se*. One could not adopt a Trade Mark to-day, and successfully sue for its infringement to-morrow.

These circumstances necessarily caused great inconvenience and expense, which the Registration Acts were passed to obviate. Under its provisions a person may invent or design a Trade Mark within

the words of the Acts, register it, and at once obtain a good title to it, supposing it to be a good and valid Trade Mark. Registry is notice to the world, and supplies the place of long user at common law for this purpose.

Explained in Hudson's case.

Doubts have been expressed in several cases as to the meaning of these words, "registration is deemed to be equivalent to public user;" but these doubts have been set at rest by the case *re Hudson;* and as Mr Sebastian observes in the third edition of his Treatise on Trade Marks, "by claiming to be the proprietor, nothing more is meant than claiming to be the first to adopt, whether there has been any user or not."

Lord Justice Cotton's judgment.

Lord Justice Cotton's observations in *Hudson's* case places the matter in a very clear light. His Lordship says: "Is a man to be considered as entitled to the exclusive use of any Trade Mark where he has never used it at all? That is a difficulty; but then, I think, the meaning is this: If a man has designed and first printed, or proposed or framed, any of those particular and distinctive devices which are referred to in the first part of Section 10," [His Lordship was referring to the definition clause of the Act of 1875,] "he is then looked upon as the proprietor of that which is under that Act a Trade Mark, and this will give him the right as soon as he registers it. How can it be said he is entitled to the exclusive use of it, when he never has used it? In my opinion, though the language is not appropriate, it means this: that a man who designs—no one else having used it—one of these special things pointed out in Section 10, as designer he is to be considered as

the proprietor of it; and if there is no one else who has used it, or who can be interfered with by the registration and subsequent assertion of title to that mark, then he is to be considered as entitled, within the meaning of the Act, to the exclusive use of that which, in fact, has never been in any way used, but which has been only designed by him, and which he can be treated as the person entitled to register (if no one has so used it, or that his use would be interfered with by registration), so that no one else can say, 'Although you pretend to have designed this, in fact, as you well know, it was my design, which you took from me.'"

From this clear exposition of the law may also be gathered the view, which was evidently in the mind of the learned President of the Appeal Court, that a person cannot register as a new mark something which has already been used by another person in the same trade. This is a question which has often arisen in practice: whether any rights are obtained by registration of a Trade Mark which is not previously on the Register, but which it can be proved has been in use, and known to the trade, to denote the goods of some other person, who has not registered a Trade Mark.

A Trade Mark which has been previously used by another cannot be registered.

The question may arise in infringement cases, and also by means of an opposition, or by a motion to rectify the Register; and it does not appear that there has, up to the present, been any decision on the question, or any reference to it, except the observations of Lord Justice Cotton in *Hudson's* case.

It may be observed that under the Act of 1875, the practice was to require a statutory declaration from the applicant, verifying his statement on

application, and by which the applicant had to declare that he was lawfully entitled to the use of the Trade Mark for which he applied, so that there was some safeguard against the case of a man applying for the registration of a Trade Mark which he knew had been previously used by some person in the same trade. At a later date the declarations were dispensed with altogether. Strange as it may seem, cases have been known where persons have created a good trade in an article for a considerable time without registering the Trade Mark which identified it. Their attention has been called to their neglect by seeing the same label or device in the *Trade Marks Journal* applied for by some rival trader.

Registration dates from application.

It should be understood that *application for registration* is deemed equivalent to public use, and if registration is granted, the date of registration is carried back to the date of application.

American practice.

The question as to priority of adoption is thoroughly well understood in America,* and is fought out there in the Patent Office, under a procedure which is known as *Interference*, which is defined to be "an interlocutory proceeding for the purpose of determining which of two or more persons, each or either of whom claim to be the first adopter of a Trade Mark, really did first adopt it."

The question here would doubtless be raised by an *opposition*, lodged when the application appears in the *Trade Marks Journal*. It is unfortunate, however, as will be noticed when the practice under opposition is next treated, that no process exists for

* Brown on Trade Marks.

the *cross-examination* of witnesses, as is the custom in all contested cases depending upon the evidencc of the parties.

Registration *prima facie* evidence. After five years' conclusive evidence of right. Not conclusive in certain cases.

Registration of a person as proprietor of a Trade Mark is *prima facie* evidence of his right to the exclusive use of it. After the expiration of five years from the date of registration, it is *conclusive* evidence of his right to the mark.

This provision has been the subject of several decisions, and it is now well settled law, that notwithstanding a Trade Mark has been on the Register for five years it can be called in question, and removed from the Register for divers reasons.

Inherent defects in Trade Marks.

Firstly, For inherent defects in the Trade Mark itself. The words "*Braided Fixed Stars,*" registered for matches, were expunged from the Register on the ground that at the date of the registration, and ever since, they had been merely descriptive of matches, prepared in a particular way. (In *re Palmer, Bryant & May.*)

There are numerous other defects which cause a Trade Mark to be taken off the Register, as will be shown further on, namely, when it was not used by itself as a Trade Mark, but always with something else.

"Diamond Cast Steel"—Spencer's case.

The words "*Diamond Cast Steel,*" registered in 1876, were taken off many years after, in *Spencer's* case.

"Dry Monopole"—Heidseck's case.

The words "*Dry Monopole*" and "*Monopole*" were taken off the Register, in *Richards* v. *Butcher,* after many years' use.

"Fruit Salt"—Eno's case. Pain-Killer.

The words "*Fruit Salt,*" in like manner, were taken off; and the words "*Pain-killer*" in *Perry Davis'* case, although he had well maintained the words in America.

Secondly, If the Trade Mark, was common to the trade in the goods in respect of which it was registered, at the time it was registered (*re Wragg*), and this was followed by Mr Justice Kay in the case of *Behrens and Whittaker*, and other cases.

Common to the trade.

Several marks were taken off the Register at an early stage after the passing of the Act of 1875, but these were so ordered to be taken off, during the first period of five years, when registration was only *prima facie* evidence of the right of the registered proprietor to his mark.

Re Hyde's Mark common to the trade.

Thirdly, If the Trade Mark was not properly on the Register, that is, if it had been fraudulently placed on the Register, by an agent, as against his principal, or analogous cases.

Not properly on the Register.

RECTIFICATION OF THE REGISTER.—It has been seen that registration of a person as first proprietor of a Trade Mark is *prima facie* evidence of his right to it, and after the expiration of five years he is supposed to have an exclusive right.

It has been pointed out that this immunity from disturbance, and indefeasible position, is only illusory, for the registered proprietor is liable to be disturbed at any time, both before and after the expiration of five years, from any of the causes referred to and specified in the preceding paragraphs.

Both before and after the five years have expired, the Court may therefore, on the application of any person aggrieved by the omission, without sufficient cause, of the name of any person, or of any particulars from the Register, or by any entry made without sufficient cause, make an order for making, expunging, or varying the entry.

Marks taken off the Register before and after five years.

The first question which necessarily arises is, Who

is a person aggrieved under the Act? so as to be enabled to take proceedings to rectify the Register. The question has been considered in several cases, and more particularly in regard to an allegation that a mark which is on the Register should not be there. In one case it was said that any person interested in the same trade as the registered proprietor, is a person aggrieved.

"Person aggrieved."

The best definition of a person aggrieved was given by Lord Justice Fry, in *re Riviere*, that "any person aggrieved, means every person who will in reasonable probability suffer any injury or loss, using those words in a legal and not in a sentimental sense, from the other persons claiming to use it."

Since the above was written, a very important case has been decided before the Court of Appeal (in *re The Apollinaris Company's Trade Marks*), the judgment being delivered by Lord Justice Fry.

One of the questions to be decided was, whether the appellants, the Vichy Water Company, who had moved to rectify the Register, by taking therefrom certain marks of The Apollinaris Company, were persons aggrieved, and Lord Justice Fry said: "The words 'aggrieved person' appear to us to have been introduced into the statute to prevent the action of common informers, or persons interfering from merely sentimental motives. But they must not be read so as to make evidence of general or serious damage, a consideration precedent to the right to apply to remove a mark. We are of opinion, that whenever one trader, by means of his wrongly registered Trade Mark, narrows the area of business open to his rivals, and thereby either immediately excludes, or with reasonable probability will in the

future exclude, a rival from a portion of that trade into which he desires to enter, then that rival is an aggrieved person. Again, if the effect produced, or likely to be produced, by the wrongful Trade Mark, is not the exclusion, but the hampering of a rival trader, that rival trader is, in our opinion, aggrieved. A man who is in the same trade as the one who has wrongfully registered a Trade Mark, and who still desires to deal in the article in question, is *prima facie* an aggrieved person. This may be rebutted by showing, that by reason of some circumstances, entirely independent of the Trade Mark, the person complaining never could carry on any trade in the article. But the burthen of tendering such proof is on the man who claims the mark, and here that burthen has not been discharged.

"It is impossible to say how much of the difficulty under which the Vichy Company have laboured has been due to the Trade Marks, and how much to other circumstances. The Vichy Company are, in our opinion, persons aggrieved."

Person who has action brought against him.

Doubtless the common case of a person aggrieved by an improper registration, is that of one who has proceedings brought against him by the registered proprietor of a Trade Mark for infringement, and it can be proved by the defendant, that the Trade Mark should never have been registered, on account of it being descriptive, or any other of the causes above referred to, which render the registration invalid. It should be here mentioned, that the proper course for a defendant to adopt in a case of this kind, is to move to rectify the Register, as well as defend himself from the proceedings, because it may be, that if the Mark has been on the Register for five years, he

may not be able adequately to defend himself from the charge of infringement. The Trade Mark may have been a common mark open to the trade when registered, or be perfectly invalid on other grounds, but he may not be able to plead this defence to the action.

Hyde's case—"Bank of England Wax."

A case arose soon after the passing of the Trade Marks Registration Act, 1875, and was decided by Sir G. Jessel, where a Trade Mark was taken off the Register on the ground that it was a common mark when registered. Messrs Hyde, the well-known sealing-wax manufacturers, had registered the words "Bank of England" for sealing-wax. Several other makers of sealing-wax were threatened by the registered owners, who naturally thought they possessed the exclusive use of the words as proprietors of the Trade Mark. Twenty or thirty other sealing-wax makers proved to the satisfaction of the Court, that they had used the same words for twenty or thirty years. The mark was taken off the Register, and the registered owner was ordered to pay the costs of the proceedings for removal.

Match Label—Christiansen's case.

In a much later case before the Court of Appeal, which was the case of a match label being on the Register, which it was alleged was too similar to an earlier mark, Lord Justice Lopes laid down the following principles which should guide the Court in dealing with a case of this description. His Lordship said: "In dealing with matters which are common to the trade, I think we must look at the combination of those different matters, common to the trade, then combination and arrangement, and if we find things that are common to the trade, all inserted in a similar position, in a similar form, and

in similar arrangements, so as to make the whole so similar as to be calculated to deceive, I think that is enough."

Summary of grounds on which Trade Mark Registry rectified.

Mr Sebastian, in the third edition of his "Treatise on Trade Marks," summarises the different grounds on which Trade Marks have been removed from the Register by different Courts as follows:—

1. Name not printed in a distinctive manner.

2. Device not distinctive, being in common use in the trade.

3. Words not distinctive, or fancy words being in common use in the trade.

4. Words not distinctive, or fancy words being descriptive.

5. Words registered as old mark, but not used as a Trade Mark *per se* on goods before 1875.

6. Words registered as old marks, but used descriptively, and not as a Trade Mark.

7. A mark registered for goods for which it was not used or entitled to be used.

8. Registered proprietor carrying on no business.

9. Marks registered though too similar to earlier marks.

10. Mark inherently deceptive.

11. Mark registered by servant of the owner.

This last ground for expunging a Trade Mark from the Register has been amplified and illustrated by reference to the analogous case of an agent who has registered his principal's mark, in the recent important decision respecting the Apollinaris Company's Trade Marks, which has been already referred to.*

* See page 50.

Agent registering principal's mark. The Apollinaris Company's Trade Mark.

In this case the *Apollinaris Company* had registered labels belonging to the owner of the springs abroad from which the water was procured, with his consent, but the Court of Appeal decided that that fact did not justify the putting the mark on the Register; for, in the first place, the label must be a distinctive label, distinguishing the goods of the person claiming, from all others, whereas the labels in question did not distinguish the bottles sold by the Apollinaris Company from any other of the owners of the springs; and, in the next place, the Apollinaris Company (who had registered) were not persons entitled to the exclusive use of it, either under the Act or otherwise at law. A person who puts another's Trade Mark on the Register cannot be a person entitled under the Act. Lord Justice Fry suggested, however, a case in which an importer might use the mark of the manufacturer with an addition, indicative of the goods being imported by him; but the mark of a manufacturer, pure and simple, could not rightly be assumed by an importer from that manufacturer, or by a person who buys from that manufacturer, unless the goods of the manufacturer go to that importer or that dealer, because other goods of the manufacturer may reach the hands of other dealers, who may justly affix to them the manufacturer's mark.

The marks so registered were removed from the Register.

Cases in which the Register has been rectified by varying the entry are classified as follows:—

1. By restricting the goods for which the mark is registered.

2. By striking some part of the mark out of it.

3. By causing a partial disclaimer to be entered on the Register.

4. By directing an alteration in the name of the registered proprietor.

The Comptroller has power, on request in writing, to correct any *clerical error* in the name, style, or address of the registered proprietor of a Trade Mark; also to *cancel* the entry, or part of the entry, of a Trade Mark on the Register.

Comptroller may correct clerical error.

Besides these powers given to the Comptroller, the Court has power, on the application of a registered proprietor, to order that a Trade Mark may be added to or altered, but not in an essential particular.

Court may order addition or alteration to registered mark

This has been done in one case, by allowing Messrs Boord, the distillers, to remove the former name of their firm from a label, leaving the space a blank, with permission, when using the mark, to insert in that space the name of the firm for the time being.

Boord's Case.

Permission was also given to another firm who had become possessed by assignment of a label for goods, to strike out from the label the address where the business had previously been carried on.

Such permission is also frequently sought where a business has been converted into a joint-stock company, and it is desired to alter the trading name on a label or wrapper.

This was done when the well-known firms of Guiness & Co., Allsop & Son, and Inde Coope & Co. were converted into joint-stock companies.

IMPROPER USE OF THE WORD "REGISTERED."—It is now a criminal offence for any one untruly to represent that any Trade Mark applied to any article sold by him is registered. On summary conviction

Penalty on using word "registered" if not registered.

he is liable for every offence to a fine not exceeding £5. A person is deemed to represent that a Trade Mark is registered, if he sells the article with the word "registered," or any word or words expressing or implying that registration has been obtained for the article stamped, engraved, or impressed, or otherwise applied to the article.

There is a clear defect in the section of the Act dealing with this matter. Sub-section 2 of Section 105 does not refer to a Trade Mark, but only to a patent or design.

There also appears to be a difficulty in dealing with a dishonest person who makes no verbal representation, but places a show card in juxtaposition with an article for sale, having thereon the objectionable words. Possibly there are some clauses of "The Merchandise Mark Act, 1887," which would be capable of being applied to such a case.

CHAPTER IV.

OPPOSITION TO REGISTRATION.

THERE are so many intricate points requiring the greatest care on the part of applicants, the registration of whose Trade Marks are opposed by any person, and on the part of persons desirous of opposing registration, that it was thought desirable to treat the subject in a separate chapter, the more so as the practice has been very much amplified by the Patents, Designs, and Trade Marks Act of 1883-1888, and the rules passed under such Acts. Under the Act of 1875, it was not customary to place great reliance upon the statements contained in a notice of opposition, or the answer to it — the counter statement. Anything, however rough or sketchy, was thought sufficient to send to the Registrar of Trade Marks, to arrest the progress of registration, by way of opposition. In practice also the Court, if the case ever reached so far, very rarely considered, or indeed had brought before it, the contents of the notice of opposition, or counter statement.

Opposition cases now heard before Comptroller.

The practice is now entirely altered. Cases of opposition are now directed to be heard before the Comptroller of Trade Marks; then there is an appeal to the Board of Trade, and only in case the Board of Trade directs, is the case decided by the Court.

Contents of notice of opposition.

Moreover, the rules under the last Acts specify the nature of the contents of the notice of opposition, altered, of course, to suit the requirements of the particular case; and unless the notice of opposition is in strict compliance with the rules, the opponent is seriously prejudiced when the case comes to be heard by the Comptroller.

Comptroller not to refuse registration without hearing applicant.

It has been seen that the Comptroller, having received the application for registration, may, if he thinks fit, refuse to register a Trade Mark; but he is not to exercise this discretion adversely to an applicant, without giving the applicant an opportunity of being heard, personally or by his agent, of which hearing ten days' notice is given.

Supposing, however, the application is accepted, or the hearing terminates in favour of the applicant, or in the case of an appeal to the Board of Trade the same result follows, the Comptroller then advertises the application in the *Trade Marks Journal*, an official paper published under the direction of the Board of Trade, and a representation of the Trade Mark appears therein in black and white.

Notice of opposition.

NOTICE OF OPPOSITION.—Any person may then, within one month, or such further time not exceeding three months as the Comptroller may allow, of the first advertisement of the application, give notice of opposition.

The notice of opposition is to state the ground or grounds on which the opponent intends to oppose the registration, signed by him or by his solicitor, and is to contain an address for service in the United Kingdom, according to a form, which in outline is given in the rules, with such variations as circumstances may require.

If the ground, or one of the grounds, of the opposition is that the applicant is applying for registration of a Trade Mark identical with, or having such resemblance to, a Trade Mark already on the Register with respect to such goods, as to be calculated to deceive, the notice is to state the *date of registration* and the *number* on the Register of such Trade Mark already on the Register.

Form in the rules.

The form in the schedule to the rules merely gives the formal parts of the notice of opposition, such as:—

"I, , hereby give notice of my intention to oppose the registration of the Trade Mark advertised under the above number for Class in the *Trade Marks Journal* of the day of , 18 , No. , page .

"The grounds of opposition are as follows."

The rest of the notice is to be filled in by the applicant or his solicitor, according to the circumstances of each particular case.

Some text-books contain forms adapted to many different cases, some of them involving the most difficult points of Trade Mark law, and in practice it has been found that none of these are appropriate to some of the complicated cases which arise between the rival traders, although highly useful so far as they go. The notice of opposition therefore, it will be seen, is a document requiring great skill and care, and knowledge of Trade Mark law, and should be prepared in anticipation of the evidence which the opponent will be able to produce in support of his opposition and the applicant's reply, seeing that the opponent has, in the first instance, to lodge his evidence in support, as will be presently pointed out.

Notice of opposition requires great care.

On the hearing of the case, no opposition is allowed in respect of any ground not stated in the notice of opposition.

Counter statement.

THE COUNTER STATEMENT.—The applicant's reply is called *the Counter Statement,* which has to be sent to the Comptroller, signed by the applicant or his solicitor, *within one month* after the receipt of the notice of opposition, or such further time as the Comptroller may allow. If he does not send the counter statement, his application is deemed to be abandoned.

Evidence.

The opponent within two months after the expiration of one month, or such further time not exceeding three months as the Comptroller may allow from the date of the advertisement of the application, has to leave at the Trade Marks Branch of the Patent Office, such evidence by way of declaration as he may desire to adduce in support of his opposition, and deliver to the applicant copies thereof.*

The applicant, within one month from the delivery of opponent's copy of his statutory declarations, is to leave at the same Office his evidence in answer, also by way of statutory declaration, and deliver copies to the adverse party. †

* The writer must express his opinion, from much experience in this branch of Trade Mark practice, that too much time is given. There may be cases perhaps where persons are abroad, in which special facilities may be given, but in many cases applicants are delayed registration for many months, it may be a whole year or more, by the facilities afforded for time.

† It appears to be a great and important defect in this practice that there exist no provisions to cross-examine the person who has made statutory declaration, a power which

When the evidence is complete, either party may obtain an appointment for the hearing of the case, and the decision is notified to the parties.

APPEAL TO THE BOARD OF TRADE.—Either party dissatisfied with the decision of the Comptroller can appeal to the Board of Trade within one month from the date of the decision, or such further time as the Comptroller may allow, but special leave of the Board of Trade may be given for a further extension of time.

Appeal to Board of Trade. Statement of grounds.

The practice is to leave at the Trade Marks Branch of the Patent Office a notice of appeal, together with a *statement of the grounds* of appeal, and the appellant's case in support.

The Board of Trade has also to be notified of the appeal, together with a copy of the statement of the case. The opponent, or applicant, as the case may be, has also to be notified, and to be furnished with a copy of the statement.

The Act directs that the Board of Trade if required "shall" hear the applicant, and the opponent, and the Comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted.

Board may refer appeal to the Court.

The Board of Trade may, however, refer the appeal to the Court, and the Court then has jurisdiction to hear and determine the appeal, and may make a similar order.

It would seem, however, that the Board of Trade

is not absent from any other legal proceedings (which this is). The writer has called the attention of the Board of Trade to this defect, and he has reason to believe it will before long receive parliamentary attention, as there is no power to remove it by means of rules.

is compelled to hear the appeal, although doubtless in practice, neither of the parties would be advised to refuse an immediate hearing by the Court, if the Board deems it unadvisable to hear the appeal, in which case the Board has power to direct the evidence to be adduced before the Court, and no doubt further evidence can be adduced by special leave.

Abandonment of Opposition.—If the applicant abandons his application after notice of opposition, he shall be liable to pay to the opponent such costs in respect of the opposition as the Comptroller determines to be reasonable, but the practice is very doubtful with regard to the payment of costs, if the opponent abandons his opposition at any stage; and it seems that if the case is ultimately heard by the Court, no costs can be given to a successful opponent of the previous proceedings in the Comptroller's department, or before the Board of Trade.*

When the case is heard by the Court, the Court has full power to decide as to the validity of the mark, notwithstanding that the Comptroller has originally passed it for registration.

The "Gem" air-gun case.

This was so decided in the "Gem" air-gun case (*re Arbenz*), where the mark had been passed by the Comptroller, opposed by rival gun-makers, decided in favour of the applicant, after a lengthy

* Another apparent defect in the whole of this procedure is, that no costs are allowed to either party, nor is there any discretionary power for the Comptroller to order costs to be paid by the unsuccessful litigant. Very considerable injustice and injury appear to be the result of this omission in the Act, or the rules, to the party who has been put to expense by an invalid opposition, or an improper application.

and careful hearing by Mr Justice Kay, and ultimately taken off the Register by the Court of Appeal, partly upon a ground which had not been taken before the Court below, namely, that the word "Gem" was descriptive, and not a fancy word.

CHAPTER V.

INFRINGEMENT OF A TRADE MARK.

"IMITATION," it is said, "is the sincerest form of flattery." When, however, it takes the shape of copying your favourite label or wrapper, for the purpose of fraud, the compliment does not appear to have been generally appreciated by the commercial community, although there can be no doubt the fact is a proof of the value of the Trade Mark which is imitated.

Remedies against infringement.

The registered proprietor of a valid Trade Mark to which he is lawfully entitled has three remedies open to him to adopt against persons who infringe his rights :—

Common law remedy.

1. He can bring an action in the High Court of Justice before the Queen's Bench Division, claiming damages in an action for deceit on the ground of false representation.

Chancery remedy.

2. He can bring an action in the High Court of Justice before the Chancery Division, claiming an injunction to restrain the alleged wrong-doer from using the registered Trade Mark, and also claim damages, or an account of profits.

Criminal remedy.

3. He can take criminal procedings under the "Merchandise Marks Act, 1887," by summons before a Magistrate or Justice of the Peace, or by indictment.

The second remedy is the one preferred, and will be treated of in this chapter, the criminal remedy being separately considered.

ACTION FOR INFRINGEMENT.—What will be now explained will be the remedy by injunction, granted by a Judge of the Chancery Division of the High Court of Justice, against the illegal use of another person's Trade Mark, consisting of any of those things which the law has laid down to be registerable as Trade Marks. Actions for infringement.

The question of putting up goods in a manner so like the mode adopted by another manufacturer or dealer as to be calculated to deceive, and the fraudulent use of a name of an individual or firm by another firm of the same name, are analogous questions, but will also be separately considered, and explained in subsequent chapters.

The principles upon which a Court proceeds to afford protection to a person whose Trade Mark is infringed, are stated by various writers in various ways. They have been well enunciated over and over again, by eminent judges in numerous important cases.

It has been said that fraud is not an actual ingredient in the case, but it is the right to property which is affected; and in another important case it was said by that eminent lawyer, Lord Westbury, that "Imposition on the public is indeed necessary for the plaintiff's title, but in this way only, that it is the test of the invasion by the defendant of the plaintiff's right of property; for there is no injury done to the plaintiff if the mark used by the defendant be not such as may be mistaken, or is likely to be mistaken, by the public for the mark of the Fraud not essential.

plaintiff, but the true ground of the Court's jurisdiction is property."

It must of course, however, be understood that the property is not in the mark, but in its application to particular goods, and consequently a person has not such an abstract right to use the mark he adopts for particular goods, as to enable him to prevent others from using the same mark on other goods. Such rights may arise now under the Trade Marks Registration Acts, and may arise on opposed registrations, in respect to similar descriptions of goods included in the same class.

Lord Cranworth's definition of the principles.

Lord Cranworth stated the general principles to be that any one who has adopted a particular mode of designating his manufacture, has a right to say, not that other persons shall not sell exactly the same article, better or worse, or an article looking like it, but that they shall not sell it in such a way as to steal his Trade Mark, and make purchasers believe that the article is his manufacture.

American's definitions.

A learned American author has stated the principles in these words:—"The ground upon which the Court protects Trade Marks is, that it will not permit a party to sell his own goods as the goods of another. A party will not therefore be allowed to use names, marks, letters, or other *indiciæ* by which he may pass off his own goods on purchasers as the manufacture of another person.

"A man is not to sell the goods of his manufacture to *B*, under the pretence that they are the goods of the manufacture of *A*, who by superior skill and industry has established a reputation for his articles in the market. The law will not permit a practice of this kind, nor the use of names which contribute

to effect it; he has no right, and will not be allowed to use names, marks, or other symbols, by which he may palm off on buyers, the articles which he is selling, and thereby attract to himself the patronage that without such deceptive use of such names, &c., would have benefited that other person who first got up, or was alone accustomed to use such names, marks, or symbols.

"In commercial dealings, the utmost good faith should be observed, and no one is permitted to go into the market with labels assimilated to those of another, so as to profit by the ingenuity, good faith, or established reputation of the latter.

"If the article sold by the defendant does not differ from the complainant's, but merely inferior to it, the effect must be to destroy in the market the value of the plaintiff's article. In all cases where a Trade Mark is imitated, the essence of the wrong consists in the sale of goods of one manufacturer or vendor for those of another, and it is only when this false representation is directly or indirectly made, and only to the intent in which it is made, that the party who appeals to the justice of the Court can have a title to relief."

Lord Kingsdown's definition. American Leather Cloth Company's case.

Lord Kingsdown, in the case of the *American Cloth Company*, says:—"The fundamental rule is that one man ought not to put up his goods for sale as the goods of a rival trader, and he cannot, therefore, in the language of Lord Langdale, in the case of *Perry v. Truefitt*, be allowed to use names, marks, letters, or other *indiciæ* by which he may induce purchasers to believe that the goods he is selling are of the manufacture of another person."

It must be understood that the same principles

in these cases apply to middlemen or dealers who are not the manufacturers, in which case Trade Marks are deemed marks of selection.

Cases of infringement of Trade Marks appear very early in the English Law reports.

First infringement case in England.

The first case was that of *Southern* v. *How*, which is thus reported in Popham's Law Reports :—" In 22 Eliz., an action upon the case was brought in the Common Pleas by a clothier, that whereas he had gained great reputation for his making of cloth, by reason whereof he had great utterance to his benefit and profit, that he had used to set his mark to his cloth whereby it should be known to be his cloth, and another clothier perceiving it, used the same mark to his ill-made cloth, on purpose to deceive him, and it was resolved the action did well lie." It was doubtful whether the action was brought by the defrauded clothier or by the purchaser.

For many years the Courts of Law and Equity appeared indisposed to interfere for the protection of Trade Marks, considering them somewhat in the light of monopolies, so that the law for the protection of Trade Marks as now administered in the Courts is exclusively the growth of the last seventy or eighty years, and may be said to form a complete system of jurisprudence, thoroughly well understood and administered.

Necessity for immediate proceedings.

As soon as the fact of an imitation or improper use of a registered Trade Mark has come to the knowledge of the registered proprietor, it behoves him, without any unnecessary delay, at once to take steps against the infringer, if the rights of the registered proprietor are sufficient to entitle him to do so.

Urgency is needed, because it becomes necessary in most cases that an application for an *interlocutory injunction* should be made as soon as the proceedings in the action are instituted by the issue of the writ. This interlocutory injunction it may be of the utmost importance to obtain at an early stage, and it will not be granted if, in the opinion of the Court, unreasonable delay has taken place. It has been decided, however, that the plaintiff may take sufficient time to secure the necessary evidence to establish his case.

Interlocutory injunction.

There are many reasons why an interlocutory injunction should be applied for, and applied for at an early stage. It may be in some cases absolutely necessary to stop the injury being done to the plaintiff, without waiting until the case is heard by the Court.

In some cases when goods bearing the pirated mark are on board ship for transmittance abroad, or in the custody of dock or wharf owners, and the utmost diligence is required to stop the goods going abroad, or being disseminated in other ways, an *ex parte* injunction may be obtained.*

In many cases it frequently happens that on the hearing of a motion for an interlocutory injunction, supported by the best evidence which can be obtained, and establishing the plaintiff's rights in a substantial manner, the defendant is advised to submit to a perpetual injunction, and to treat the

* In one case within the writer's knowledge, the goods bearing the objectionable mark had been shipped whilst the proceedings were being taken. V.-C. Bacon granted an injunction, *ad interim*, and ordered the defendant to forward a cablegram to China to stop the goods being sold with the pirated mark thereon.

hearing of the motion as the hearing of the cause.

Protesting not sufficient.

A person who has become aware of an infringement of his rights must take some decided measures, because apart from the risk he runs of losing the benefit of an interlocutory injunction, he may lose all right to relief by what is technically called "acquiescence" on his part. The fact that he has written to the infringer, and protested, and asserted his rights, goes for nothing. Lord Justice Turner said, in a case in which delay and acquiescence was charged against the plaintiff, "What the plaintiffs mainly rely on was the continual claim on their part, and no doubt they have not ceased to assert their claim; but I cannot agree to a doctrine so dangerous as that the mere assertion of a claim, unaccompanied by any act to give effect to it, can avail to keep alive a right which would otherwise be precluded."

Defence that plaintiff is aware of defendant's acts.

A very frequent defence which is set up against a plaintiff's rights which are intact on all points is, that the plaintiff was aware of the defendant's acts; but it appears to be clear law, having been laid down in one case by such an eminent judge as Lord Justice Fry, that the evidence adduced on this point by the defendant must go to show, not merely that the plaintiff *might* have been aware of the infringement, but that he actually was so, and with such knowledge he remained quiescent.

The question of delay in bringing an action, however, may also affect the plaintiff's right to costs, even although an injunction is granted at the trial.

Communication with defendant before action.

When it is known by the registered proprietor of a Trade Mark that it is being infringed, it behoves him to be very careful how, and in what manner,

he places himself in communication with the infringer, and whether he should do so by letter, and in that case as to the form of letter. In many instances it is not the whole Trade Mark which is pirated, or used by another person, and it may not also be an exact copy, or an identical imitation of a Trade Mark. A person is entitled to relief where the essential portion, or essential portions, of a label, or a combination Trade Mark, is taken; or where there is used a colourable imitation of a label, or wrapper, or other Trade Mark, in such a manner as would be calculated to deceive.

In these cases, it is necessary to specify with accuracy, if the wrong-doer is approached by a written communication, what is claimed, and if too much, or too little is claimed, the applicant for relief may be prejudiced at a later stage of the proceedings by some act which a person may take on receipt of a written communication, loosely or improperly worded.

The "Two Elephants" case—Orr Ewing & Johnston. Essential features of ticket.

In the important case of *Orr Ewing & Johnston* the plaintiffs, Orr Ewing & Co., used upon Turkey red yarn a ticket, or label, comprising different particulars, but upon which were two elephants.

The defendants used a ticket, or label, on the same description of goods, also bearing two elephants, but placed in a different position. It was, however, proved by the plaintiffs in that case, that the goods sold by them were known as Two Elephants Yarn, and the Court came to the conclusion that the two elephants constituted essential features of the plaintiff's Trade Mark, and granted an injunction against the defendants using two elephants on any

ticket on Turkey yarn, so as to represent or induce the belief that any of the yarn was dyed by the plaintiff's.

This is one of the best instances of claiming essential features of a combined mark.

It is very seldom that the exact thing itself is taken—that is to say, identical in all respects, although this is sometimes done and justified on different grounds.

The "Osman" Turkish Towel case—Barlow *v.* Johnson.

Another and very recent illustration of a manufacturer's claim to an essential feature of a label is the case of *Barlow* v. *Johnson*, in the case of a name or word. Barlow & Jones, Limited, of Manchester, are one of the largest and most extensive manufacturers of Turkish towels. They manufactured a particular kind of Turkish towel, upon which they placed a label, or ticket, of a distinctive nature, bearing, besides other devices and ornamentations, in a prominent position, the word "Osman." Being an exceptionally good towel, the towels became known by the name "Osman," and obtained a great reputation. Another firm of Turkish towel manufacturers commenced to make a similar kind of Turkish towel, on which they placed a ticket, very similar to the plaintiff's ticket, and afterwards changed it to one not at all similar, but bearing in a very prominent position the word "Osman." It was proved that the word was the essential feature of the label, which was registered under "The Trade Marks Registration Act, 1883," and an injunction was granted, restraining the defendants from using the word "Osman."

Marks need not be identical in infringement cases.

In order to ascertain whether there has been an imitation of the plaintiff's mark, it is not necessary that there should be an exact copy; in fact, as before

observed, this is seldom done. It is desired to take something which closely resembles the thing itself, without making an exact copy.

The "Day Martin & Blacking" case.

In the leading case of *Croft* v. *Day* (Day & Martin's Blacking), Lord Langdale laid down in the clearest language, the mode in which a fraud of this nature is generally endeavoured to be accomplished. "First, there must be such a general resemblance of the forms, words, symbols, and accompaniments as to mislead the public; and secondly, a sufficient distinctive individualism must be presented, so as to procure for the person the benefit of that deception which the general resemblance was calculated to produce. To have a copy of the thing would not do, for, though it might mislead the public in one respect, it would lead them back to the place where they were to get the genuine article, an imitation of which was improperly sought to be sold. For the accomplishment of such a fraud, it was necessary in the first instance to mislead the public; and in the next place, to secure a benefit to the party practising the deception by preserving his own individuality."

As to what is a *colourable imitation*, and in what cases can it be said that a person has so imitated another person's Trade Mark as to be calculated to deceive, and which a Court will restrain, it is always a difficult matter to determine.

The "Tovril" case.

It may be the case of a word. The use of "Tovril" was restrained by Mr Justice North, at the instance of the proprietor of the beverage called "Bovril," and the fraud was assisted by the use of cups, urns, and other modes of selling the article, similar to those used by the proprietors and inventor of "Bovril."

In *Steinway* v. *Henshaw*, Mr Justice Stirling restrained the defendant from using the word "Steinberg" on pianos, which his Lordship considered was adopted to pass off defendant's pianos for those of the eminent firm of Steinway & Sons, of New York and London.

Rodgers & Rottgen—German cutlery case.

The well-known firm of *Joseph Rodgers & Sons*, Limited, succeeded in restraining one Rottgen, a German manufacturer of cutlery, from using two Maltese crosses, which in fact he had registered in Germany, and which Mr Justice Kay thought was similar to Messrs Joseph Rodgers & Sons' world-wide device, a Trade Mark of a star and Maltese cross, and which had been in use by their firm and predecessors since 1764.

The deception was also assisted by the use of labels on packets of cutlery, sample cards, and other modes of putting up goods, similar to those adopted by the plaintiffs.

Proof of actual deception.

There is seldom to be found capable of being produced to the Court on the hearing of cases of this description, evidence of persons having been *actually deceived*, although this was done in the case of *Lever v. Goodwin*, which will be commented upon in a subsequent chapter, having reference to cases of imitation of mode of putting up goods. Nor is it necessary to do this, when the counterfeit mark is so nearly resembling the genuine mark, as, in the opinion of the Court, what the defendants have done is calculated to deceive.

This was so laid down in the case of Orr Ewing & Johnston, and it may be useful to refer to what Mr Justice Fry and Lord Justice Cotton said in that case, explanatory of the point.

It will be recollected that in that case the defendants had taken two elephants as part of their ticket, and which the Court came to the conclusion formed an essential part of plaintiffs' ticket, and after going very minutely into the whole of the case, Mr Justice Fry proceeded—

"I think therefore that while the defendants did take these two elephants, they took that which was a material and substantial part of the plaintiffs' ticket. Now what is the result of that. It appears to me that the result of that is this: to throw upon the defendants the burden of proving that their ticket did not deceive purchasers, so that they should believe that the defendants' goods were plaintiffs' goods."

On appeal, Lord Justice Cotton explained this principle as follows:—"Not that in all cases where fraud is charged, or in a case of this sort, the burden of proof is not on the plaintiff to make out his case, but that when the defendants do use, under suspicious circumstances, a ticket which of itself is calculated to deceive, that then the burden of proof is thrown upon them, to displace that *prima facie* evidence against them, and to show that, in fact, they were innocent in doing this, which of itself is not innocent, because it is calculated to deceive."

The plaintiff, however, always produces to the Court, evidence of persons well versed in the trade in the goods in respect of which the genuine and false Trade Marks are used, that the two marks are so similar as to be calculated to deceive.

It may be, that when the two things are placed close together, it will be seen that they differ very

considerably, and therefore the learned judges have laid down rules, from which can be clearly gathered the principles which should regulate a Court in coming to a decision that the Trade Mark complained of is a colourable imitation, and should be restrained.

Lord Cranworth's judgment in *Seixo* v. *Provezende.*

It would be impossible to explain these principles in clearer language than that used by Lord Cranworth in *Seixo* v. *Provezende*, and which are constantly quoted in Trade Mark infringement cases:—"It is hardly necessary to say that, in order to entitle a party to relief, it is by no means necessary that there should be absolute identity; what degree of resemblance is necessary is, from the nature of things, a matter incapable of definition *à priori*. All that Courts of Justice can do is to say that no trader can adopt a Trade Mark so resembling that of a rival as that *ordinary purchasers*, with *ordinary caution*, are likely to be misled. It would be a mistake, however, to suppose that the resemblance must be such as would deceive persons who should see the two marks placed side by side. The rule so restricted would be of no practical use. If a purchaser, looking at the article offered to him, would naturally be led, from the mark impressed on it, to suppose it to be the production of the rival manufacturer, and would purchase it in that belief, the Court considers the use of such a mark to be fraudulent. But I go further: I do not consider the actual physical resemblance of the two marks to be the sole question for consideration. If the goods of a manufacturer have, from the mark or device he has used, become known in the market by a particular name,

I think that the adoption by a rival trader of any mark which will cause his goods to bear the same name in the market may be as much a violation of the rights of that rival as the actual copy of his device."

This was followed, as has been seen, in the case of the "Two Elephants" Turkey Yarn (*Orr Ewing* v. *Johnston*). Also when the plaintiff's beer was known as "Dog's Head" Beer, the defendants were restrained from using on their beer the head of a different kind of dog from that used by the plaintiffs (*Read* v. *Richardson*); and in numerous other cases.

The "Two Elephants" case.

"Dog's Head" Beer.

One of these may perhaps be referred to, as it illustrates the subject in a very clear manner.

In *Ford* v. *Forster* the plaintiff, who was a maker of the shirts, was in the habit of selling his shirts as "Ford's Eureka Shirts," and it was argued on behalf of the defendants, that as the plaintiff had always marked his shirts as "Ford's Eureka Shirts," and as the defendant had only adopted the term "Eureka," it was impossible that the public could be deceived by such means.

Ford's "Eureka" Shirts.

This objection was overruled, on appeal, by the Lords Justices, on the ground that the word "Eureka," so used, was the mark by which the public would be influenced in purchasing the shirts. "It is quite obvious," said Lord Justice Mellish, "that although he adds the word 'Ford,' for the purpose of enabling people to come to him, and in order to tell them where to buy a 'Eureka' shirt, you must buy it of Ford; yet a large number of persons who read these advertisements would be attracted by, and remember, the word 'Eureka,' and would wholly forget the word 'Ford.'"

The above cases have been instanced as much for the purpose of explaining the grounds upon which the Court proceeds, in considering whether there has been an imitation of the plaintiff's Trade Mark, as to show the care which is required in making the right claim against the defendant at the right time.

Danger of delaying proceedings.

Another danger may now be pointed out to which a person is subjected, by not taking proceedings at as early a moment as possible, when he is aware of his Trade Mark being adopted by another person; and this has occurred more particularly in respect of a name used to designate a particular article to be a particular person's manufacture. It is true that these cases occurred before the Registration Act of 1875 came into operation, but they may still hold good in similar cases.

Name may become *publici juris.*

It often happened that a mark which, at its first adoption by the owner, and for some time afterwards really did convey such a meaning, has, either from the negligence or licence of the owner, come to be understood as no more than descriptive of the particular class of goods upon which it is placed, and from this cause, or from lapse of time, or other circumstances, has become a name "*publici juris,*" and as such open to all the members of the community equally.

Lord Justice Mellish's definition of *publici juris.*

This argument was put forth by the defendant in the above-mentioned case of *Ford* v. *Forster.* "There is no doubt, I think," Lord Justice Mellish said, "that a word which was originally a Trade Mark, to the exclusive use of which a particular person, or his successor in trade, may have been entitled, may subsequently become *publici juris,* as

in the case recently before us of '*Harvey's Sauce.*' It was admitted there that although that had been originally the name of the sauce made by a particular individual, it had become *publici juris*, and that all the world were entitled to call sauce 'Harvey's Sauce' if they pleased."

"Harvey's Sauce" became public property, because the owners of the name did not take proper precautions to protect themselves.

"Reading Sauce," "Worcestershire Sauce," "Harvey's Sauce."

The same thing occurred in the case of "Reading Sauce" and "Worcestershire Sauce," but in the case of "Harvey's Sauce" an injunction was granted at the instance of the successors in business of the original inventor, restraining a person from selling a sauce under the title of "The Original Lazenby's Harvey's Sauce." In the case of Reading Sauce, a similar injunction was granted to restrain a firm from selling a sauce under the name of "The Original Reading Sauce."

"Original" or "only genuine."

The Judge in the latter case laid down that where there are a great number of persons who produce the same article, "original" means that the article so called is that made by the first inventor. That is the meaning of the word "original" which the Court of Chancery has always recognised.

The same principles have been laid down in other cases, and also with reference to the use of the words "The only genuine," and the like. Even although a manufacturer may have lost his right to a name or a label, such species of false representation will be restrained.

Goodall, Backhouse, & Co.'s "Yorkshire Relish."

An instance may be mentioned in which manufacturers of sauce have maintained their right to a name for sauce, and their right to their label, having

taken immediate proceedings to protect themselves. This occurred in the case of *Goodall* v. *Hutchins*, before Mr Justice Kay, on the 27th January 1882, and the judgment in that case is of such an instructive nature that it may be referred to with advantage in considering both portions of the question, imitation of label, and of the words "Yorkshire Relish," as applied to a sauce.

Goodall v. *Hutchins.* Mr Justice Kay's judgment.

Mr Justice Kay said: "For many years the plaintiffs [*Goodall, Backhouse & Co., of Leeds*] had been making, and selling, a sauce to which they gave the name of 'Yorkshire Relish,' and upon these bottles was a label in red, white, and blue colours." His Lordship then described what the defendant had been doing, and proceeded: "No one could fail to be deceived by the bottles of the defendant, and he had not the smallest shadow of a doubt that the bottle and label of the plaintiffs were, by the defendant, put before the eyes of his designer, with directions to copy it as closely as could be, without taking the very thing, and that he had managed to make a copy so close that very many purchasers would be likely to be deceived by it. In my opinion it was calculated, and meant, to deceive, and was a gross fraud. . . . Then there remained the question what the defendant had thought fit to contest, namely, whether or not he might use the words 'Yorkshire Relish,' and the mode in which he attempted to justify doing that was this. He did not say he was aware of the materials, or mode of manufacture of the plaintiffs' sauce, or that the words 'Yorkshire Relish' had become the exclusive designation of a particular sauce that might be made by anybody, but he said other people had been

making sauces to which they had given the name 'Yorkshire Relish.' From the evidence it appeared that if this were so, it had been done in a secret and hole-and-corner sort of way, and to such a small extent, that it did not become known to the principal dealers in such goods. The defendant had no manufactory in Yorkshire; he had no knowledge of the recipe of the plaintiffs; and he could not justify the use of the title 'Yorkshire Relish' by saying that other people had used the name."

His Lordship granted an injunction restraining the use of the words "Yorkshire Relish" and the use of the label.

An important American case, *The Dixon Crucible Company* v. *Guggenheim*, so completely exemplifies the exact principles of this class of case, that it is considered very useful to set forth portions of the judgment.

The article sold by the plaintiffs and defendant was stove polish, put up in cubes, and covered with wrappers, and bearing labels with the names used by each, which were very similar, and so were the wrappers and labels, but slight differences existed when the two cubes were placed side by side, and to one not thoroughly familiar with both the one could easily be mistaken for the other, so far as the shape and general appearance were concerned. The Judge called attention to these differences, but stated that the general appearance and effect were substantially the same, and then proceeded: "A number of affidavits were read on both sides as to the closeness of the alleged imitation. Those of the plaintiffs say that the defendant's article is purchased and used to

a very large amount by persons who supposed that they were buying the plaintiffs' polish; while the defendant alleged that both the Joseph Dixon and the J. C. Dixon polish are known to the trade, and that the defendant never sells the one for the other. Further, that any one of common understanding can distinguish between them, and that persons are not likely to be misled. Respecting this point, the testimony of the defendant is merely negative. That of the plaintiffs is positive and strong. The public have been misled. It is true that the wholesale dealers may generally understand the difference between the two articles, and may not sell the J. C. Dixon for the Joseph Dixon; but the small retail dealers, scattered all over the world, do not so understand this distinction, and if they did might not so regard it. Much less would their customers —many of whom are ignorant people—sometimes domestics, sent to the store by their employers—recognise any difference between them, or know whether they were buying the Dixon Stove Polish which has been advertised for so many years, or the article manufactured and sold by the defendant. . . . True it is that they are not exactly alike. But the whole Trade Mark need not be counterfeited. And the Court will examine to see if the very differences are not colourable."

In another American case where "Bovina" was substituted for "Boviline" in a label, the Court said: "The design was evidently to depart from the other sufficiently to constitute a difference, when the two were compared, and yet to do it so skilfully that the difference would not be detected by an ordinary purchaser, unless his attention were particularly

called to it, and he had a very perfect recollection of the label."

The same principles so well and clearly laid down in these and other American cases will be found in all the English cases relating to imitation of labels, wrappers, and other Trade Marks.

CHAPTER VI.

CONSEQUENTIAL RELIEF—ACCOUNT OF PROFITS—DAMAGES—COSTS.

A PLAINTIFF in an action, claiming an injunction to restrain the defendant from infringing his Trade Mark, or from passing off his goods as and for the goods of the plaintiff, or from using his name in a fraudulent manner, is always advised to claim an account of profits—or damages—and the costs of the action, and a plaintiff who has succeeded in obtaining an injunction can elect whether he will have an account of profits, or an inquiry as to damages.

Account of profits preferable to damages.

It may be stated as the result of considerable experience, that it is preferable to claim an account of profits, by reason of the difficulty of proving the extent and nature of the damages which follow the defendant's unlawful acts.

***Leather Cloth Company* v. *Hirschfeld*.** V.-C. Wood

In the case of the *Leather Cloth Company* v. *Hirschfeld* (in 1865), it was held by Vice-Chancellor Wood, that it would not be assumed, in the absence of evidence, that the amount of goods sold by the defendant under the fraudulent Trade Mark would have been sold by the plaintiffs, but for the defendant's unlawful use of the plaintiffs' Trade Mark; for how could the Court assume that the persons who bought what the plaintiffs averred were inferior articles at an inferior price, would necessarily,

if they had not done so, have bought the superior articles at the higher prices.

In this case, however, the plaintiffs took an inquiry as to damages, and failed to prove special damage; they then claimed the amount of profits which they would have made if they had sold the amount of cloth which the defendant had sold under their Mark.

American cases.

The question has been apparently well settled in America. In the case of *Graham* v. *Plate*, it was said: "Every consideration of reason, justice, and sound policy demands that one who fraudulently uses the Trade Mark of another, should not be allowed to shield himself from liability, for the profit he has made, by the use of the Trade Mark, on the plea that it is impossible to determine how much of the profit is due to the Trade Mark, and how much to the intrinsic value of the commodity, the fact that it is impossible to apportion the profit, rendering it just that he should lose the whole."

In another American case (*Hostetter* v. *Vowinkle*), the damages were assessed at the amount of profits which the plaintiffs would have made if they had sold the same quantity of goods as the defendants had sold of theirs, under a spurious label.

But in England the same difficulties exist, and the plaintiff will be well advised to claim an account of profits.

An account of profits is worked out in the Chambers of the Judge who has granted an injunction, before the Chief Clerk, and the order for it forms part of the order for the inquiry.

Lever v. *Goodwin.* "Sunlight Soap."

In *Lever* v. *Goodwin* (the Sunlight Soap Wrapper case), the order was, "that the following account be taken, that is to say, an account of the profits made by the defendants in selling or disposing of soap made by or for the defendants, in any wrapper such as that contained in the exhibits, marked J.S.S.[1], J.S.S.[4], and B.B.[1], and in the form of those exhibits, and it is ordered that the defendants, Goodwin Bros., do, within fourteen days after the date of the Chief Clerk's certificate to be made pursuant to this order, pay to the plaintiffs, Lever & Co., the amount which upon taking such account shall be certified to be payable by the defendants to the plaintiffs."

A point was raised in the Court of Appeal on behalf of the defendants, as to the form in which the account of profits ought to be, that the only profits which the plaintiff could call for was that profit which arose from the sale of the soap, when the ultimate purchaser bought it not as the defendants', but as the plaintiffs.'

Lord Justice Cotton, affirming Mr Justice Chitty's order on this point, said: "It is well known that both in Trade Mark cases and Patent cases, the plaintiff is entitled, if he succeeds in getting an injunction, to take two forms of relief as alternative; he may either say, 'Now, I claim from you the damage I have sustained from your wrongful act,' or 'I claim from you the profit which you have made by your wrongful act.' . . . The defendants, as I understand, do not sell anything to retail purchasers; what they sell, they sell to middlemen, that is to say, to purchasers from them as wholesale merchants, and who are going to sell it

retail to persons who come and buy one or two, or any number of these packets; and the complaint against them is this: 'You have dressed up your soap in such a dress, that those middlemen to whom you sell it are enabled by having that deceptive dress on it to sell it to the ultimate purchaser as the soap of the plaintiffs when it is your soap. In my opinion the whole gist of the complaint against them is, you have sold a weapon calculated to be used fraudulently by the middlemen, and the profit for which they must account is the profit which they have made by the sale of the soap in that fraudulent dress to the middlemen."

Great care is required in working out the account of profits in the Judges' Chambers before the Chief Clerk, and it is very necessary in large cases to procure an inspection and examination of the defendant's books by a skilled accountant. A good many questions may arise in taking these accounts, as to the nature of the gross profits, and the defendant's right to charge certain items against the plaintiff for materials, rent, bad debts, and the like.

Examination of defendant's books.

In one of these cases the defendant, against whom the injunction was granted to restrain him from selling an article called "Glucose," bearing the plaintiff's Trade Mark, was simply an agent for a foreign manufacturer, who sent the goods here for sale by the agent, who had to account for the profits he had made, and pay them to the plaintiffs.

The defendant claimed to deduct certain bad debts which he had incurred, and the matter was fully discussed, with the result that the Chief Clerk was of opinion that the defendant must account for

his profits, which were not to be diminished by losses incurred in his general business. The question was settled without any decision from the Court.

In practice very few of these accounts of profits or inquiries as to damages are ever worked out. They generally terminate by the offer and acceptance of a lump sum.

In trifling cases it is hardly worth while to claim either damages or profits, should a defendant show a disposition to consent to an injunction on being served with notice of motion for an interlocutory injunction, and to treat the hearing of such motion as the hearing of the action, as constantly happens; the plaintiff will be well advised in ordinary cases to waive his claim for damages or profits, unless he can obtain payment of a fixed and reasonable sum.

Costs.

With regard to costs, as a general rule they will follow the result of the action, but although the plaintiff may be entitled to an injunction, he may be deprived of costs on account of his own conduct —such as unreasonable delay in commencing proceedings, or where the defendants made at the proper stage a reasonable offer, which the Court thinks should have been accepted by the plaintiff. The Court may in such a case grant an injunction, but without costs.

In some cases the plaintiff may have to pay costs of persons who have been joined in an action, such as forwarding agents, and who had made reasonable offers.

The Court will sometimes in heavy cases, and cases of great difficulty, give costs to a successful plaintiff on the higher scale, but not always. It is a matter entirely for the Court.

It is not actually necessary that a person whose Trade Mark is infringed should communicate with the infringer before commencing proceedings. Whether this should be done or not depends greatly upon the character of the parties implicated —that is to say, whether they are sufficiently respectable in other respects, as to lead to the belief that they will accede to a demand to discontinue using the complainant's Trade Mark.

Whether notice to infringer before proceedings necessary.

In some cases such an application is simply used as a subterfuge for an offer which cannot be accepted, but which renders it difficult, except at the risk of costs, for a plaintiff to proceed.

In other cases, it is absolutely necessary, as has already been stated, for a properly worded request to be made, and a Court very frequently takes into consideration the correspondence which has passed, and whether the conduct of the parties have been fair and reasonable.

It was laid down by Lord Romilly, that the defendant being the aggressor, the plaintiff would be justified in filing his bill, without making any application to the defendant.

In another case Vice-Chancellor Wood granted an injunction with costs, though no notice had been given before bill filed.

Mr Justice Chitty gave costs with an injunction, there having been no notice to the defendant, who had acted quite innocently, and it was stated that Sir George Jessel, Master of the Rolls, acted on the same principle.

In some cases the Court will order the delivering up, to be destroyed, of fraudulent labels or wrappers, and in one case Vice-Chancellor Bacon

Delivering up of fraudulent labels, wrappers, &c.

ordered that the representation of a certain animal which was an infringement of the plaintiff's Trade Mark, should be cut out of the defendant's ticket on the goods, and as the goods had already been shipped to China, the defendant was ordered to pay the costs of a cablegram to China to ensure this being done on the arrival of the goods.

ADVERTISEMENT OF THE INJUNCTION.—A plaintiff is always justified in publishing the fact of an injunction being granted, in the public papers, and by circular to his customers, unless, of course, the defendant has consented to an injunction, on the terms that it shall not be published, or only for a limited period.

Advertisement of injunction must be truthful.

Such an advertisement must be truthful in its terms, and accurately represent the facts; if otherwise, it may be treated as a contempt of Court, or otherwise dealt with.

In a case before Mr Justice Chitty, a motion was made by the defendants to commit a successful plaintiff for inserting, what was alleged to be, an incorrect account of the grant of an injunction.

Mr Justice Chitty said: "If a party to an action published a report of the case in a Court of justice, especially when he reported it for his own benefit, he was bound to make a reasonably fair statement of what had taken place."

Such an advertisement should never be inserted in a public paper, unless under proper advice, and a judgment of the House of Lords shows that it is unsafe to publish or circularise even a correct judgment of a Court, when the whole of the case is not reported.

It was a case where judgment had been given

for one party, and the whole judgment was admittedly reprinted correctly, but their Lordships stated that it might be deemed libellous, if the grounds of the judgment were not also set forth, with the evidence upon which the judgment was founded.

CHAPTER VII.

MATTERS AFFECTING THE RIGHT TO SUE.

AFTER what has been explained in preceding chapters,* it will be understood that the mere fact that a person has obtained registration under "The Trade Marks Registration Acts, 1875 to 1888," of something which he supposed represented, and which he intended to use, and has used, as a Trade Mark, is not sufficient to enable the registered owner to prosecute successfully in a civil court, a person who is using the same thing, or a colourable imitation as it, on the same description of goods.

It is said in a "civil court," that is, any of the Courts attached to the High Court of Justice, of the Chancery, or Queen's Bench Divisions.

Whether a person can be prosecuted under the "Merchandise Marks Act, 1887," for forging, or falsely applying a Trade Mark, or one so nearly resembling a Trade Mark as to be calculated to deceive, if the Trade Mark is an invalid Trade Mark, remains to be seen, and will be commented upon hereafter in dealing with the criminal remedy,† considering that the only definition of a Trade Mark in that Act is, that it means a Trade Mark registered under the "Patents, Designs, and Trade

* See chaps. ii. and iii. † See chap. xiii.

Marks Act, 1883," and by implication under the Act of 1875.

Whether plaintiff's mark is a valid mark.

Certainly, however, with regard to any proceedings to obtain an injunction, it would be necessary, before commencing such proceedings, to consider whether the Trade Mark is a valid mark, and properly placed on the Register, and this, notwithstanding that the mark has been on the Register five years.

***Behrens re Whittaker.* Plaintiff's (Whittaker's) mark defective.**

In *Behrens re Whittaker*, a mark for white shirtings had been on the Register for twelve years or so, and on the strength of it, the registered owner sued a firm, to restrain them from using what was alleged to be a colourable imitation of a device. The defendants in that action, Messrs L. Behrens & Sons, succeeded in shewing to the satisfaction of Mr Justice Kay, that the mark had been improperly placed on the Register, and it was taken off the Register, on a motion to rectify it, by the defendants in the action, who of course ultimately succeeded.

Eno re Dunn.

Another very disastrous result of proceedings adopted by a registered Trade Mark owner, occurred in the recent important case of *Eno re Dunn*, the circumstances of which were very peculiar and instructive, and although not strictly on the subject treated in this chapter, on those grounds may be stated here.

Mr Eno is the well-known inventor and manufacturer of a preparation for making a non-intoxicating beverage. In the year 1878 he registered the words "Fruit Salt" as an old mark in Class 42. He also, in September 1877, registered the same words in Class 3, as an old mark for proprietary medicines for human use.

In the year 1878, the plaintiff succeeded in an

action against one Stephens to restrain him from using the words "Fruit Salt," and the labels he was using.

In appears, however, that in May 1886, one W. G. Dunn applied to register the words "Dunn's Fruit Salt Trade Mark Baking Powder" as a Trade Mark for baking powder, in Class 42.

This was opposed by Mr Eno on the ground of his Registered Mark. On a summons being taken out by Dunn, and coming before Mr Justice Kay, Dunn was prevented from registering the words, but Mr Eno consented to have the words "Fruit Salt" expunged from the Register, which his counsel stated he felt unable to maintain, on account of their not having been used before the 13th August 1875, except as part of a label.

The case was ultimately taken to the House of Lords, who confirmed the decision of Mr Justice Kay, which had been reversed by the Court of Appeal.

Another and more recent instance of a registered owner being defeated, on his attempting to attack a firm for an alleged colourable imitation of his registered Trade Mark, on account of the invalidity of his Trade Mark, occurred in the case of *Richards* v. *Butcher*, before Mr Justice Kay.

Heidsick's "Dry Monopole."

Messrs Richards & Co., agents in England for Messrs Heidsick & Co. of Rheims, and the registered owners of the Trade Marks in dispute, brought an action against the defendants, Messrs Butcher & Robinson, wine merchants, for the alleged infringement of two Trade Marks, "Monopole" and "Dry Monopole," used in connection with champagne, by the use of the word "Monobrut."

The word "Monopole" was registered by Messrs Heidsick on July the 28th, 1882, claiming a user since 1861, and "Dry Monopole" was registered by the same firm on the same date, a like user being alleged.

The defendants in the action moved to rectify the Register of Trade Marks, by expunging the two above-mentioned Trade Marks, on the ground that they had never been used alone, as Trade Marks, before the 13th of August 1875, the date of the passing of "The Trade Marks Registration Act, 1875," and also on the ground that they were not "special and distinctive" words within that Act.

The defendants' evidence was to the effect, that the words "Monopole" and "Dry Monopole" had never been used alone before August the 13th, 1875, but always in conjunction with other words and devices.

Mr Justice Kay's judgment.

His Lordship, in an exhaustive judgment, came to the decision that the words "Monopole" or "Dry Monopole" had never been used alone before the 13th of August 1875, but always in conjunction with something else, namely, the name of the firm Heidsick & Co., Rheims, and that it was intended that the name of that firm should be treated as a Trade Mark; and ultimately his Lordship came to the conclusion that there had not been either on the wrappers or corks a user of the words "Monopole" or "Dry Monopole," as to lead a person to believe it to be a Trade Mark, or the only Trade Mark. Accordingly he made an order directing the Trade Marks in question to be expunged from the Register.

It may be useful to show the view his Lordship

took of the plaintiffs' use of the word, as a guide to others.

His Lordship said: "It was impossible for any one looking at this case' (the case in which the bottles were packed) "to say which was the Trade Mark. It did not constitute such a user of the word 'Monopole' as to make the public come to the certain conclusion that 'Monopole' was the Trade Mark, and 'Monopole' only; when you had 'Dry Monopole' on some cases, and 'Monopole' on others, how was a purchaser to suppose that 'Monopole' was a Trade Mark, or that 'Dry Monopole' was a Trade Mark?"

Mr Justice Kay, in deciding this case, referred to *Spencer's* case, which was decided on the same principles, and which may be usefully referred to.

Sheffield case—"Diamond Cast Steel." Spencer's case.

This was a Sheffield case, and was a motion to expunge from the Register of Trade Marks, at the instance of Messrs Cammell and three other Sheffield firms, the words "Diamond Cast Steel," which had been registered by Walter Spencer in the year 1876, in Classes 5 and 12, for steel and files, claiming a user of twenty-four years.

The contention of the applicants was, that although the 10th Section of "The Trade Marks Registration Act, 1875," allowed any special and distinctive word or words used as a Trade Mark, before the passing of the Act, to be registered, it was decided in *Palmer's* case that in order to entitle a person to register under that section, the special and distinctive word, or combination of words, must have been used as a Trade Mark of themselves, *separately*, *i.e.*, not in combination with any other device.

The evidence showed that Spencer's firm, who

had carried on the business of a steel and file manufacturer, was entitled to a Sheffield Corporate Mark, consisting of a crescent, Z turned on one side, and a diamond, stamped on all the best qualities of their steel and files, the words "Diamond Cast Steel," as well as the Corporate Mark, and the words "Spencer, Rotherham."

Mr Justice Chitty removed the mark from the Register, holding there had been no separate user of the words "Diamond Cast Steel" as a Trade Mark.

The registered owner (Spencer) appealed, and the decision of Mr Justice Chitty was affirmed.

Their Lordships (Esher, M. R. Lindley, and Lopes) placed the matter in a very practical light. Lord Esher said: "Were those words, in fact, used as a Trade Mark before 1875? What is the test? It seems to me that *Palmer's* case says this: 'Is it usual in the trade?' How does a man use a Trade Mark in his trade? By putting it on his goods. By using it either by stamping on his goods, or by putting a label on his goods. You do not use a Trade Mark by having it shut up in your warehouse; you do not use a Trade Mark by having it put up in your warehouse; and you do not use a Trade Mark by advertising it in a newspaper. It is only by putting it on your goods, so when your goods are sold in the market, there is the distinguishing mark."

Lord Justice Lopes says: "In my opinion, they" (the words "Diamond Cast Steel") "were not used by themselves as a Trade Mark, but they were used in conjunction with something else which, with the words in question, made up and composed the Trade Mark."

There have been several other cases of the same nature, where persons have relied on the registration of their Trade Marks, with the result that they have been defeated, with the loss of their Trade Mark, on divers grounds; and, therefore, the first step which a trader should take before adopting, or even threatening, proceedings, is to be properly advised as to the validity of the Trade Mark, and let him lay the whole of the facts before his adviser, and he will very often find that the chance of loss of valuable rights is not balanced by an insignificant, but costly, fight over a fancied resemblance between his Trade Mark and that of a rival, probably not in the same trade.

The above cases will suffice upon this branch of the subject.

False representation in mark.

The next point which may perhaps be usefully considered as detracting from the right of a registered owner to adopt proceedings against an infringer, although in the result the Trade Mark may remain on the Register, is that of using a false representation, or fraudulent statement, contained in his own Trade Mark.

Lord Justice Mellish, in the case of *Ford* v. *Forster* (the Eureka Shirt case), which has been already referred to on another point, laid down this principle: "If the Trade Mark contains a false representation, calculated to deceive the public, a man cannot, by using that which is in itself a fraud, obtain any right at all in the mark."

Use of the word "patent" when expired.

There are many ways in which a false representation or false statement can be made; if, for instance, a person states in his Trade Mark that he has an existing patent, to which he is in fact not entitled,

and this false statement has in many instances proved fatal to a plaintiff's claim.

The word "patent" must be used on the Trade Mark itself, and collateral misrepresentations made by the plaintiff by advertisements in the newspapers will not, as a matter of course, disentitle him to relief.

Cheavin v. *Walker*—The "Filter" case.

Cheavin v. *Walker* (decided in May 1887) was a case which clearly shows the principles upon which the Court acts with reference to the improper use of the word "patent."

The plaintiff, J. Cheavin, manufactured filters on a principle patented by his father, S. Cheavin, in 1862, but which patent lapsed in 1865; he placed on his filters a tablet with the words, "J. Cheavin's Improved Patent Gold Medal Self-cleansing Rapid Water Filter, Boston, England;" beneath there was a medallion, with the Royal Arms, and the words, "By Her Majesty's Royal Letters Patent."

The defendants manufactured filters on the principle of the same patent, and placed on them a tablet with the words, "S. Cheavin's Patent Prize Medal Self-cleaning Rapid Water Filter, Improved and Manufactured by Walker, Brightman & Co., Boston, England."

The two filters appeared to be almost identical in appearance. The Vice-Chancellor Bacon had granted an injunction, holding that the plaintiff had acquired a right of Trade Mark in the tablet, that this right had been fraudulently infringed by the defendants, that the plaintiff was not deprived of his right to an injunction by his reference to the lapsed patent.

Court of Appeal reversed Vice-Chancellor Bacon's decision.

The Court of Appeal, Sir G. Jessel, M.R., Lord Justices James and Baggallay, reversed this decision, holding besides that the alleged Trade Mark was a mere inscription, and that the defendants had committed no infringement, but had merely stated the principle on which the plaintiff's filter was made by them, that the plaintiff was disentitled to relief by reason of his reference to the lapsed patent, being such as to induce the belief that it was still in force.

Jessel's (M. R.) judgment.

The Master of the Rolls (Jessel) said: "You may state in so many words, or by implication, that the article is manufactured in accordance with a patent which has expired. But if you suggest that it is protected by an existing patent, you cannot obtain the protection of representation as a Trade Mark. Protection only extends to the time allowed by the state for the patent, and if the Court were afterwards to protect the use of the word as a Trade Mark, it would be in fact extending the time for protection granted by the statute. It is therefore impossible to allow a man who has once had the protection of a patent to obtain further protection by using the name of his patent as a Trade Mark."

Lord Justice James said: "It is impossible to allow a man to prolong his monopoly by trying to turn a description of the article into a Trade Mark. Whatever is mere description is open to all the world."

False representation. Tobacco trade.

Two important cases in connection with the tobacco trade illustrate very completely the principles upon which the Court proceeds where the plaintiff's whole Trade Mark consists of a false re-

presentation, but it must be said, on behalf of the plaintiffs in those cases, that the practice has been a common one for many years, to sell British made cigars, or cigars not of Havana make, in boxes labelled to represent that they are of Havana make. Hundreds, and it may be thousands of labels have been so used for years, and until the cases of *Wood* v. *Lambert* and *Newman* v. *Pinto* occurred, there was nothing to show that there was any illegality about it, at all events in England.

In America a case had been decided in 1869 which established the same principles, but this was not probably known to the English tobacco trade.

The facts, arguments, and judgment are very instructive, and so accurately explain the principles which guided the judges of the Court of Appeal in England in deciding the cases *Wood* v. *Lambert* and *Newman* v. *Pinto*, that it is considered useful to make a few extracts from the report of the case, which appeared in the American Reports.

American case.

Lorin Palmer was a tobacco merchant in New York, and made superior cigars, known as "Golden Crown," and which he sold in large quantities. In 1858 he devised a Trade Mark, a golden crown, and had labels printed, which he entered under the Copyright Acts of the United States. The labels were nearly square, and on the smaller was inscribed "Golden Crown," below was "L.P.," and below that "Havana." The large label was enclosed in an ornamental border; on it were "Golden Crown," below that the figure of a Golden Crown, below that, "Fabrica De Tabacos de las Majores Vegas," below that again, "De la Vuelta Abajo, Calle del agua, No 73, Habana."

The labels were used by placing a large one inside the cover of the cigar box, and a smaller one over the edge of the box, where the cover is opened.

The defendant, a printer, made a great number of counterfeit labels of the plaintiff's Trade Mark, for persons unknown to the plaintiffs. He was notified to stop printing the counterfeit labels, but he refused; an action was brought to restrain him, and the defendant alleged that the complainant's cigars were manufactured and sold in the city of New York, and not at Havana, and that therefore the announcement upon complainant's label, "Fabrica De Tabacos de las Majores Vegas, de la Vuelta Abajo, Calle del agua, No 73, Habana," was wholly untrue, and both calculated and intended to deceive, and so being calculated and intended, was not entitled to the aid of a Court of equity for its protection.

Injunction was refused, and on the plaintiff appealing, the decision was affirmed, one of the learned judges referring to the announcement on the plaintiff's label, that it was a declaration that the cigars were the product of a "Factory of cigars from the best plantations, de la Vuelta Abajo, Calle del agua Habana." His Lordship then proceeded to refer to the maxim, "He who comes into equity must come with clean hands. . . . . The party who attempts to deceive the public by the use of a Trade Mark which contains on its face a falsehood as to the place where his goods are manufactured, in order to have the reputation which such goods have acquired in the market, is guilty of the same fraud of which he complains in the defendant."

The label stated that it had been entered as copyright at a certain office. The learned judge

said: "What is there in the fact that the design or engraving had been copy registered in the United States, inconsistent with the declaration that the cigars contained in the box were manufactured in Havana, of Cuban tobacco? . . . . It is contended, further, that the falsehood is in a foreign language, of which it is presumed that the plaintiff's customers are ignorant. Yet there is certainly enough to convey to every one who can read, that the cigars are from "Havana."

English case—*Wood* v. *Lambert.*

The case which has been already mentioned, of *Wood* v. *Lambert*, illustrates both principles which have been stated, that a plaintiff will fail to restrain another person from imitating his Trade Mark or labels, if such Trade Mark should never have been registered, or was not properly on the Register, and when it contains any false representations.

Messrs Wood in 1869, being great makers of cigarettes, made a cigarette, which they called "Eton." In 1876 they registered the word "Eton" for cigarettes. Before and at the time when this mark was registered, Messrs Wood had sold these "Etons" in boxes with a label on them—"St Petersburgh, P. Mavrogortato & Company, Cigarettes." They had also made these cigarettes for Messrs Lambert & Butler, and had supplied those cigarettes to them, with a Trade Mark, designed by Messrs Wood, for Messrs Lambert & Butler, "Cigarettes of the finest Turkish Tobacco manufactured by Jancal Tachta, Constantinople."

An injunction was claimed against the defendants, Lambert & Butler, to restrain them from infringing the plaintiff's Trade Mark, "Eton." When the defendants moved to rectify the Register by taking

off the Trade Mark, the plaintiff succeeded before Mr Justice Pearson, but on appeal the Lords Justices (Lindley, Fry, and Lopes, L.J.J.) expunged the mark from the Register, on the ground that the plaintiff (Wood) having used the word "Eton" in conjunction with the names "P. Mavrogortato" and "Jancal Tachta," it was not distinctive of his manufacture, and ought not to have been registered.

The learned Lords Justices decided the case on the ground that no one would understand from the names on the boxes and the addresses, St Petersburgh and Constantinople, that the cigarettes were made by Messrs Wood, and notwithstanding the expiration of five years from registration, the mark was removed.

The next case which will be mentioned exemplifies the principle which has been referred to in a very clear light, namely, that where the plaintiff's mark is composed of elements which constitute a false representation, the Court will not give any relief. It is very similar in its circumstances to that of the American case.

Havana label on German cigars. *Newman* v. *Pinto.*

It was the case of *Newman* v. *Pinto*, and the circumstances are these. Newman (the plaintiff), trading as Nathan Newman & Co., cigar and tobacco manufacturers, registered, in 1883, a Trade Mark for cigars, consisting of an artistic design of a female warrior with a child on either side of her, each child holding a shield, which, as registered, had their centres in blank; at the top of the label were the words "La Pureza."

The plaintiff sold cigars in boxes, bearing the registered label, but the shields were filled in with

the arms of Spain in one, and the arms of Havana in the other shield.

The label was placed on the ends of the boxes, and a similar label was placed inside each box. On the top of the boxes were branded within a circle the words, "La Pureza—Habana—Ramon Romnedo." There was also on each of the boxes a lock, or seal label, which comprised, among other things, "Ramon Romnedo" printed as a signature.

The cigars on the boxes were admittedly not made in Havana, but were alleged to be made of Havana tobacco.

The plaintiff brought an action against the defendant, who was selling cigars in boxes got up in exactly the same style as the plaintiff's.

The defendant contended that the plaintiff was not entitled to relief, because the plaintiff was guilty of misrepresentation by the manner in which he used "Habana" on his boxes, and there was another defence, that the plaintiff was not using his Trade Mark as registered.

Mr Justice Kekewich tried the case, and the plaintiff's witnesses proved a great number of instances of the use of the word "Habana" upon cigars not made in Havana, and said the word "Habana" merely denoted shape, and in a very lengthy judgment, Mr Justice Kekewich granted an injunction with costs.

The defendant appealed, and the appeal succeeded, on the ground that the plaintiff's boxes, taken as a whole, conveyed a misrepresentation that the cigars were manufactured in Havana, when they were not, and that the plaintiff, whether the misrepresentation was successful or not, was engaged in a fraudulent

trade, and could not invoke the aid of the Court to protect such trade.

Lord Justice Bowen said, with reference to the name "Ramon Romnedo," it was "a name intended to appear to the English purchasing public as a Spanish name. Following the name of a Spanish brand, and 'Habana,' it seems to me it is intended, I will not say to state, but to suggest to the purchaser, that 'Ramon Romnedo' is an existing person, or was an existing person, who has something to do with Havana, and with a Havana brand; and, secondly, that he has something to do with the cigars inside. . . . Can it be said that that box, taken as a whole, does not represent to the mind of a person who would look at it,—he would very likely not believe it, because I think it is quite true that persons who are accustomed to buy cigars do not believe much what they are told on the outside of a box, any more than a person who buys a horse believes what the ostler of the horse-dealer tells him,—that these cigars—the manufactured article inside—are connected with Havana to some further extent than the mere connection which arises out of the fact that they are made of the Havana leaf? It surely represents that in the manufacture of the cigars some Havana house is concerned, somebody who is entitled to use the name or *facsimile* of the signature, 'Ramon Romnedo.' Well, that is absolutely false. This box is made in Germany; the whole of these pictures are devised in Germany; the signature 'Ramon Romnedo,' who is a person that never existed, is put on in Germany; and the whole thing is a simple sham. . . . I think that no Court of justice can assist a man who is engaged in that operation."

Lords Justices Cotton and Fry delivered lengthy judgments to the same effect. The appeal succeeded, but the defendants were not entitled to the costs of the defence in the Court below.

Lord Justice Fry stated: "We have before us the case of two fraudulent tradesmen, each of whom is desiring to defraud the public by asserting rights against one another in this Court."

There are many other instances of the mode in which a plaintiff may be deemed guilty of such an amount of misrepresentation as to disentitle him to relief, but enough has been said here to exemplify the principles upon which the Courts always act in such cases.

CHAPTER VIII.

DEFENCES.

NATURALLY it follows that whatever circumstances deprive a registered owner of a Trade Mark from any relief against a person who is alleged to be infringing his registered Trade Mark, the defendant, when sued, can take advantage of these circumstances as a defence, but as will have been seen from the case above mentioned (*Newman* v. *Pinto*), if his own conduct is fraudulent, although in equity no relief can be granted against him, he is not entitled to the costs of his defence.

As to the imitation.

In the first place, if the claim of the plaintiff is founded on imitation, this is, as the late Master of the Rolls (Sir George Jessel) frequently said, a matter of "eyesight," is the alleged imitation so like the registered Trade Mark as to be calculated to deceive? It may be that the dissimilarities are greater than the similarities, but it is impossible to lay down any principles, or even indicate any, with regard to a label or ticket, for instance, which would be so deemed when used on the same description of goods. It is quite plain from the principles which have been enunciated by eminent Judges, it is not necessary that there should be exact identity. The fact that a man puts his own name on the goods was proved not to be a good defence in many cases—*The*

Singer Manufacturing Company v. *Wilson, Siegert* v. *Findlater, Lever* v. *Goodwin, Wotherspoon* v. *Currie* (Glenfield Starch Case), amongst probably many others.

Is the Trade Mark valid?

Some of the principal defences necessarily will be whether the plaintiff's Trade Mark is valid in itself, whether it was properly placed on the Register, whether it is being used as registered, and whether it contains false representations, or the like, which have been fully explained in reference to the cases of *Cheavin* v. *Walker, Wood* v. *Lambert,* and *Newman* v. *Pinto.*

If the defendant is advised that the plaintiff's mark is an invalid one—not distinctive of the plaintiff's goods, when placed upon the Register—if it was common to the trade when registered—if it was not properly on the Register, from any other cause, to use the language of Lord Justice Cotton, in *Edwards* v. *Dennis,* the defendant will be advised not only to enter a defence to an action, but at once to move for an order to rectify the Register, by removing the objectionable mark therefrom; and whether it has been on the Register for five years, or more than five years.

It has been seen that a mark has been removed from the Register when registered in 1876 (*Wood* v. *Lambert*), and in *Behrens & Whittaker* it was removed after twelve years' registration. Spencer's mark, registered in 1876, removed in 1886.

It may be that a name is open to the public on account of long delay in taking proceedings, and has become a name that any one can use, such as "Worcestershire Sauce," "Reading Sauce," "Harvey's Sauce," owing simply to the neglect of the pro-

prietors of the original names to assert their rights, or for some other reason.

Whether name given to a new article and registered becomes *publici juris.*

It has been argued that a name which is given to a new article becomes *publici juris,* whether registered or not, and that a person will have great difficulty in preserving such name, if it came to mean an entirely new product, or article of manufacture.

This will be treated fully in a subsequent chapter, and all that it is considered necessary to say here is, that by the Registration Acts, a person is allowed to take a name, or invented word, or invented words, or words having no reference to the character or quality of the goods, and not geographical. The law says, he is to have a *prima facie* right during five years, and an absolute right after the expiration of five years, and renewable on payment of certain fees. Because he uses this valid Trade Mark, consisting of a word on a new article, the product of his ingenuity or skill, and he does not choose to patent it, or it may not be the subject of a patent, why should the rest of the trading community, for their own advantage, be permitted to take this registered Trade Mark, and with it the product of the first inventor's brains, and possibly large expenditure of money in making the thing known? It would not be for the benefit of the public, because the public can always obtain the article from the original manufacturers, who alone appear to be justly entitled to it.

The principle is different with regard to a word or name used upon a patented article which is open to be used by the public after the expiration of the patent, although, as before observed, it is by no

means clear that this will be the result, if the word has been properly registered under the Acts.

The *Linoleum* case, however, and the *Singer* case, and a few others, were decided, it is submitted, on different principles, and even in these cases the patentee had a certain monopoly, and he chose to explain his invention in a written specification, open to the world, and with all the consequences attaching to it.

Acquiescence.

The defence, which can be founded on what is called the plaintiff's acquiescence, sometimes merely deprives the latter of his right to an interlocutory injunction, but at the hearing of the action the case may be different: "there must be such acquiescence as to amount not only to a positive licence, but to an implication of an implied grant, before the plaintiff can be for ever deprived of his rights."*

***Fullwood* v. *Fullwood*.**

In *Fullwood* v. *Fullwood*, Mr Justice Fry laid down that mere lapse of time, short of the stated period fixed for the limitation of actions, would not deprive a plaintiff, in an action for infringement of a Trade Mark, of his right to an injunction.

Defence of user of the same mark.

In many cases the defence is that the defendant has been using the infringement for a number of years, more or less; but it has been decided that the evidence must show, not merely that the plaintiff might have been aware of the infringement, but that he actually was so, and with such knowledge he did nothing to assert his rights.

***Oakey* v. *Dalton*. User for twelve years not known to the plaintiff—no defence.**

In the case of *Oakey & Sons* v. *Dalton* (the Wellington Knife Polish case) the defendant alleged that he had been continually using the imitation label for a period of ten or twelve years, and the

* Sebastian, 3rd ed., p. 224.

argument upon this was that he had been enjoying an extensive trade, which ought not to be interfered with by injunction. Mr Justice Chitty came to the conclusion, on the evidence, that although there had been some business on his part, the nature of the business had been of a tentative character; he was of opinion that there had been fraud in the inception of the business, and that the continued trading had been a continuation of the fraud, and not one of the plaintiff's witnesses had heard of this trading on the part of the defendants. Defendant's counsel had given the figures at 18,000 tins, running over a period of ten years, or about 1,800 tins a year, averaging £25 a year. This his Lordship called, with regard to a business of this class, trumpery, as against the plaintiff's trade of two millions.

"Hole-and-corner" user of defendant.

It is, of course, always a matter of evidence whether a defendant who has actually been using the imitation for a considerable, or any, period, can succeed against the plaintiff's rights; but he certainly will not do so, if the trading has been in a "hole-and-corner manner," and the plaintiffs have never heard of it.

Putting defendant's name on label—no defence.

It has already been stated that the defendant cannot avail himself of a defence formed on the fact that he has used his own name in conjunction with the Trade Mark in dispute, and there are a great mass of authorities to this effect. The cases of *Seigert* v. *Findlater* and *Lever* v. *Goodwin* (Sunlight Soap), *Wotherspoon* v. *Currie* (Glenfield Starch), have been cited to this effect.

Lever v. *Goodwin* (Sunlight Soap Wrapper).

In the former case, this is the way Mr Justice Chitty dealt with this point: "A point, and a strong point, which was made for the defendants was, that

their name appeared, and so it does. I am afraid that it is that which led the defendants, when they were preparing their wrapper, to think that they could escape. If I put my name on it, I can then always say that my name would not be mistaken for the plaintiffs', but unfortunately for them, and for their point of view, but fortunately, I think, in the interests of justice, that is not a sufficient answer."

Lord Justice Cotton dealt with the same argument, in a similar manner. "It is very true that *Goodwin's* name does appear here (on the wrapper), as the maker or the wholesale seller of this particular soap; but it is quite contrary to experience, quite contrary to what one sees upon the evidence to suppose, that every one, every woman, every man, when buying a packet of tabular soap, from a store or from a shop, looks to the name particularly, or to those things which are printed on the outside, for the purpose of determining whether what he has bought is that which he has been accustomed to, or that which he knows is good, or whether it is something else."

Trade Mark not used as registered.

An important point has arisen in more than one case, and it may be open for a defendant to say, the plaintiff is not using his Trade Mark as registered. On this point Mr Sebastian says, it is an inoperative defence "that the plaintiff in practice uses devices on his Trade Mark which are not registered, as part of themselves, filling in blank spaces with coats of arms," and he refers to the case of *Newman* v. *Pinto*, already fully referred to before, Mr Justice Kekewich, and other cases.

It appears, however, from the cases referred to,

that it depends very much upon the circumstances of each case, whether a Court will decide against a plaintiff, who is in practice, using his Trade Mark differently to the registered mark.

Newman v. Pinto.

In *Newman* v. *Pinto* it is true that Mr Justice Kekewich (whose judgment was reversed on another point) did not decide the case against the plaintiff, on the ground that they had filled in two shields, on the label, which in the registered mark were in blank, with the arms of Spain and Havana, when used on boxes of cigars, on the ground that the defendants were using identically the same label as the plaintiff. His Lordship, however, gave considerable attention to a case which was decided on circuit by Lord Justice Baggallay, not otherwise reported than in a Trade Journal, taken from the shorthand writer's notes.

Godfrey Phillips & Co. and Ogden. The "Guinea Gold" case.

This was a case in which an action was brought by Ogden against Godfrey Phillips & Sons, tobacco and cigar manufacturers, for infringement of the plaintiff's label, which contained the words "Guinea Gold," with certain representations, whereas the defendants were using the words "Sweet Guinea Gold," with an autograph signature of the firm. Mr Justice Kekewich, in his judgment in *Newman* v. *Pinto*, said: "And Lord Justice Baggallay in giving judgment, though he attributed great importance to the deviation from the registered Trade Mark of the plaintiffs, rested that importance entirely on the argument that it must be compared with what the defendant had done. . . . To my mind, that judgment of Lord Baggallay, which I do not for a moment doubt is correctly reported, and is sound, has no application to the present case."

Melachrino v. Melachrino.

In *Melachrino* v. *Melachrino & Co.* it was held by Mr Justice Chitty, that the plaintiffs were not disentitled, because they placed the word "registered" on their Trade Mark, as used, though if different from the registered Trade Mark, in having what were blank spaces in the latter filled in with coats of arms; but as will be seen from the judgment of the learned judge, he rested his judgment on other points.

Ellis v. Ruthin Soda Water Company.

At an early stage of Trade Mark registration, Sir George Jessel, Master of the Rolls, said, in *Ellis & Sons* v. *Ruthin Soda Water Company,* "As I understand the Trade Marks Act, if you come for Trade Mark, and not for actual fraud, you can only sue in respect of what you had registered as a Trade Mark."

Advisable to use marks strictly as registered.

It is undoubtedly an unsafe practice for a Trade Mark owner to alter his Trade Mark from that which he had registered, and what appears in the *Trade Marks Journal,* but the circumstances of the case must be considered as to the plaintiff's conduct in this respect, and as to the defendant's conduct, whether the Court will now on that ground alone deprive a plaintiff of a remedy.

CHAPTER IX.

CASES OF IMITATION OF MODE OF PUTTING UP GOODS.

BESIDES the infringement of a Trade Mark by taking the identical thing itself, or by using a colourable imitation of a label or a wrapper, which of itself may be registered as a Trade Mark, a trader may claim to put up his goods in such a distinctive fashion as to denote to the public that such a mode denotes his goods and no other.

This may be done in divers ways—by using distinctive wrappers, by using packets of a certain colour and appearance, the use of bottles of a particular pattern or design.

It has been said also, apart from Trade Marks, a word or words may be so used by a person in fraud of the rights of another, as to bring the case within the old common law doctrine of passing off goods as the goods of another.

In America there are numerous cases which have been decided with regard to bottles or barrels of a peculiar design, or other mode of packing goods, and which have been restrained.

In England, the cases which at all events appear in the Law Reports from the earliest times up to the present, have been apparently few in number. One of the most important was that of *Siegert* v. *Findlater*, before Mr Justice Fry (now Lord Justice Fry) in 1878.

The "Angostura Bitters" case.

The plaintiff manufactured a fluid sold under the name of "Angostura Bitters;" this was sold in bottles covered with a wrapper. The defendant manufactured also a fluid which he called "Angostura Bitters," and sold it in bottles and wrappers of a similar description to the plaintiff's, using the name "Angostura Bitters," and further imitating the plaintiff's wrappers.

The Court held that he could not be restrained from using the name in case he should ever discover the plaintiff's secret, and manufacture the fluid, but he must be restrained from using the name so as to deceive the public into the belief that his fluid was the plaintiff's.

In the course of the argument, Mr Justice Fry remarked that he was disposed to think that in the whole get up of the defendant's goods there had been an attempt to make them like the plaintiff's.

After giving judgment upon the question of the right to use the word "Angostura," his Lordship said: "The substantial question which, in my opinion, arises is this, whether the wrapper used by Meinhard (the defendant), and the general form in which his bottles are made up, have been adopted by him for the purpose of representing that his goods are the goods of the plaintiff, and whether those wrappers and that general form are calculated to produce that effect. That seems to me to be the main question which I have to try." His Lordship then having referred to the great similarity in the "get up" of the plaintiff and defendant's articles, the bottles being very much of the same form and size, the sealing-wax closely alike in colour and in general effect, the two articles being ex-

ceedingly alike, and in comparing the characteristics of the wrappers, the intention was brought irresistibly to his mind, said: "Is there any reason in the nature of things, in the character of the business, or the characters of the product, which should produce this community, I might almost say this identity of general form, in the absence of a desire to deceive?"

An injunction was granted in the general form to restrain the use of the bottles and wrappers in question.

Mere presence of the name of the manufacturer is not conclusive that there is no attempt to palm off the goods as those of the other manufacturer.

Although there may have been other cases in which the doctrine of passing off goods as the goods of another man have assisted the Courts in coming to a decision, no case has ever occupied the time of the Courts, of more importance, and which more clearly exemplifies and lays down the correct principles which will guide the Courts in future cases, than that of *Lever* v. *Goodwin.*

Lever v. *Goodwin.* The "Sunlight" Soap Wrapper case.

The case is fully reported in the Law Reports (36 Chancery, Division 1), and at considerable length, together with reprints of the plaintiff and defendant's wrappers, in Cutler's "Reports of Patent Designs and Trade Marks," vol. iv. p. 492.

The circumstances of the case were these:—

Messrs Lever & Company in 1884 adopted the word "Sunlight" to distinguish their soap, and registered this word as a Trade Mark. They put up their soap in the market in 12 oz. tablets, a form never before used for soap. On the top of each tablet they stamped their Trade Mark. The tablets

were wrapped in wrappers made of imitation parchment paper, and on each wrapper was printed some letterpress in broken type, which consisted in this—there are two kinds of type, and there are large capital letters, in which some of the words are expressed, with the result that you can read off the words in capital letters as a distinct statement or a distinct question.

Messrs Lever spent large sums of money in advertising the soap, which they put upon the market. The sale of the soap became very great.

Early in 1885 they discovered that the defendants, who were universal soap manufacturers, were selling soap in 12 oz. tablets, on the top of which was stamped their name and a descriptive term for the soap, such tablets being wrapped in wrappers made of imitation parchment paper, on which was printed letterpress, being a kind of paraphrase of the plaintiffs' letterpress, printed in broken type, as before explained.

Messrs Lever requested Messrs Goodwin to abandon this wrapper, and this being refused, Messrs Lever commenced an action, claiming an injunction to restrain the defendants from passing off their soap as or for the plaintiffs' soap. There was another question as to a Trade Mark, but that has no bearing on the question here being discussed.

For the plaintiffs a number of witnesses were called, who spoke to the novelty of the get up of the plaintiff's soap, and to the fact that, in their opinion, the get up of the defendants' soap was calculated to deceive. The defendants contended that the get up of the defendants' soap was not such an imitation of the plaintiffs as could be

objected to. The plaintiffs had no monopoly of the twelve oz. tablets, or broken print, or imitation parchment paper. Besides, the defendants' name appeared prominently on the wrapper. It was stated on behalf of the plaintiffs, that they did not claim any monopoly in twelve oz. tablets, or imitation parchment paper for wrappers, or broken type separately; but they claimed the combination, which, it was contended, was copied, and, on the evidence, copied intentionally by the defendants.

Mr Justice Chitty's judgment.

Mr Justice Chitty gave a most exhaustive judgment, and after disposing of the Trade Mark question, stating the facts as above mentioned, said: "The law on this head is plain. It is founded on fraud. The simplest case is where the seller misrepresents to the buyer that the goods which are being offered for sale are the goods not of the person who made them, but of some other manufacturer. That is a simple case between the buyer and the seller. Then there comes the case, which is a simple one also, and one that does, I am sorry to say, occur, when the manufacturer, by subtle devices, which are to accompany the goods on their sale in the market, gets them up in such a form as to be calculated to deceive the ultimate buyer into the belief that the goods which he is putting on the market are the goods of some other maker. Here generally a double fraud is committed: first, there is the fraud which is perpetrated, when it is successful, on the ultimate buyer; and secondly, there is a fraud perpetrated or committed upon the other manufacturer, who loses his trade." Then his Lordship, having quoted several apposite passages

from the judgment of Lord Langdale, in the case of *Croft* v. *Day*, which have been already referred to, and also passages from the judgments of Lord Cranworth in the case of *Seixo* v. *Provezende*, already referred to—went on to say: "No defendant ever, so far as I know, puts forth an exact copy. The imitation would be too gross, and consequently, I am sorry to say, I have known that in many cases what is done is this: He tries to take many of the striking points in his adversary's wrapper, or the like; then he puts in certain points of distinction, to which, when the matter is brought before a Court of justice, he can refer, and say, 'You say they are alike! Why, see here, there are so many points of distinction!' That curiously enough appears to have been the case in another action which was tried before me, in which Messrs Lever were the plaintiffs; and I have had cases in which, when the document has been produced, it has been that there have been cunning alterations here and there, the intention being to make it as like as it can be, for the purpose of deceiving the ultimate purchaser, and still reserving a loop-hole for escape, when the matter is brought into Court, by saying that the two things are not alike."

Judgment of the Court of Appeal.

The defendants appealed; and the judgment of Mr Justice Chitty was approved.

Lord Justice Cotton.

Lord Justice Cotton said, in referring to the contention of the defendants: "'There is no monopoly in this parchment paper; there is no monopoly in the spaced printing, then why should I be restrained in carrying on business from using those things as to which the plaintiffs cannot claim any monopoly whatever?' That was an obvious fallacy.

There may be no monopoly at all in the individual things separated, but if the whole are so joined together as to attempt to pass off, and to have the effect of passing off, the defendants' soap as the plaintiffs', then, although the plaintiffs had no monopoly even in parchment paper, or in spaced printing, yet, if those things in which they have no sole right are so combined by the defendants as to pass off the defendants' goods as the plaintiffs', then the defendants have brought themselves within the common law doctrine, in regard to which equity will give to the aggrieved party an injunction, in order to restrain the defendant from passing off his goods as those of the plaintiffs."

Lord Justice Lindley.

Lord Justice Lindley said: "What is called 'the general get-up,' which is an expression used by some of the witnesses, is so similar that I cannot suppose for a moment there would be the slightest difficulty in mistaking the one for the other. Of course, in all these cases there are differences, as well as resemblances, and the question, so far as the packages are concerned, must always be decided by contrasting the resemblances—the striking resemblances—with the striking differences,"

Abbot v. *Bakers and Confectioners' Tea Association.*

A similar case came before the Court of Appeal in *Abbot* v. *Bakers and Confectioners' Tea Association,* many years before *Lever* v. *Goodwin,* when an injunction was issued, restraining the defendants from using wrappers which were an imitation of those of the plaintiffs'; and, on appeal, the Lord Chancellor said, that though no one mark was exactly imitated, the combination was very similar, and likely to deceive; that it was true there was no proof that anyone had been deceived, or that

the plaintiffs had incurred any loss; but where the similarity was obvious, it was not of any importance. Appeal dismissed, with costs.

American decision.

An American decision of great importance was that of the New York Supreme Court, in the case of *Lea* v. *Wolf*, which is to the effect that where the defendant puts up for sale his manufactured article with labels and wrappers which are a colourable imitation of those used by the plaintiff, *e.g.*, where the colour of the paper, the words used, and the general appearance of the labels show an evident desire to give a representation of those used by the plaintiff, he would be enjoined from so doing; and the fact that he puts his own name on the wrappers, as the manufacturer of the article, will not prevent it being an infringement of the plaintiff's Trade Mark.

Another important decision of the same Court was in *Brown* v. *Mercer*, and is to this effect: That where a person, by a combination of elements and symbols, has produced a wrapper to enclose and designate an article manufactured by him, under which it has gone into use, he cannot be interfered with, or despoiled of his lawful business, by the adoption of a label by another, similar in colour, size, border ornamentation, and coloured ink, and so closely an imitation that the careless or unobservant purchaser may readily be misled. Such practices are deceptive, and have their origin in, and promote, dishonourable competition. In order to justify the intervention of the Court of equity, it is sufficient that the imitation is so close that a crafty vendor may palm off on the buyer the article manufactured by the latter as that of the

former. It is not necessary to an application for an injunction that, in certain particulars, the label of the defendant differs from that of the plaintiffs, so long as the imitation, in other respects, is so close that the general appearance is the same, and purchasers have been, and are, likely to be deceived.

Another decision may also be usefully referred to of the same Court, in *Cook* v. *Stärkweather*, which was to the effect that although the name adopted by dealers for their article be not one to the exclusive use of which they are entitled, the peculiar style of the package in which they put up the article, and the combination constituting the label, may be protected.

Where a peculiar device is applied to a box or barrel, specially prepared to advertise, special preparations of the box or barrel constitutes a part of the Trade Mark, and may participate in the protection.

This principle was applied to protect plaintiffs in the use of a barrel with a red rim, and a glazed surface on the head, with the letters "A.A.A." and a Maltese cross, and to enjoin defendants from using a similarly-prepared head, with the letters "X.X.X." and a crown.

The American Courts, according to Mr Coddington, have even gone to the length of protecting plaintiffs in the use of a stick, upon which they rolled their carpets for many years, and which, having been put into the centre of their rolls of carpet, they claimed to be their Trade Mark. The stick consisted of two pieces, ground on the inside, so that when the two pieces were put together they

formed a shell with a rectangular opening, with the outside corners rounded off, so that the ends of the stick or shell formed an octagon, and were visible at each end of the roll of carpet, and in this, and other respects, were stated to be peculiar to the plaintiffs.

The defendants had commenced to sell carpets rolled upon sticks resembling the sticks used by the plaintiffs, and the evidence in that case showed that such sticks in rolls of carpet indicated to the public that the goods containing them were made by the plaintiffs, and that anyone seeing such shells in carpets, would suppose them to be the plaintiffs' goods, and that the use by the defendants of the said sticks would deceive the public.

French decision.

It appears that the French Courts take the same view with regard to the imitation of wrappers, and also with regard to some special seal, or bottle corks, where the colour of the wax is the same, and the bottle is the same. It is called an action for "concurrence de loyale," but in some foreign countries, notably in Holland, the same view is not taken.

In a case in France, which was decided by the Court of Appeal, the plaintiffs were manufacturers of solid laundry bluing in cakes in the form of sad-irons, with the raised figures of women on one side, in the act of ironing, and on the other of washing, or placing clothes on a line to dry. Regular deposit was made of the mark.

The defendants made their blue also in the form of sad-irons, with the figure of a woman in the act of washing or ironing. It was held that the defendants had infringed the marks and emblems

adopted by the plaintiffs, and the fact that the bluing of defendants bore their name was unimportant, as the difference in name did not justify the usurpation of a mark which most generally guides a purchaser.

CHAPTER X.

FRAUDULENT USE OF A NAME BY PERSONS OF THE SAME NAME.

THE foundation of the right of a person to restrain another person of the same name from carrying on business in his own name, is based on fraud or false representation. This must be proved to the satisfaction of the Court, otherwise no person can be prevented from carrying on business in his own name, dealing in the same description of goods as those of perhaps a better known trader. In one or two cases it was said that fraud was not an absolutely necessary ingredient, so that the matter has been left somewhat in doubt, whether absolute fraud must be shewn, or the possibility of mistake, to induce the Court to interfere.

Foundation of right is fraud.

One of the earlier cases which exemplifies this doctrine was that of *Burgess* v. *Burgess* (in 1853), where the plaintiff was the manufacturer of "Burgess' Essence of Anchovies," at 107 Strand. The defendant, his son, having been in his employ, set up business, and called the articles he made "Burgess' Essence of Anchovies."

Burgess' Anchovy case.

An injunction was refused by V.-C. Kindersley, and on appeal it was held that, in the absence of fraud, the defendant could not be restrained from using his own name, as describing his article, as being what in fact it was.

In this case Lord Justice Turner said: "Where a person is selling goods under a particular name, and another person, not having that name, is using it, it may be presumed that he so uses it to represent the goods sold by himself as the goods of the person whose name he bears; but where the defendant sells goods under his own name, and it happens that the plaintiff has the same name, it does not follow that the defendant is selling his goods as the goods of the plaintiff. It is a question of evidence in each case whether that is false representation or not." Lord Justice Knight Bruce gave the following quaint explanation of the same principle: "All the Queen's subjects have a right to sell their articles in their own names, and not the less so that they bear the same name as their fathers. The defendant carries on business in his own name, and sells his Essence of Anchovies as 'Burgess' Essence of Anchovies,' which in truth it is."

Holloway's case.

In *Holloway* v. *Holloway* the circumstances were different, because the brother, Henry Holloway, of the plaintiff, the well-known Thomas Holloway, sold pills and ointment, in pill boxes, pots, and with labels and wrappers, similar to those used by the plaintiff, the original manufacturer. It was held in that case by Lord Langdale, the Master of the Rolls (in 1850), that the defendant's conduct was intended and calculated to deceive, and on this ground an injunction was granted, but it was expressly stated that "the defendant's name being Holloway, he had a right to constitute himself a vendor of Holloway's Pills and Ointment," but not in such a manner as to deceive the public, and make them

believe he was selling Thomas Holloway's pills and ointment.

Lord Justice James put the matter very clearly in the case of *Levy* v. *Walker*, in which the right to a continuance of a former name in a partnership arose. "It should never be forgotten in these cases that the sole right to restrain anybody from using any name he chooses to carry on is a right in the nature of a Trade Mark: that is to say, a man has a right to say, you must not use a name, whether fictitious or real, you must not use a description, whether true or not, which is intended to represent or calculated to represent, to the world that your business is my business, and so by a fraudulent misstatement, deprive me of the profits of the business which would otherwise come to me. That is the principle, and the sole principle, on which this Court interferes. The Court interferes solely for the purpose of protecting the owner of a trade or business from a fraudulent invasion of that business by somebody else."

Whether there are circumstances of fraud.

This class of case therefore affords great scope for ingenuity, to ascertain whether there have arisen those circumstances, or *indiciæ* of fraud, which must be shown, to induce the Court to grant any form of relief.

Freeman's Baking Powder.

One of the most instructive cases is perhaps that of *Freeman* v. *Freeman*, which was tried before Mr Justice North a few years back, and from which it can be gathered what are those circumstances of fraud which are sufficient to induce the Court to hold that the defendant is carrying on business in a manner intended and calculated to deceive.

Freeman & Hilyard had for many years carried

on the sale of "Freeman's Baking Powder," and in 1876 they registered as a Trade Mark, the front of the label used on packages. The sale was very large, and their article had become recognised in the trade, and asked for by customers as "Freeman's."

The defendant carried on business for some time as a china and glass merchant, then he took up the ironmongery business, and subsequently he added to that business that of an oil and colourman, provision dealer, and other matters of that kind, and for the first time commenced to deal in baking powder, being with some small exception supplied by the plaintiffs. It was shown that defendant knew plaintiffs' article, as he produced invoices, in which the baking powder was described as "Freeman's." It was proved to the satisfaction of the judge that when the defendant commenced to make baking powder he sold and put it up in packets very like those of the plaintiffs. There was evidence produced to the Court as to the sale of defendant's baking powder to the plaintiffs, when "Freeman's" was asked for.

Mr J. North's judgment.

His Lordship, after narrating a few facts, said: "It was clear that the plaintiffs' baking powder was known by the name of "Freeman's," it was clear that the defendant had a right to sell baking powder, and to use his own name and address, but it was incumbent upon him to use his own name in such a way as not to represent that the goods made by him were really the goods of somebody else. He thought that the name "H. Freeman" had been placed in a conspicuous manner upon the packages by the defendant in order to identify his

baking powder with the name of Freeman. In addition to that there was the fact of the packet being of the same size, the boxes of the same shape and size, and the advertising that the powders were sold in 6d. and 1s. tins, when, upon the defendant's own evidence, he had never sold any tins. He also thought that the use by the defendant of the plaintiffs' show cards had not been sufficiently explained."

An injunction was granted, restraining the defendant from selling, or offering for sale, or attempting to pass off, any baking powder not manufactured by the plaintiffs, as and for the goods of the plaintiffs. The defendant was also restrained from using the label.

Warner v. *Warner*. Warner's "Safe Cure."

A more recent case was that of *Warner* v. *Warner*, tried before Mr Justice Stirling, who granted, on the motion of the plaintiff, an interlocutory injunction, on the same facts as were proved on the trial.

The defendant appealed to the Lords Justices, but the decision of Mr Justice Stirling was affirmed.

The plaintiff was the manager and sole proprietor of certain medical preparations, which were first introduced in the year 1879 under the name of "Warner's Safe Cures," for various ailments, and had been since sold in large quantities. He had very extensively advertised his compounds in England, the United States, and elsewhere, and they had been known in the market as "Warner's Safe Cures." The defendant was discovered selling a medical preparation of his own, under the title of "Warner's Great Cures," and "Warner's Cures."

The following circumstances were proved to the satisfaction of the Court. The defendant began life

as a carpenter, and afterwards became a master builder. In 1888 he saw an advertisement in a newspaper by a Mr Ashton, who carried on business in Chancery Lane as a manufacturer and vendor of certain medical preparations, some of which were sold as "Ashton's Great Gout and Rheumatic Cure," and as "Ashton's Great Asthma Cure." The defendant became sole proprietor of the business, and soon after he began to alter the labels used by Ashton. First of all he designated his preparations as "Warner's, late Ashton's," and afterwards he further altered them, so that they ran "Warner's Gout and Rheumatic Cure,—sole proprietor, J. Warner."

Mr Justice Stirling's judgment.

His Lordship said: "True it was that every man had a right to carry on his own business in his own name, but that proposition was subject to this qualification, that he did so honestly." His Lordship then referred to "Burgess and Burgess," and quoted the portion of the judgment of Lord Justice Turner, which is above referred to. He also referred to other circumstances which had been proved, as to certain letters which had been sent to the defendant, asking for "Warner's Safe Cure for Rheumatism," and "Warner's Safe Rheumatic Cure," which the defendant replied to by sending his own medicine. These circumstances had great weight with the Court of Appeal, and his Lordship, who granted an injunction restraining the defendant from selling or in any manner representing any goods manufactured by him as the manufacture or goods of the plaintiff.

A few practical remarks may be usefully made here, as to the steps which are very frequently

found to be necessary in order to discover from a fraudulent imitator of another person's Trade Mark, the mode in which he carries out his practices.

It frequently becomes necessary to adduce evidence that traders are actually selling goods of one person's manufacture, when asked for the genuine article. It is thought advisable in such cases to procure evidence of this being done, and great care should be exercised as to the mode in which it is carried out, the selection of the persons who should be sent, and the directions given to such person.

A certain course adopted in several cases which were successfully decided in favour of the plaintiff, before one of the learned Judges of the Chancery Division, was stated by his Lordship to be justified, as it would be impossible to find out what people were doing unless this was done.

So in the case above mentioned. Mr Justice Stirling referred to the sending of the letters to the defendants, asking for "Warner's Safe Cure for Rheumatism," and "Warner's Safe Rheumatic Cure," and his sending his own medicine in reply. "It was a trap, and the defendant fell into it, but if he had been acting honestly he would not have been there."

That was the view taken by the Court of Appeal, on the appeal made in this case, and substantially the evidence was unchanged. Lord Justice Cotton in the appeal case specially referred to these letters, and the contention on the other side that it was a trap; but his Lordship added, that it was a trap which was only set for a man who did not carry on his business honestly.

Again, in the case of *Rodgers* v. *Rottgen*, which

has been referred to on another point, it was known that the defendant, a cutlery manufacturer in Germany, had been using, in Germany and in India, two crosses in imitation of the well-known mark of Messrs Joseph Rodgers & Sons, Limited, of Sheffield, consisting of a star and cross, and also using on packets of knives labels being almost exact copies of Messrs Rodgers' labels on similar packets, and in other ways imitating their mode of putting up their sample cards and their goods. At length it was discovered that the defendant was endeavouring to obtain orders in England for the goods so fraudulently marked and put up.

Evidence on behalf of the plaintiffs was therefore obtained, by procuring some of the defendant's goods to be sold in England, and upon this sale, both of samples and of a case of goods fraudulently marked, the action proceeded, and was decided in favour of the plaintiffs, Mr Justice Kay justifying the steps which had been taken on behalf of the plaintiffs to procure the goods.

As an illustration of a case in which the Court declined to restrain the use of a name at the instance of persons of a similar name, a very recent case was that of *Turton* v. *Turton*, decided by Mr Justice North in favour of the plaintiff, and reversed by the Lords Justices (in May 1889, Lord Esher, Cotton, and Fry).

The plaintiffs, Thomas Turton & Sons, Limited, had for many years carried on at Sheffield the business of steel manufacturers. The defendant, John Turton, had for many years carried on a similar business in the same town, at first as "John Turton," then as "John Turton & Company." In 1888 he took his

two sons into partnership, and carried on the same business as "John Turton & Sons." There was no evidence that the defendants imitated the Trade Mark or labels of the plaintiffs, or otherwise attempted to deceive the public.

It was held in that case that although there was a probability that the public would be occasionally misled by the similarity of the names, the plaintiffs were not entitled to an injunction restraining the defendants from the use of the name "John Turton & Sons."

Judgment of the Court of Appeal.

The judgment of the Lords Justices comprise the principles upon which these cases should be decided, expressed in such clear language, and the circumstances under which the Court will or will not interfere to restrain a man from using his own name are so well explained—for there is no doubt as to the interference of a Court to prevent a man using a name which is not his own—that a few extracts from the judgments appear useful to be quoted here.

Lord Esher said, as to what the defendant had done: "He had not done anything with the intent, or for the purpose, of making the use of his simple name look as if his name were the name of the plaintiffs'. In some cases, besides using the name, the parties have, to use what I think is a happy phrase of my brother Cotton, garnished that use, that is, they have done things besides using the name, in order that the use of the name might look as if it were being used by the old firm. There is nothing of that kind here. . . . Is there anything dishonest? Is there anything wrong, morally, in any, even in the strictest sense, in a man using his

own name, or stating that he is carrying on his business exactly as he is carrying it on? Is there anything wrong in his continuing to do so, because people may make blunders, and even, if you please, because they make probable blunders? What is there wrong in what he is doing? . . . Therefore upon principle, I should say, it is perfectly clear that if all that a man does is to carry on the same business, and to state how he is carrying it on —that statement being the simple truth—and he does nothing more with regard to the respective names, he is doing no wrong. He is doing what he has an absolute right by the law of England to do, and you cannot restrain a man from doing that which he has an absolute right by the law of England to do; therefore, if a man uses his own name, that is no *prima facie* case; but if, besides using his own name, he does other things which show that he is intending to represent, and in point of fact making his goods represent, the goods of another person, then he is prohibited, but not otherwise."

Lord Justice Cotton said: "In my opinion the Court cannot stop a man from carrying on his business in his own name, although it may be the name of a better known manufacturer, when he does nothing at all in any way to try and represent that he is that better known and successful manufacturer. If that were so, there would be at once a monopoly obtained in the use of names by any persons who, by carrying on business in one name, got a reputation; and it would be a very convenient way of enabling traders to prevent any competition with them by any persons who had the same name in the same trade."

Lord Justice Fry concurred in the judgment on the same principles.

Hendricks v. Montague. Fraud not essential.

It has been explained that the foundation upon which a Court will interfere to prevent a man from using the same name as an existing trader or firm, is based upon fraud or fraudulent intention; but in *Hendricks* v. *Montague,* decided by the Court of Appeal (Lord Justices James, Brett, and Cotton), Lord Justice Brett said: "It seems to me it is not at all necessary, according to the authorities, and according to the doctrine of the Court, to suppose there was any intention of fraud existing, or that there would be any in the future." Lord Justice Cotton said: "In my opinion it is not necessary that in taking the name they have, there should have been any fraudulent intention; but whether there was a fraudulent intention or not, everybody is responsible for the reasonable consequences, upon facts known to him, of what he is doing."

The action was one in which Mr Hendricks, the acting manager of "The Commercial Life Assurance Society," claimed and obtained an injunction against the promoters of a projected Company, intended to be called "The Universal Life Assurance Association," restraining them from using the name, and it was argued by Mr Chitty (now Mr Justice Chitty) that it was the taking of an invented name, so similar to the old name as to be calculated to deceive, and with the intention of carrying on a similar business, and that even if the name was taken at first, without any fraudulent intent, yet if they persisted in using it after notice that it is calculated to deceive, that is evidence of fraudulent intent. Mr Justice North based his judgment in *Turton* v.

CHAPTER XI.

NAME BECOME *PUBLICI JURIS* APPLIED TO A PATENTED ARTICLE.

THERE is no subject connected with Trade Marks which has given rise to so much difficulty, and which may do so in the future, than the question as to the rights of an owner of a patent, or his successor in business, to a trade name which has been given to a patented article, on the expiration of the patent.

Name applied to a patented article.

Some of the cases which have been decided have occurred before the passing of the "Trade Marks Registration Act, 1875," and some have been decided since; but it is believed that there has been no decision as to the effect of the registration of a name simply as a Trade Mark, given to a patented article, and whether such name can be exclusively maintained by the original patentee, or his successor in business, by virtue of the registration of such name under the Registration Act.

"Home Washer."

The words "Home Washer," applied to a patented machine, were taken off the Register after the expiration of a patent, for other grounds: that the words were descriptive, and that the registered owner was not carrying on any business.

Wheeler & Wilson Sewing Machine.

One of the earlier cases was that of the *Wheeler & Wilson Sewing Machine Company*, the facts of which were these: The plaintiffs were an Ameri-

can Company, possessed of the right to a particular kind of sewing machine, of which Messrs Wheeler & Wilson, two of the original members of the Company, had been patentees, under a patent which expired in 1866.

The plaintiffs filed a bill to restrain the defendants from selling machines other than the plaintiffs', under the title of "Wheeler & Wilson's Sewing Machines." It was held by V.-C. James, that the name "Wheeler & Wilson" on a sewing machine was descriptive merely of the character of the machinery, and not equivalent to an assertion that the machine was of the plaintiffs' manufacture. The Vice-Chancellor said: "It seems to me that the name 'Wheeler & Wilson Machine' has come to signify the thing manufactured according to the principle of that patent. That being so, I cannot restrain anybody, after the expiration of that patent, from representing his article as being the article so patented. A man cannot prolong his monopoly by saying, 'I have got a Trade Mark in the name of a thing which was the subject of a patent,' and therefore, to that extent, I think the plaintiffs are not entitled to relief."

Singer Manufacturing Company v. Wilson. Same v. Loog.

The same principle was affirmed in the important cases of the *Singer Manufacturing Company* v. *Wilson* and the *Singer Manufacturing Company* v. *Loog.*

The first case originally came before Sir George Jessell, the Master of the Rolls, and was appealed to the Court of Appeal, and afterwards to the House of Lords.

The second case was also decided on the same principles. In both cases it was decided on the

highest authority that a manufacturing company, who affixed their own device to their machines, and also their name, could not be restrained from using the Singer Company's name as descriptive of the principle on which the machines were constructed; that is to say, that the machines were Singer machines, made according to the Singer patent. It is, of course, understood that there must be no attempt to represent that the machines were, in fact, manufactured by the original manufacturers. It also appears, from the remarks of Sir George Jessel in the *Singer Manufacturing Company* and *Wilson*, that there must also be no attempt to take, as well as the name, any special distinctive device impressed or stamped on the machines made by the original manufacturers.

It will be at once seen that these are cases in which it was decided to be allowable to take the name of the original manufacturers and patentees as descriptive of the patented machine.

The "Linoleum" case.

The same principle was, however, laid down by Mr Justice (now Lord Justice) Fry in the case of the *Linoleum Manufacturing Company* v. *Nairn*, the circumstances of which are of such an important nature, that it is thought desirable to set them forth at some length, as they illustrate not only the question now being discussed, but should also act as a caution to persons registering under the same circumstances.

This was a case where a Trade Mark had been registered under the Act of 1875 by the plaintiffs, the Linoleum Manufacturing Company, the assignees of a patent for floor-cloth. The Trade Mark registered consisted of a lozenge-shaped figure (to be

used upon the floor-cloth), with the words "Linoleum Floor-Cloth" inscribed on the border of the lozenge. In the centre of the lozenge there was a *fleur de lys*, and beneath it the words, "F. Walton's Patent." The invention consisted of a new substance, namely, the solidified or oxidised oil, and it was not disputed that the inventor gave to it the name of "Linoleum."

Mr Justice Fry, in giving judgment, said: "It appears that the defendants are now minded to make (as it is admitted they may make) that substance, I want to know what they are to call it? That is a question I have asked, but have received no answer, and for the simple reason that no answer could be given except this, that they must invent a new name for it. I do not think the law stands in that way, and I think that if Linoleum meant a substance, which substance may be made by the defendants, the defendants may call it by the name which that substance bears."

The learned Judge then called attention to certain acts of the plaintiffs which evidently had weight upon his mind in deciding the case. "Then there are advertisements put out by the plaintiffs. One of these is made an exhibit, and having given their Trade Mark, and so forth, is in these terms: 'Linoleum is produced from oxidised linseed oil of the first quality and ground cork. Oxidised linseed oil is the most tenacious and indestructible cement that can be made,' and then they go on to give a warning: 'Every piece of Linoleum has a Trade Mark printed upon the back.' The Trade Mark is put in the margin in order that it may be seen. . . . They describe Linoleum as a remarkable floor-cloth, and

then warn persons against imitations. They call attention to the Trade Mark. 'Look for the Trade Mark' is the warning given to intending purchasers, evidently intended to show that the word 'Linoleum' is not of itself enough, and that those who desire to buy the goods of the Linoleum Manufacturing Company (who are the plaintiffs in this action), must look for their Trade Mark. Well, there are other indications of the plaintiffs' own use of the word. When they come to register their Trade Mark under the recent statute for the registration of Trade Marks, they are desired to describe their calling as applicants for registration, and they describe their calling as 'Linoleum floor-cloth manufacturers,' which evidently, to my mind, shows that the word 'Linoleum' is not a word confined to the particular manufacture of the plaintiffs. No man, I imagine, of the name of Smith would think of registering himself as the maker of Smith's soap (or whatever it may be) when he was a general soap manufacturer."

In this case it will be seen that there was a Trade Mark registered, but there was no imitation of it as a whole, simply the word "Linoleum" was taken, and which the acts of the owners themselves had made public property.

If the registration of a name affects the principle.

It is admitted by Mr Sebastian in his treatise, that "the registration as a Trade Mark of a name of this description will somewhat complicate the question, as registration of a Trade Mark is *prima facie* evidence, and after five years' registration, conclusive evidence of the right of the registered owner to the exclusive use of such Trade Mark. But the wording of the Act is entirely directed to the registration of a Trade Mark, the exclusive use

of a Trade Mark, &c., and since a name which has become *publici juris*, whether registered or not, cannot be a Trade Mark within the definition section of the Act, because it contains nothing distinctive, it seems that, at all events within the five years, this enactment does not preclude a defence on the ground that the name so registered is in fact no Trade Mark, and was registered or is continued on the Register by error."

The same learned author then refers to the remarks of Lord Justice Mellish in *Ford* v. *Forster*, which he thinks appear to be equally applicable since the Act as before. "There is no doubt, I think, that a word which was originally a Trade Mark, to the exclusive use of which a particular trader, or his successors in trade, may have been entitled, may subsequently become *publici juris*, as in the case which has been instanced of Harvey's Sauce. Then what is the test by which a decision is to be arrived at, when a word which was originally a Trade Mark has become *publici juris?* I think the test must be, whether the use of it by other persons is still calculated to deceive the public; whether it may still have the effect of inducing the public to buy goods not made by the original owner of the Trade Mark, as if they were his goods. If the mark has come to be so public and in such universal use that nobody can be deceived by the use of it, or can be induced from the use of it to believe that he is buying the goods of the original trader, it appears to me, however hard to some extent it may appear on the trader, yet practically, as the right to a Trade Mark is simply a right to prevent a trader from being

cheated by other person's goods being sold as his goods through the fraudulent use of the Trade Mark, the right to the Trade Mark must be gone."

As the question will probably in the future become one of the greatest importance to persons who may find themselves in the position indicated, and the text writer has ventured to imagine a state of things which would lead to great loss and injury, the writer with great deference submits that the test laid down with so much clearness by Lord Justice Mellish may be read to mean quite the reverse to that which Mr Sebastian imagines.

Lord Justice Mellish was referring to the case of Harvey's Sauce, which words from the neglect of the proprietors, or some other reason, *had* become open to anyone to use, but owing to the existence of a patent, the name of a patented article is not *publici juris.* It appears to be assuming the very point in question, to say that the name would become so immediately on the expiration of the patent, in spite of its registration. If immediately a patent has expired, we will suppose for an article of food or medicine, a name of world-wide reputation, which has been registered as a Trade Mark by a particular trader, and has attained an immense reputation and sale, by the expenditure of large sums of money in advertising, is taken by one or more persons, it is difficult to see why such a case would not fall within the test laid down by Lord Justice Mellish, "the use of it by other persons is calculated to deceive the public." It would have the effect of inducing the public to buy goods not made by the original owner of the Trade Mark, as

if they were his goods. It has not become *publici juris* viewed by this test.

However the important question may be hereafter settled by authority,—for it will inevitably arise,—it may be pointed out that although a name applied to a patented article may become public property on the expiration of a patent, it does not follow that a distinctive label, or a device, applied to a machine, or on the covering in which an article is enclosed, and which has been registered under the Registration Acts, should become public property.

There is ample authority to establish this proposition from an early date, and one may be cited which, coming as it does from an eminent Judge (V.-C. Wood, afterwards Lord Hatherley) must be looked upon with great respect.

Tayler's Patent Solid-Headed Pins.

The plaintiffs were the successors in business of the original patentees of "Tayler & Company's" patent solid-headed pins, in packets labelled similar to the plaintiffs', with the addition of their name. An injunction was granted to restrain the use of the label, but it was said that the defendants could not be absolutely restrained from representing that the pins were made according to Tayler's expired patent, but that they must not do so in such a way as to deceive. V.-C. Wood said: "It was said that when a patent expired, it was open to the public at large to adopt the description of the article by which it had become known to the world, and to use the label by which the article made by the plaintiffs had been theretofore distinguished. It does not however follow, because upon the expiration of the patent the article and known description became open to all, that, therefore, all would be

entitled to use the label by which the patentees had been accustomed to distinguish their goods. The public may have acquired confidence in that particular label, and that confidence may have given a value to it, which the patentees may be entitled to have protected after the expiration of the patent."

It is perfectly clear from the observations of V.-C. Wood in that case, from those of Sir George Jessel, in the *Singer* v. *Wheeler & Wilson* case, and those of Mr J. Fry in the Linoleum case, that although a name given to a patented article, and by which alone the thing came to be called, after the expiration of a patent may become public property, yet a specific label or Trade Mark used on or in connection with the goods must be respected.

The practical result, therefore, which can be gathered from the cases, and the judgments of the learned Judges, is that persons should be careful to adopt some specific Trade Mark, in addition to a name, so as to be able to continue to reap the benefit of the reputation given to an article, and which really and justly belongs to the original manufacturer or patentee.

CHAPTER XII.

SHEFFIELD MARKS.

THE rights and privileges of the Cutlers Company of Sheffield are so well known to those interested, that it will only be necessary to remark that the important privileges, which are the subject of five Acts of Parliament (the 21st James I., c. 31; 31st George III., c. 58; 41st George III., c. 97; 54th George III., c. 119; and 23rd Victoria, c. 93), are unaffected by the Trade Marks Registration Acts, but the latest Act, that of 1888, affords particular privileges to persons engaged in the Sheffield trade connected with metal goods.

The Cutlers Company is to keep at Sheffield a new Register, called the Sheffield Register, and in this Register (in respect of metal goods, which will be explained further on) all the Trade Marks entered before the 1st January 1889, either in the Register established under "The Trade Marks Act, 1875," or the subsequent Registers, belonging to persons carrying on business in Hallamshire, or within six miles thereof, are to be entered.

The Cutlers Company is also, on the request made in the prescribed manner, to enter in the Sheffield Register, in respect of metal goods, all the Trade Marks which have been assigned by the Cutlers Company, and actually used before the 1st

January 1884, but which have not been entered in either of the other Registers.

An application for registration of a Trade Mark used on metal goods shall be made to the Cutlers Company, and the application is to be notified to the Comptroller, who within *one month* from the date of the receipt by him of the notice from the Company of the application, may give notice that he objects to the acceptance of the application; otherwise it is to be proceeded with by the Cutlers' Company.

If the Comptroller gives notice of objection, the application is not to be proceeded with by the Cutlers Company, but any persons aggrieved may appeal to the Court.

Upon the registration of the Trade Mark in the Sheffield Register, the Company is to give notice to the Comptroller, who enters the mark in the Register of Trade Marks, bearing the same date as the date of application to the Cutlers Company.

All the provisions of the Act, and the rules relating to the registration of Trade Marks, apply to the registration of Trade Marks on metal goods by the Cutlers Company, subject to some special provisions, which affect only the holders of Sheffield marks.

When the Comptroller receives from a person not carrying on business in Hallamshire, or within six miles thereof, an application for registration of metal goods, he is to notify the application, and the proceedings therein, to the Cutlers Company, by sending a notice or official paper, with a note distinguishing such application.

On the expiration of five years from the com-

mencement of the Act of 1883-88 the Cutlers Company is to close the Cutlers Company's Registration of corporate Trade Marks, and all marks entered therein, unless entered in the Sheffield Register, shall be deemed to be abandoned; so that it appears to be of great importance to Sheffield Trade Mark owners to look after their interests in this respect.

If a person is aggrieved by a decision of the Cutlers Company he can appeal to the Comptroller, who has power to confirm, reverse, or modify the decision; but this decision is subject to appeal to the Court.

It is important to notice that the expression "metal goods" means all metals, whether wrought, unwrought, or partly, and all goods composed wholly or partly of any metal.

CHAPTER XIII.

"THE MERCHANDISE MARKS ACT, 1887."

"THE Merchandise Marks Act, 1862," repealed by "The Merchandise Marks Act, 1887," was the first attempt of the Legislature to deal with the subject of Trade Marks.

For years previously, the forgery of Trade Marks and the false marking of merchandise had occupied the attention of commercial men and members of the Legislature, but it was not until 1860 that any active measures were taken to remove the evils which existed.

In 1860, and up to 1862, several Bills had been proposed, dealing both with the fraudulent marking of merchandise and the registration of Trade Marks.

In 1862, Bills dealing with both branches of the subject were introduced into the House of Commons, and referred to a Select Committee, composed of lawyers and mercantile men of great experience.

After the Committee had examined a large body of witnesses, a resolution was proposed and rejected, for adopting a system of registration of Trade Marks, but the other subject was dealt with, and became law by the passing of "The Merchandise Marks Act, 1862."

This Act made it a misdemeanour to forge or counterfeit any Trade Mark, or falsely apply any such Trade Mark, *with intent to defraud*, to any article, or to any wrapper, in which any goods were sold. The proof of an intent to defraud was thrown on the prosecutor, and in practice it was found difficult to work, inasmuch as unless the Trade Mark which was charged as a counterfeit was identical, or almost identical, with the prosecutor's Trade Mark, it was difficult to obtain a conviction.

"The Merchandise Marks Act, 1862."

Intent to defraud.

In some cases, however, it was found useful, and one of the early cases in 1871 was taken before Sir Robert Carden, at the Mansion House, and which was a prosecution at the instance of Messrs Goodall, Backhouse & Co., of Leeds, for using on sauce a counterfeit of their labels, on bottles containing their celebrated "Yorkshire Relish."

The Magistrate convicted the defendants, stating he was of opinion "that the defendants had been guilty of a most abominable fraud, and their conduct was very little better than picking a pocket. Here was an article that was regarded favourably by the public, and which enjoyed a good reputation, and the defendants had manufactured what he had a right to consider was an inferior article, and had used fraudulent labels, and palmed the article upon the public as the genuine 'Yorkshire Relish.' This proceeding was not only a fraud upon the public, but was calculated to inflict very serious mischief upon the proprietor of the genuine article."

In another case before Mr Chance, at the Lambeth Police Court, a conviction was secured

against a tobacconist for using a label on a wrapper for tobacco, consisting of the representation of a tobacco leaf, printed on a brown ground, and bearing the words "Chesnut Brown Virginia," being a counterfeit of a label on a wrapper belonging to another established tobacco manufacturer, consisting of a tobacco leaf in another position, bearing the words "Nut Brown."

Mr Chance said he "must give full protection to those who had a Trade Mark; the defendant evidently had the leaf upon the complainant's wrapper copied, although it was reversed, and persons might easily be deceived."

The old Act, however, being found to a great extent inoperative, and the false marking of goods having long occupied the attention of Foreign Governments, conferences were held, and, in the result, Bills were introduced into Parliament, and a Select Committee sat in 1887, collecting a large mass of evidence as to the use of fraudulent marks, from which it appeared that false trade descriptions were in extensive use; the outcome of which was the passing of the Act now about to be explained.

"Merchandise Marks Act, 1887." Forging a Trade Mark.

Forging a Trade Mark is a new expression, meaning the act of a person who, without the assent of the proprietor, makes that Trade Mark, or a mark so nearly resembling it as to be calculated to deceive.

Falsifying genuine Trade Mark.

It also means *falsifying* a genuine Trade Mark, whether by alteration, addition, or effacement, or otherwise.

Assent of the proprietor.

The defendant charged with these offences has to prove the assent of the proprietor, which entirely reverses the principal point of the Act of 1862,

which threw the evidence of proving "intent to defraud" on the prosecutor.

A person who falsely applies to goods, a trade, or any mark, so nearly resembling a Trade Mark as to be calculated to deceive, is also an offence under the Act.

Falsely applying TradeMark to goods.

So also is the act of a person who makes any die, block, machine, or other instrument for the purpose of forging, or being used for forging a Trade Mark.

Marking dies, blocks, &c.

He is also punishable if he disposes of, or has in his possession, any of these articles for such purpose, or causes any of these things to be done.

The person charged must prove that he acted without intent to defraud.

Onus on defendant to prove no intent to defraud.

The above offences comprise those which a person is directly supposed to commit.

Then there are the acts of those who put upon the market, or deal in, the result of the commission of the offences of the actual forger, namely, those who sell, or expose for, or have in their possession for sale, or any purpose of trade or manufacture, any goods or things to which a forged Trade Mark is applied, or to which any Trade Mark, or Mark so nearly resembling a Trade Mark, as to be calculated to deceive, is falsely applied.

Selling,&c., goods with forged Trade Mark.

These are also offences under the Act, punishable in the same manner as the act of a direct forger, but the person who is so charged with these minor offences may be liable to exonerate himself from the charges in divers ways.

He must prove, that having taken all reasonable precautions against committing one of these offences, he had no reason to suspect the genuineness of the

Defendant to prove his innocence.

Trade Mark, and he must prove that he gave all the information in his power, as to the persons from whom he obtained the goods, or the prosecutor, or someone on his behalf demanding the information.

He may prove that otherwise he had acted innocently.

The distinction between the acts of those who actually make a Trade Mark similar to one already in existence, or assists another, by making the blocks or dies for the purpose, and of those who sell an article bearing a false Trade Mark, is very just.

In the one case, it is impossible not to see that the genuine Trade Mark must have been before the person who makes counterfeit, or makes the blocks or dies from which it is to be printed or impressed on a label or wrapper, or on the article itself.

In the second case, a middleman, or general dealer, may be utterly ignorant of the existence of the original or genuine Trade Mark; he might have no reason to suspect he was selling an article being a counterfeit mark.

It is of course his duty to state from whom he obtained the goods, on being requested to do so; but it will be seen that it is not sufficient merely to give this information; he must also prove he had no reason to doubt the genuineness of the Trade Mark.

If he cannot prove these things, it is still open to the person charged to prove that he had otherwise acted innocently.

These words have received the judicial consideration of two eminent judges, the Lord Chief-Justice and Mr J. Matthews, in a case of an analogous

nature under the Act, and will be referred to when dealing with "The Bottle Question," and also in another case.

Punishment.

The punishment for these offences, on conviction, are severe ones: on indictment, two years' imprisonment, with or without hard labour, or a fine, or both; on summary conviction, four months' imprisonment, with or without hard labour, or a fine not exceeding £20.

If a second or subsequent conviction, six months, with or without hard labour, and a fine not exceeding £50.

There is an appeal open to the defendant to the Quarter Sessions, and if charged before a Court of summary jurisdiction, he may have the option of being tried on indictment. He is to be informed of this privilege before the charge is gone into.

Definition of Trade Mark registered under the Act of 1883.

There is no other definition of what a Trade Mark means, than that it is "a Trade Mark registered in the Register of Trade Marks kept under 'The Patents, Designs, and Trade Marks Act, 1883,' and as the registration of Trade Marks kept under the Act of 1875 is deemed part of the same book, Trade Marks registered under that Act (which is repealed) will be protected by "The Merchandise Marks Act, 1887." This Act, however, was passed before the Act of 1888, but doubtless the same protection will be afforded to Trade Marks registered under the Act of 1888.

Very important questions, however, would seem to arise, whether the mere fact of registration under the Acts will exclude a defendant, charged under "The Merchandise Marks Act," from raising any question as to the validity of Trade Marks already registered.

It does not appear whether a person criminally charged can take advantage of these privileges, or when or in what manner he can do so; but it would seem only reasonable, that he should be permitted to raise the question whether a Trade Mark registered should be on the Register, or be removed therefrom.

Definition of applying Trade Marks to goods.

A Trade Mark is deemed to be *applied* to goods when it is applied to the goods themselves, or to any covering, label, reel, or other thing, in or with which the goods are sold, or exposed for sale, trade, or manufacture.

Also, when a person places, encloses, or annexes any goods with any covering, label, reel, or other thing to which a Trade Mark has been applied.

When he uses a Trade Mark in a manner calculated to lead to the belief that the goods in connection with which the Trade Mark is used are designated or described by that Trade Mark.

Covering includes stopper, &c.

Covering includes a stopper, cask, bottle, vessel, box, cover, capsule, case, frame, or wrapper. Label includes any band or ticket.

A Trade Mark is deemed to be applied, whether woven, impressed, or otherwise worked into, annexed, or affixed to the goods, or to any covering, label, reel, or other thing.

Saving as to artificers, &c.

Persons are protected from punishment, who as artificers, or in the course of business, are employed by other persons to make dies, and blocks, and the like, and are not interested in the profits of the goods on which the false marks are placed, who prove their innocence, in like manner as it is open to a person who sells such articles to prove.

Such persons must give notice that they intend to

rely on this defence, otherwise they will be liable to pay the prosecutor's costs, although discharged from the prosecution.

Defendant may give evidence.

The Act allows a defendant to give evidence, and he or his wife may be sworn, and examined, and cross-examined, in like manner as other witnesses.

In reviewing the powers and liabilities of this important statute so far as it affects Trade Marks—the Act dealing also with the use of false trade descriptions—it will be seen in the first place, that the Magistrate or the Justices on a summary proceeding, or the Court and a Jury on indictment, will have to decide, in the case of a mark which is not identical, the same questions which arise before Judges of the Chancery Division of the High Court, whether the Trade Mark in dispute so nearly resembles the genuine Trade Mark as to be calculated to deceive.

It would therefore seem that the prosecutor should be provided with the same evidence as if he were applying for an injunction to the High Court, and the Magistrate, Justices, or Court and Jury must be satisfied in the same way, and on the same principles, and which have been fully explained in preceding chapters.

Seeing, however, that a person may be restrained by injunction from using an objectionable Trade Mark on other grounds than those implying a fraudulent intention, it would appear that a defendant may, under the saving clauses, open up any of the same defences which would be open to him in the High Court, or when the civil remedy is sought, and it will be strange if he is not able to

contest the validity of the mark in the cases put of a common mark being registered, of a descriptive mark, or one which should never have been registered at all, and the other numerous cases which have been referred to.

The Act is undoubtedly a very severe one, as it affects Trade Marks, and it can only be said that a Trade Mark owner will only be advised to proceed under the Act in very clear cases, otherwise a great deal of useless expense will be incurred, together with much waste of time and annoyance.

The Act deals also in the same manner with regard to the false marking of goods, but the subject is not germane to that of Trade Marks.

CHAPTER XIV.

THE BOTTLE QUESTION.

For many years persons engaged in the mineral water trade, or the sauce trade, or any other industry requiring the use of bottles for the sale of their goods, have been troubled and injured by the fact that their bottles have been bought up by others, and filled with their mineral waters or sauces, and the like.

The bottles have borne the labels, and sometimes the names and place of business of the original manufacturers, and it is very evident that a good deal of deception and damage may have been caused by this practice.

Attempts have been made to induce the Court of Chancery to interfere, but there have been decisions to the effect that a manufacturer who disposes of a bottle of soda water or a bottle of sauce has no right of property in the bottle itself, although probably if used fraudulently, and for the purpose of illegally passing off goods, an injunction might have been obtained.

Several attempts were made, and particularly by the mineral water industry, to invoke the aid of the criminal law, but in many instances magistrates gave conflicting decisions, and what was earnestly required was an authoritative expression of opinion from a higher Court.

At length it may be said that the question has been finally settled by the case of *Wood* v. *Burgess*, decided by Lord Justice Coleridge and Mr Justice Matthews, sitting as the Divisional Court of the Court of Queen's Bench, under "The Merchandise Marks Act, 1887."

Wood v. *Burgess* case.

The prosecutor, Thomas Wood, was a mineral water manufacturer, carrying on business at 430 Hackney Road. The defendant was also carrying on business as an aerated water manufacturer at Brick Lane, Spitalfields.

The prosecutor used glass bottles, some of which had moulded on them the words following, "This Bottle is the property of Thomas Wood, 430 Hackney Road; no deposit charged," while others had moulded in them the words, "T. Wood, 430 Hackney Road."

The defendant sold his mineral water in the prosecutor's bottles, marked as above mentioned, and having, at the bottom of each bottle, a paper label bearing the name of the defendant in the following form, "Burgess, Lemon, 215 Brick Lane, Bethnal Green Road."

The prosecutor instituted proceedings under "The Merchandise Marks Act, 1887," alleging that the defendant had applied a false trade description under the Act. It was proved before the Magistrate that the prosecutor had given no authority for the use of the bottles, and the defendant had been warned that the use of other persons' bottles would render him liable to be proceeded against. The defendant admitted that he gave no directions and took no steps to prevent the bottles of other persons being filled and sent out to his customers.

It was contended for the prosecutor that the defendant had not "acted innocently" within the meaning of the statute, whilst the defendant contended that the circumstances showed he had no intent to defraud.

The Magistrate dismissed the summons on the ground that an intent to defraud was a necessary ingredient in the offence, and that there was no intent to defraud.

A case was stated for the opinion of the Court of Queen's Bench, and at the request of the Judges, the Magistrate stated he found that there was a false trade description within the meaning of Section 3, Sub-section 3 of the Act, and that it was false in this respect that the name and initials of the prosecutor were applied to goods which had not been manufactured by him, the prosecutor not having authorised the use of such name and initials.

The case was argued before the Judges above named, and thoroughly argued out, when their Lordships decided that as the Magistrates had found that it was a false description, and that it was an application of the false description not merely to the bottles, but to what is in the bottles—that is, to the manufacture, and that it came distinctly within the third sub-section of the third section. The case was remitted to the Magistrate, with the opinion of the Court that he ought to have convicted.

This case is supposed to have entirely settled the question, and many prosecutions have been instituted and defendants convicted on the faith of it.

A prosecution was instituted under the Trade Mark sections of the Act, as well as the false trade description sections, by Messrs Goodall, Backhouse

& Co., against a sauce manufacturer, under these circumstances.

The prosecutor sold their "Celebrated Yorkshire Relish" in bottles bearing their registered label, and also having moulded in the bottles the words "Yorkshire Relish" round the shoulder, and their name, "Goodall, Backhouse & Co., Leeds," up the side of the bottle; a separately registered Trade Mark, the willow pattern plate, was moulded into the bottom of some of the bottles.

The defendant obtained the prosecutor's bottles so marked from marine store dealers, and placed therein his sauce, to which were affixed a label bearing the words, "Worcestershire Sauce," and other printed matter, with his name and address.

It was contended, on the part of the defendant, that it was the custom of the trade for the manufacturers of cheap sauces to use other firms' bottles, but the learned Magistrate said that if this was so, then it was in his opinion a dishonest thing to do.

Ultimately Mr Montague Williams (the Magistrate) said that he had no doubt there was a clear case of false Trade Mark, and under the Act there was no necessity for it to be shown that there was a fraudulent intention, but if he was called on to decide in cases where bottles belonging to a well-known firm with their Trade Marks were used by other manufacturers to put in their own stuff, which in some cases might only be filth put in, he should hold that there was an intention of fraud, and in such a case he should not deal with the case himself, but send it for trial.

The defendant pleaded guilty, and an undertaking was given not to repeat the offence.

CHAPTER XV.

REGISTRATION AND PROTECTION OF TRADE MARKS ABROAD.

BRITISH Trade Marks can be registered now in nearly every country of Europe, as well as in the United States of America, the Australian Colonies, and some of the British Colonies, also in Canada and the Cape, the Spanish Colonies, and South American Republics, such as Argentine Republic and Uruguay.

It would be out of place here, and serve no useful purpose, to specify the exact steps, and under what forms of legalisation or otherwise registration can be effected in each of the countries above referred to, as no Trade Mark owner would attempt registration of his own mark without the assistance of a competent adviser.

It may be useful, however, to observe that in many countries abroad application must be accompanied by a certificate of the registration in England of the Trade Mark required to be registered abroad, and great care should be taken to see that the representation of the Trade Mark, which must accompany the application, corresponds exactly with the registered mark in England, which appears in the *Trade Marks Journal*, and a copy of which is affixed to the certificate of registration.

Treaties with Foreign Powers.

There are many treaties between Great Britain and foreign Powers, some of them dating many years back, providing for the same protection in their respective territories for British subjects as enjoyed by native subjects, but always provided that the person claiming protection shall have complied with the formalities as to depositing or registration of Trade Marks in force in the different countries where protection is sought.

The treaty with Austro-Hungary dates from 1876; Belgium, 1862; Columbia, 1866; Denmark, 1879; Equator, 1880; France, 1882; Germany, 1875; Italy, 1883; Montenegro, 1882; Portugal, 1880; Roumania, 1880; Russia, 1859; Servia, 1880; Spain, 1875; Switzerland, 1880; United States, 1877; Uruguay, 1885.

In 1883 the important Convention for the protection of industrial property was signed, and ratified in 1884, whereby the Governments of Belgium, Brazil, Spain, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland constituted themselves into a union for the protection of industrial property.

In 1884 the British Government joined the Convention, two of the States—Tunis and Ecuador—having previously joined; and there are also included San Domingo, United States of America, and Paraguay. It is believed that Ecuador and Salvador have since seceded, and Sweden, Norway, and the Dominican Republic have joined.

This Convention affords to the subjects or citizens of each State the same advantages as regards Trade Marks and Trade Names that their respective laws now grant, or shall hereafter grant, to their own

subjects or citizens; consequently they have the same protection and the same legal remedy against any infringement of their rights, but they must observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each State.

Any person who has duly applied for a Trade Mark in one of the contracting States enjoys, as regards registration in the other States, a right of priority during three months after application.

There is in the Convention what has been felt to be rather a curious privilege for the subjects of the contracting parties, to the effect that every Trade Mark "duly registered in the country of origin" is to be admitted for registration and protected in the form originally registered in all the other countries of the Union.

This is further explained by the Final Protocol, so that apparently there should be no mistake about the matter, as follows:—

"Paragraph 1 of article 6 is to be understood as meaning that no Trade Mark shall be excluded from protection in any State of the Union, from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislature of that State; provided that on this point it complies with the legislation of the country of origin, and that it had been properly registered in said country of origin."

The question has arisen whether this means that any Trade Mark which has been registered in any of the countries, parties to the Convention, and which is valid in such countries, can be registered in the other countries, whether such Trade Mark is valid

according to the law of the country in which registration is required, or is not considered registerable.

In the case of the Californian Fig Syrup Company's Trade Mark, it was shown that the Company had registered in America, in 1885, the words "Syrup of Figs." In 1888 the Company applied to the Comptroller of Trade Marks to register the mark under the provision of Section 103 of the Trade Marks Act of 1883-1888, and of the International Convention, but it was refused.

The Company appealed, and Mr Justice Stirling decided that upon the pure construction of the provision, without expressing any opinion as to how far that provision extended, or from what liabilities it emancipated a foreigner, it was simply a qualification of the preceding part of the clause, and did not give an independent or new right of registration under the Act, and the Company not having made their application within four months from their applying for their Trade Mark in the United States, the application failed.

There is a decision on this point before Mr Justice Kay, *re* Vignier's Trade Mark, relating to "Monobrut" champagne. The word had been registered in France in 1884.

It was a motion to rectify the Register by expunging the word, and Mr Justice Kay, in complying with the application, said that the word was descriptive, and therefore could not be registered in England, and that the fact that it had been registered in France made no difference. His Lordship said: "The right thing to do was before those four months (the time limited by the Con-

vention) had expired, to apply to expunge it from the Register, and then to make an application within four months to have it put on the Register in consequence of the Convention."

There is, therefore, no decision as to what would be done in the case above suggested,—if a Trade Mark is not valid here, will the fact of registration abroad make any difference? and *vice versa* in foreign countries, and Trade Mark owners would do well to take competent advice before incurring expense in cases of the like nature, and to ascertain the practice in foreign countries on the subject.

There is an important clause in the Convention, to the effect that a Trade Name is to be protected in all the countries of the Union, without necessity of registration, whether it forms part of a Trade Mark or not.

It will be seen that Russia, Germany, Austria, Austro-Hungary, Turkey, and many other countries have not joined in this Convention; but nevertheless, British Trade Marks can be freely registered in such countries, and a British subject can avail himself of their laws against infringement of his Trade Marks, but the laws of some of these countries are not quite in accordance with the law of England as administered by the Courts in some respects. It may therefore be useful to state how some of these countries deal with infringements of Trade Marks, or imitation of packing, and the like.

FRANCE.

In this country the same principles appear to hold good with respect to a colourable imitation of

a Trade Mark, as guide our Courts in coming to a decision ; but, of course, their decision is based upon the circumstances of each case.

In an important judgment of the Court of Appeal of Bordeaux with reference to two conflicting labels, the Court stated that the principles relating to such a mark were well settled, namely, that an imitation is considered fraudulent if the aspect and general appearance of the whole label constituting the Trade Mark, in spite of dissimilarities, are of a nature to produce confusion, and to deceive a buyer.

The French Courts also take the same view as the English Courts as to the improper use of the name of an existing firm by a person of the same name.

This was well exemplified in the case of *Louis Roederer & Company* v. *Theophile Roederer* in 1865. The plaintiff, the well-known champagne grower of Rheims, complained of the defendant's use of the surname of the head of their house to their prejudice.

The Tribunal of Commerce of Rheims gave the plaintiff relief, but it was not considered sufficient by Messrs Roederer, who appealed to the Supreme Court, when they ordered the defendant to print his Christian name, "Theophile," in full, and in characters of the same dimensions as the surname. He was also to insert in his business announcements the date of the founding of his establishments, and that the order should be inserted in the public newspapers at the expense of the defendant.

The "Chartreuse" case related also to a "label," beside "name," the defendant alleging that his liqueurs were the same as those of the original

manufacturer, and he alleged that having discovered the secret of making them, he must necessarily call them by the same name; but he had made a considerable alteration in the title of the article, and put his own address. The Court refused to listen to these arguments, but ordered the confiscation of all the liqueurs, and the destruction of the false labels, with other punishments.

The French law also takes cognisance of the act of a person who puts up his goods in the same way as another trader for the purpose of passing off his goods as those of the other trader, irrespective of Trade Mark. The action in France is called an action for "*concurrence de loyale,*" similar to the action which was taken in the case of *Lever* v. *Goodwin* for the imitation of the Sunlight Soap wrapper, before Mr Justice Chitty and the Court of Appeal.*

There can be no question that in France, as in America, the most perfect system of jurisprudence prevails, by which complete justice can be obtained in regard to all these commercial injuries.

Trade Marks in France are called "Marques de Fabrique," and also "Marques de Commerce;" and it appears that the English words "Trade Mark" are coming into use.

GERMANY.

The German Trade Mark law was passed in 1874, a certain date being fixed for the registration of Trade Marks, and there was a great rush to register before the time had expired.

* See p. 118.

It is feared that notwithstanding the publicity given to the announcement of the passing of the Act, when it came into operation very great negligence was displayed by British Trade Mark owners, whose marks were of great value, in applying for registration, and this accounts a good deal for the apparent hardship which has been inflicted on some of them by the prior registration in Germany of valuable English marks.

The German law provided for the registration of foreign marks, but proof was to be given that all conditions had been fulfilled in the foreign country, and that the person desiring to register could claim protection in his own country for his Trade Mark.

This was done when the Act was first in operation by means of forms which were prepared by the writer, and approved by an eminent German advocate, and were in use for some time, and by means of which the writer registered some hundreds of British Trade Marks. The practice is now satisfied by transmitting a certificate of the English registration.

The views which the German Courts take of an infringement case do not altogether tally with those adopted by the English Courts, as it appears that only a slight deviation from another mark will be sufficient to enable another person in Germany to adopt a similar mark.

This was the case with the well-known mark of Joseph Rodgers & Sons, Limited, consisting of a star and cross, one of the Courts allowing a German subject to take two crosses; and in another case, merely a transposition of the cross and star—in the one case parallel, in the other per-

pendicular—was sufficient to make the two marks distinct.

The Act of 1874, however, provides that the protection accorded by the provisions of that law to the owner of a Trade Mark, name, or a signature, will not be invalidated in case such Trade Mark, name, or signature should be reproduced with such alterations as only a close and accurate examination could detect.

In an important case that was decided in Germany in 1876, a British firm obtained substantial justice. This was the case of Messrs Tennent of Glasgow, the well-known brewers, against a German firm, Messrs Deetjen & Schröder, brewers, of Hamburg.

Messrs J. & R. Tennent claimed an injunction to restrain Deetjen & Schröder from using Tennent's mark, consisting of the letter T on a label for beer, and to have defendants' registration of the mark cancelled.

It appeared that in 1864 the plaintiffs tried to prevent defendants from using their mark, which they were then unable to do, and for thirteen years defendants had been using Tennent's mark, consisting of a facsimile of their label.

When the law of 1874 was passed, both parties registered the marks, whereupon Tennent took proceedings. One Court in Hamburg decided in favour of the plaintiffs; this was reversed by the High Court of Hamburg, and ultimately, on appeal to the Imperial Court at Leipzig, the decision of the first Court was affirmed, on the ground that the defendants' original use of the label was fraudulent, and that no rights could accrue from a fraudulent user.

The case of *Clark* v. *The Dresden Sewing Machine Thread Company* is of a far less satisfactory nature, and lays down, one may venture to say, very unjust principles of Trade Mark Law.

Clark & Company of the Anchor Mills, Paisley, are a very old firm of manufacturers of sewing thread. Their Trade Mark was an anchor, which always appeared on their labels and wrappers, and was well known in Germany. They registered an anchor as their Trade Mark in Germany on the 1st May 1875, but did not register their labels.

The Dresden Company imitated the Trade Mark of an anchor, used on a compound label, very similar to Messrs Clark's, which the defendants had registered. Clark & Company adopted proceedings in Germany, to restrain the Dresden Company from using the label, and judgment was given in their favour. The defendants appealed, but the judgment was affirmed, and on the defendants again appealing to the Imperial Supreme Court, Leipzig, the decisions of these Courts were upset.

In the judgment of the Court of Appeal occurs this strange principle, laid down on the highest authority:

"In considering the question of identity, the whole combination must be taken into account; and if there is a substantial difference between the two labels, the owner of the one cannot restrain the owner of the other from using it. It is true that this construction permits one manufacturer to use the Trade Mark of another, if he only combines it with numbers, letters, or words, or alters the existing combination of numbers, letters, or words; but as long as there is a difference in the general

appearance of the mark, such use, with such combination, is not illegal."

There was also another German decision in the case of *Ainsworth* v. *Knapp*, in the early stage of Trade Mark Registration in Germany, in 1877, where a German firm were held entitled to retain their use of an imitation of Messrs Ainsworth's well-known "Falcon" brand, on the ground of concurrent use, Knapp having adopted this Trade Mark in 1870, and had registered it in 1875, Ainsworth also having previously registered it.

The facts are very complicated, and it appears almost impossible to understand the reasons given by the learned German Judges for their judgment.

A great outcry was raised at the time, as Knapp had also registered two other well-known English Trade Marks, the "Anchor" of Messrs Clark of Paisley, and the "Goat's Head" of Messrs Jonas Brook & Brothers of Huddersfield.*

A very high Trade Mark authority in Germany referred to these decisions in an official report to the British Government. "In other cases it has been laid down by the same tribunal (The Imperial German Supreme Court of Commerce) that where an adopted design—say an anchor, or a goat's head, the marks of certain parties, have been adopted by other parties, but one figure surrounded by a certain ornament or inscription, which the other has not, that there is no such similarity as to prohibit the ornamented design. This decision may have a very lamentable consequence;

* It is understood that Messrs Brook succeeded in getting an apology from Knapp, and an undertaking not to use their Trade Mark for the future.

the peculiar mark introduces the commodity into the world, and the quality is represented by the anchor or goat's head. If there is an extra ornament or inscription, the various nations may not be able to understand or to examine the inscription, and all foreign nations and peoples are not acquainted with the same language. They will surely be led by the anchor or the goat's head, as that is the distinct well-known sign. It does not demand sharp reasoning to see that under such an appreciation of facts the salutary object of the Trade Mark Law is not only lost, but that by such an exposition of and application of the law, deceit is turned into law."

This was written ten years ago, but from recent experience it may be gathered that the views of the German Courts are not very different from what they were. It is still probable, however, that a great deal would depend upon the circumstances of each case, and that justice was done in the Tennent Case.

AMERICA.

The Act which regulates Trade Marks in America dates from 1870, and under this statute, amplified by the Convention, British subjects have the same rights as Americans to register their Trade Marks, and can obtain efficient protection from the American Courts in case of infringement.

There is, however, no definition of a Trade Mark in the American statute, except that it must be a lawful Trade Mark, according to the well-known principles laid down with the greatest lucidity and grasp of the subject by some eminent judges in a

number of leading cases. It may be first observed that there is no country recognising Trade Marks to identify goods in which the Courts of law show a more thorough appreciation of the proper principles on which a Trade Mark case should be grounded than are displayed in the judgments of some, it may be said of most, of the Judges before whom these cases have arisen. A large number of such cases are collected in Mr Rowland Cox's collection of Trade Mark Cases, published in 1871, and there is no better book on the subject than Brown's Treatise on Trade Marks.

The Act gave protection to Trade Names and Trade Labels, and by a subsequent Act of 1874 prints and labels are dealt with; in which "Label" is defined as a slip, or piece of paper, or other material, to be attached in any manner to manufactured articles, or to bottles, boxes, or packages containing them; and bearing an inscription (not a Trade Mark), as, for example, the name of the manufacturer, the place of manufacture, the quality of goods, directions for use, &c.

The definitions of a Trade Mark given by Mr Brown, Mr Coddington, and Mr Upton have already been quoted; and from which it appears that distinctiveness is one of the principal features of an American Trade Mark, and Mr Brown sums up the essentials of a Trade Mark as, *individuality*, *universality*, and *exclusiveness*. Unless they all concur, there can be no Trade Mark.

English Trade Mark owners have obtained from the American Law Courts efficient protection, even in cases before the Trade Mark Act was passed.

Messrs Gillott, the celebrated pen makers of

Birmingham, for many years used on steel pens of their manufacture the arbitrarily selected numerals, "303," with their name, "Joseph Gillott. Extra Fine." The pen was in great demand in America, and became known to stationers and other dealers by its number, "303," which distinguished it from other pens of the plaintiffs' make. No other pen was then known to have numerals upon it.

The defendant in the action was a firm of "Esterbrook & Company," and they manufactured in America, and sold, a pen which in size, colour, pattern, flexibility, and fineness of point, closely resembled Gillott's pen. Esterbrook also impressed on his pen the number "303," with his firm's name and the words "Extra Fine," and put up the pens in boxes of the same size as the plaintiffs', with a similar label, and in other respects the whole arrangement was cunningly adapted to mislead.

One of the learned Judges, in giving judgment, said: "The design to defraud, by manufacturing and packing pens in all respects similar to the plaintiffs', excepting only in the use of the name, appears very plainly. I cannot reason so artificially as to disguise this conclusion from myself."

One of the other Judges said: "It is not necessary for the plaintiff, in order to receive the protection of the Court, that he show that his whole Trade Mark has been pirated or simulated. A false impression can as well be conveyed to the mind of the public, and especially to the memory, by a partial, or by a total counterfeit. The design to defraud may be as apparent, and is generally more injurious, in the partial than in the entire imitation."

The defendants in fact sold their merchandise as

that of the plaintiffs' manufacture, so that there is another illustration how the same principles which are in vogue in England prevail in America and France.

HOLLAND.

This country will be next referred to, as it appears that, notwithstanding there is a complete law for the registration of Trade Marks, under which British Trade Marks can be registered, and a fraudulent infringement of a registered Trade Mark can be prevented, the law does not recognise an action against a person for imitating wrappers, or distinctive modes of packing goods, and it is feared that the principles which prevail in Germany also are impressed on the minds of the Dutch Judges, and that even a slight deviation from a registered mark will cause another Trade Mark to be considered a legitimate concurrent mark.

SPAIN.

It is feared that by the law of this country as respects Trade Marks, a similar Trade Mark may be used if it is not identical, thus assimilating the principles which regulate the view of their Judges on the subject of infringement to that of Germany and Holland, but probably the case which has led to this impression might have depended upon certain circumstances.

There is free registration of British Trade Marks, and there is no particular definition of a Trade Mark in their law, only that "any figure may be used as a Trade Mark except the arms, insignia, or decorations of Spain, or Trade Marks previously registered."

It is necessary to show that the mark is registered in England, and it does not appear that the authorities will recognise any special rights which accrue to a Trade Mark in England, if contrary to the Spanish procedure.

A very hard case arose soon after the passing of the English Act of 1875. An eminent firm of needle manufacturers of Redditch had registered in England their needle label, concurrently with two other needle manufacturers, according to the rules which were passed on the subject, when there had been concurrent user of similar Trade Marks in the same trade.

The firm's goods were largely purchased in Spain, and bore a great reputation, but when they applied to register there, it appeared that one of the other firms who had registered in England their concurrent label had obtained registration in Spain, whose officials refused registration of the old established label of the other manufacturer, on the ground that they could not register a Trade Mark which had been previously registered.

This was certainly before the Convention of 1883, and whether the Spanish authorities are now more amenable to reason the future will show.*

PORTUGAL.

The law was passed in 1883, and recognises the right of manufacturers and merchants to distinguish the various articles, &c., manufactured by them, or

* The writer communicated with the highest official authorities in Spain, pointing out the injustice of shutting out his client's label, and also sought the aid of the British authorities, but to no purpose; the Spanish authorities were inexorable.

in which they trade, by means of special and distinct Trade Marks, and to have them registered.

Any marks used to distinguish any manufacture or article of trade are *Trade Marks*, such as any special names, or designation, marks, emblems, seals, stamps, edgings, drawings, relievos, letters, and signatures of persons.

Mere words, letters, or numeral figures, unaccompanied by any distinguishing characteristic, are not Trade Marks. No person can appropriate a Trade Mark already used by another person, or which may be mistaken for it.

The rules and regulations contained in the law of Portugal are extremely full, and give the most efficient remedies against piracy of Trade Marks, and it is conceived that foreign manufacturers and merchants out of Portugal enjoy the same rights and guarantees as are accorded by the law of their respective countries to Portuguese subjects.

AUSTRIA.

In this country the previous registration of Trade Marks in the United Kingdom is not necessary. In particular cases, however, such a previous registration is required, and must be proved. This is the case in regard to wrappers and labels which are not distinctive, and are not considered Trade Marks in Austria. It is possible to obtain, in certain cases, the registration of such a wrapper or label, if it has been registered in England.

Trade Marks intended for use in Austria should be at once registered, to avoid fraudulent adverse registrations, which would prevent the legitimate

owner from obtaining the protection which he might afterwards be desirous to obtain.

Infringements.—It is considered an imitation if the marks cannot be distinguished without more than ordinary attention.

Every encroachment on the right to a mark gives the injured party the right to insist on its stoppage, and claims for compensation are decided according to the civil law.

Besides the protection of marks, so called, the law protects from an illegal appropriation of the names, style, arms, or the special designation of an inland trader.

The procedure and decision respecting encroachments belong to the political administrative authorities of first instance, and the same authorities also decide disputes respecting the right in marks, the priority and transfer thereof, and questions as to the identity of marks.

A very useful provision in the Austrian law is to the effect that whenever the question of an encroachment rests on the comparison of two marks, the authority is to obtain a report from unprejudiced professional persons, and when the report is received, the parties are to be present, and may be heard with any explanations and objections.

ITALY.

A very liberal construction of the rights of foreigners prevails here, so that all Trade Marks already put into use, according to law in foreign countries, are recognised and guaranteed in Italy, provided that the foreigners observe the regulations laid down for natives.

The regulations consist in depositing the mark in Italy, according to the formula in vogue there, and obeying their rules as to production of evidence of the right of registration in the foreign country.

Recourse is had to the Court Tribunals in case of infringement of Trade Marks, and it is absolutely necessary that the Trade Mark in regard to which redress is sought should have been duly registered.

RUSSIA.

British Trade Marks are registerable in Russia, but it has been seen that this country is not a party to the Convention, and therefore the Trade Mark must comply with the law of Russia. There is no definition of a Trade Mark in the Russian law, but the remedy for infringement has been open to great question, and special care would seem to be required in dealing with such cases.

SWEDEN AND NORWAY.

A new law was passed in Sweden and Norway in 1884 for the registration of Trade Marks, and British Trade Marks can be registered there without anything more than the production of proof that the mark has been registered in the United Kingdom, the law giving him an exclusive right to use any special Trade Mark, that his products in the general market shall be distinguished from the products of other persons.

The Trade Mark is to be affixed on the product itself, or on the vessels or covers (packing) wherein it is contained.

Excluded from registration are Trade Marks consisting only of numeral characters, letters, or

words, which are not sufficiently distinguished by such a particular form that the mark will not be determined as a figurative mark, and it must not be a mark so similar to a previously registered mark, that notwithstanding the discrepancies in certain respects, the mark, on the whole, would be easily mistaken for the other.

The Swedish law contains also provisions for renewal and transfer of the mark, and for the punishment of persons infringing Trade Marks, and for deciding contests as to priority of adoption, and other useful and practical provisions, clearly evincing the care and knowledge of the subject with which the law was prepared.

SWITZERLAND.

The law for registration and protection of Trade Marks in Switzerland is of recent date, having been passed a few years since, previous to which there were Canton enactments, which gave some slight protection.

The law is now operative in Switzerland, and takes the place of these Canton enactments, and gives protection to foreigners, who must show their Trade Marks are protected in their own country.

Trade Marks must be clear and distinctive, and must not consist exclusively of figures, letters, single words, or the arms of a state or public body. The owner of a Trade Mark must not allow it to fall into disuse.

The Bureau Federal have the power to suggest to an applicant that his Trade Mark is not sufficiently distinctive, and this right they have exercised in several instances, causing much in-

convenience, but the difficulties raised have been surmounted.

It is important to note that the Swiss authorities construe the sixth article of the Convention of 1883 in a liberal sense. English marks registered in England can be registered in Switzerland, even if a Swiss mark of the same description could not be so registered. For instance, a single word cannot be registered according to the Swiss law, but according to the English law it is seen that it is, and consequently in Switzerland it can be registered, notwithstanding if it were a Swiss mark, registration would have been impossible. This is as it should be, and is a proof not only of the liberality of the Swiss lawyers, but also of their clear-sighted views of Trade Mark rights in general.

BRAZIL.

The law here protects the right of property in Trade Marks, but it must first be registered in Brazil, and previously registered in the United Kingdom.

The remedy for infringement is criminal as well as civil, the one insuring punishment by imprisonment and fine, and the other, compensation for losses caused by the forgery of the marks.

The definition is the same as in most other countries. It may consist of "the name of the manufacturer or merchant, in some distinctive form, of the name of the firm, or of any other denotation, emblem, stamp, seal, signet, stamped mark, relief, or wrapping of any kind, which may distinguish manufactured goods, or articles of trade."

In presenting marks for registration of a similar design by different individuals, the longest in existence, or, should all be new, the one first presented, is chosen.

TURKEY.

British Trade Marks can be registered, and it appears that British subjects can obtain efficient redress against piratical practices.

Messrs Jonas Brook & Co. of Huddersfield, the well-known sewing cotton manufacturers, whose "Goat's Head" brand was forged, with the exception that the name was printed "Brock" instead of "Brook." The defendants, Turkish subjects, said they were selling "Brock's thread," but they were found guilty of selling thread bearing falsely Brook's marks, and were fined and otherwise punished.

The Trade Mark must be duly registered before proceedings are commenced.

Definition of Trade Marks.—"The names, seals, signs, letters, wrappers, and other things stamped or impressed upon manufactured goods, and upon merchandise, for the purpose of publishing the place or name of the manufacturer or the name of the manufacturer and address of the trader who sells them, in fact all the sign and stamp marks intended for the purpose of distinction and speciality, are named Trade Marks."

DENMARK.

Law of April 1890.—Special Trade Marks intended to distinguish goods from those of others can be registered, and the marks are to be affixed

to the goods themselves, or to packing cases, wrappers, &c.

British subjects, by virtue of treaties and the Convention, can register their Trade Marks if conformable to the Danish law, and by this law the Trade Mark cannot consist exclusively of numbers, letters, or words which do not possess such a distinctive form as to qualify them to be considered figure marks; must not contain, without due warrant, another name or another firm than that of the applicant; must not contain statements which might give rise to offence; and must not be identical with a mark already registered, or submitted for registration, or bearing a strong resemblance, notwithstanding some variations, so that on the whole it could be easily confused.

Protection lasts ten years, and is renewable.

The law contains other most beneficial provisions respecting the assignment of marks and other details quite in conformity with the law which prevails in England, and also for the full protection of registered Trade Marks from infringement; and there can be little doubt the resource to this law in Denmark, in a proper case, would lead to satisfactory results.

There are special provisions relating to foreign marks, which leave no doubt that in Denmark at all events the special rights of British subjects whose marks are registered in England will receive protection.

AUSTRALIAN COLONIES.

The laws relating to the registration of Trade Marks in most of these Colonies approximate very

closely to "The Trade Marks Registration Act, 1875." British Trade Marks can be registered in New South Wales, Victoria, Queensland, South Australia, Tasmania, Western Australia, and New Zealand.

An experienced practitioner in Trade Mark law and registration states that it is possible in all the colonies for the Trade Mark of either an English or foreign proprietor, to be acquired by a stranger having no previous title thereto, virtually in fraud of the owner's rights, and instances have been known in which this has been done.

Priority of registration has sometimes given this right, and the imitation of an unregistered Trade Mark may have so rendered it *publici juris*, that the right to the public use of it becomes lost.

A suit is necessary to decide the question in the Colonies of South Australia and Tasmania.

It is therefore of the utmost importance that Trade Mark owners should register in any or all of the Colonies a Trade Mark which is of any value, and which it is intended to use upon goods exported to such Colonies.

New South Wales.—The definition in the statute in vogue is the same as the definition clause in "The Merchandise Marks Act, 1862," which has been before quoted, and in other respects it is very similar; and it also includes clauses for the registration of Trade Marks, making such registration compulsory before proceedings can be taken for infringement, but registration is not indefeasible in case of prior user.

Victoria.—The law here is a combination of "The Merchandise Marks Act, 1862," and "The Trade

Marks Registration Act, 1875," and the definition clause is the same and so are the rest of the provisions.

Queensland.—The law in force here is the same as the English "Patents, Designs, and Trade Marks Act, 1883-1888," with some trifling alteration as to the periods given for the payment of renewal fees, and extends the time for making application for a Trade Mark to six months instead of four, as in the 103rd and 104th Sections of the English Act.

South Australia.—The Act is the same as that for New South Wales, except that provisional certificates are granted, which continue in force twelve months, and the same can afterwards be made absolute.

Tasmania.—This also is the same as New South Wales, and also the same as to provisional protection.

There is also a similar Act in force to "The English Patents, Designs, and Trade Marks Act, 1883," and special protection is given to marks registered in the United Kingdom, if the application is made within four months of the application for protection in the United Kingdom; but there appears to be nothing to show whether the Trade Mark owner is entitled to any redress in case his Trade Mark is previously registered, if the limit of time has expired.

New Zealand.—The whole of the observations referring to registration in New South Wales, and the Acts in force there, relate to this colony.

Western Australia.—The Designs and Trade Marks Act of 1884 was the first enactment for the registration of Trade Marks passed for this

colony, and the Act is substantially the same as those portions of the English Act of 1883, which deal with Trade Marks and Designs, with certain exceptions, not necessary to be here set forth.

Infringement cases in Australia.

There can be no doubt that efficient justice can be obtained in the colony against a wrongdoer, and that the same principles which prevail in England and other enlightened countries pervade the minds of the judges in Australia, as appears from the following report of a case which was decided in the Supreme Court at Sydney in 1884.

Eno v. *Hogg.*

Mr Eno obtained an injunction to restrain one Hogg from selling an article which he called "Parisian Fruit Salt," which was charged as a fraudulent imitation of plaintiff's Trade Mark, registered in the colony in 1881.

Hogg alleged that "Fruit Salt" was merely descriptive, and incapable of registration, and that the term "Fruit Salt" being used in the colony in 1880, and before "Eno's Fruit Salt" was registered there, the plaintiff had no better right to it than any member of the public.

On appeal to the Supreme Court, it was contended that the term "Fruit Salt" had been common property there before it was registered, as Mr Eno had sent out Fruit Salt years before he registered it there, and the question was whether the word had not become *publici juris*, and several English cases were cited in support of this contention.

Against this contention a great number of English cases were cited, and it was shown that the evidence taken upon commission in England was to the effect, that the words were descriptive of nothing, and that a few sales could not make it *publici juris*.

The Chief Justice said that he did not know anything turned upon the point as to the registration of the plaintiff's Trade Mark in the colony, and that the Act in fact left the rights of the first user just where they were. His Lordship referred to the *Glenfield Starch* case, and to other cases, which he considered he was bound by, as the evidence did not show that there had been any extensive use of the defendant's preparation not having been sold for more than a year; and finally, he upheld the decision of the Court below, restraining the defendant. Mr Justice Faucett concurred in the judgment, and stated that there was overwhelming proof that the plaintiff had established his right to the use of his term "Fruit Salt" before the defendant adopted it; and the appeal was dismissed with costs.

Eno v. Davies.

Mr Eno succeeded also in another case, against an Australian firm, who were using the term, "Australian Fruit Salt," and a suit was instituted to take the registration off the file, and for an injunction.

In this case also it was proved that the defendant's mark was registered in the colony two months before the plaintiff's, but which had been advertised largely in the colony in 1877, and afterwards, and the trade had increased very rapidly up to 1881, but there had been a falling off in the business.

It is satisfactory to note that the English authorities on the subject of Trade Marks were referred to, and some of those which have been quoted in former portions of these pages, particularly *Worthington's Trade Mark* and *Seixo* v. *Provezende*, and other cases.

The Judge said he had no doubt that the case

came within the principle laid down in the cases which had been cited, wherein the Court enjoined a defendant not to continue the use of his Trade Mark, and the resemblance in the bottles, and in the printing on the wrappers, was so close, that he regretted he could not say it resulted from accident, or was consistent with innocence. He was also of opinion that when the defendant registered he must have obviously known that Eno's Fruit Salt was in the market, and that he had no more right to register than he had to sell; and ultimately he granted an injunction, also rectifying the Register by taking the defendant's Trade Mark off it.

There have been other cases at the suit of British subjects in which complete justice appears to have been done, the Courts acting under the decisions and upon the principles which have been set forth as those which regulate the practice of the Courts of law in injunction cases in England.

NON-EUROPEAN COUNTRIES.

There appear to be laws in some of the central American republics for the registration and protection of Trade Marks. In *Chili* such a law exists, and also in *Uruguay*, and in the *Argentine Republic*, and in *Venezuela*, and in *Fiji*.

In *Egypt* no law exists for the registration of Trade Marks, but several cases have occurred where the forgery of Trade Marks has been followed by the punishment of the offenders.

It appears that in *Peru* the country is "flooded with miserable imitations of English goods, manufactured in Germany, and bearing the Trade Marks of the best English houses. Even in *Lima* the

brewers openly affix the printed labels of the best English brewers on their bottles, and sell their inferior compounds with the name of Bass."

This was the report of our Minister at Lima some years ago to the Secretary of State for Foreign Affairs.

INDIA.

It is strange that there is no law for the Registration of Trade Marks in India, but large numbers of Trade Marks are deposited under the Indian Registration Act, 1877.

This in fact only operates as evidence of the deposit of the Trade Mark, and does not afford any protection, inasmuch as it is well known that gross imitations of important English Trade Marks have been so deposited.

The Indian Penal Code punishes infringements of Trade Marks if you can get at the people who are committing these offences, a thing very difficult in practice to accomplish.

CHINA—HONG-KONG.

Trade Marks can be registered in this colony.

The application is made to the Governor, and is sent out through the Home Office in England.

CANADA.

Trade Marks are registered here, and somewhat in the same mode, as is the practice with Australian marks.

The Canadian authorities will not always recognise marks which have been registered in the United Kingdom, as their definition of what a

Trade Mark should consist does not altogether tally with the English practice.

JAPAN.

The latest adherent to a system of Trade Mark registration is this country, by the passing of regulations, which came into operation on the 1st July 1889, and were promulgated the 18th December 1888.

These regulations are greatly needed in the interests of foreigners, as it appears from the Foreign Office report as far back as 1878, that "all kinds of Foreign Trade Marks are forged by Japanese;" but unfortunately it appears that British subjects cannot avail themselves of the beneficial provision of the regulations.

Trade Marks to be registerable in Japan should be composed of distinctive diagrams, or characters, or of both combined, as their essential parts.

No Trade Mark will be recognised which contains —1, A scandalous design. 2, The essential parts of which consist of a common designation of merchandise, or of a foreign or domestic national flag. 3, A mark closely resembling one already in use by another person for a similar article.

Protection lasts for twenty years, subject to renewals, and Trade Marks registered must be put into use within six months from date of registration, and not suspended for more than one year without proper reason, and there are some rather complicated provisions which must be attentively considered by registered owners whose merchandise circulate in Japan.

The same remarks apply to the rules regarding

the punishment for infringement of Trade Marks, seeing that a "full knowledge" must be shown on the part of the prosecution, that the infringing mark is that of another person.

There are other regulations which are quite original, and do not appear to prevail in any registration laws of any other country.

There can be no doubt that before long such an enlightened country will admit foreigners to the benefit of their law.

GENERAL SUMMARY.

It thus appears that nearly the whole of the civilized world (with the strange exception of British India) recognise the rights of a manufacturer to identify his goods by his own Trade Mark, and in some cases by his distinctive mode of putting up his goods for sale, and affords ample protection against infringement. Although in some cases. notably in Germany, injustice appears to have been done to some well-known English manufacturers, it is impossible to say in what manner these cases were submitted to the tribunals in question.

It may be safely concluded that the same principles must permeate the minds of the learned judges who have to decide difficult questions of similarity, and consequent deceit, as those which prevail in England, Australia, and America, and even in those countries there can be no question that success must mainly depend upon the nature of the case and the mode in which it is conducted to a conclusion.

INDEX.

	PAGE
Abandonment of opposition	62
Payment of costs by applicant . . .	62
Account of profits . .	85
Acquiescence . . .	70
Protection not sufficient to avoid . . .	,,
Mere lapse of time not sufficient to deprive plaintiffs of remedy .	111
Action for infringement of Trade Mark . . .	64
Addition to Trade Mark, Court's power to order .	55
Adoption of Trade Mark .	45
Advertising injunction .	90
Æilyton—Stephen's case .	18
Aldine Classics . . .	1
"Alpine," Descriptive word for embroidery . .	20
Alteration of Trade Mark by Court	55
American cases—The Dixon Crucible Company's case .	81
American definition of Trade Mark	3
American Leather Cloth Company's case . .	67
"Anatolia" for liquorice .	21
"Angostura Bitters" case .	117
Apollinaris Company's case .	11
Appeal to Board of Trade .	33
In opposition cases .	16
Statement of grounds .	,,
Time for lodging same .	,,
Notice of same . .	,,
Application for registration, Form of	37
Application for registration equivalent to public user	47
Autograph signature Trade Mark	4, 6
Australian Wine Importers case	40
Words calculated to deceive	,,
"Bank of England" Sealing Wax	52
Barlow *v.* Johnson . .	72
Essential particular taken	,,
Board of Trade—	
Appeal from Comptroller's decision . .	33
Bottle question . . .	161
Wood *v.* Burgess .	162
Yorkshire Relish case .	164
"Bovina" and Boviline .	33
"Braided Fixed Star" case	34
Brand as Trade Mark . .	4
Bryant & May's case . .	34
Calculated to deceive . .	108
Lord Cranworth's judgment in Seixo *v.* Provezende . . .	76
The "Two Elephants" case — Orr Ewing *v.* Johnston . . .	77
"Dog's Head" Beer case	,,
Ford's Eureka Shirt .	,,
Cancellation of entry on Register	55
"Cavite" for Manilla cigar	24
Not geographical . .	,,
Chancery remedy for infringement . . .	64
Christiansen's case . .	32
Clerical error in Trade Mark	55
Comptroller may correct	,,

PAGE

Colour 13
Label printed in different colours . . ,,
Important in infringement cases . . ,,
Colourable imitation . . 73
American case . . 82
Comptroller of Trade Marks 33
Functions discretionary ,,
Restriction as to registering identical Marks . 39
Having resemblance calculated to deceive . ,,
Hearing before . . 58
Common to the trade . . . 42
Three Mark Rule . . ,,
Common Law remedy for infringement . . 64
Consequential relief . . . 84
Convention 33
Counterstatement . . . 61
Court—
Determination of rights of parties . . . 39
Rectification of Register by 49
Costs—
No costs in opposition cases 62
When plaintiff deprived of 88
Criminal proceedings for infringement . . 64

Damages 85
Day & Martin's Blacking . 73
Defences on Infringement Case 70
Plaintiff aware of defendant's acts . . ,,
Defences 108
Defence of long user . 111
Plaintiff must know of same . . . . . ,,
Oakey *v.* Dalton — Mr Justice Chitty's judgment . . . . . ,,
Defendant may give evidence in criminal cases . 159
Delay in bringing action for infringement . . . .
Danger of delay after knowledge of . . . 76

PAGE

Delivery up of labels and wrappers 89
Descriptive words not Trade Marks 4
Descriptive word . . 21
Device as Trade Mark . . 4, 6
"Diamond Cast Steel" case 34, 96
Disclaimer by applicant for registration . . . 5, 9
"Dog and Porridge Pot" case 35
"Dome" Black Lead case . 29
"Dry Monopole." case . . 48
Dunn's Trade Mark . 40, 94

"Electric" 20
Descriptive word for velvet . . . . ,,
Edwards *v.* Dennis . . 34
Eno's "Fruit Salt" . . . 93
Essential particulars to be stated in application . 5
Evidence in opposition cases 60
By statutory declaration ,,
"Excelsior" for Soap . . 21

False representation in Trade Mark 98
Fancy words under the 1883 Act 19
Foreign registration—
English certificate—when required . . . 33
Series of Marks . . 38
English certificate required in some cases . 164
Treaties with Foreign Powers . . . 166
Convention of 1883 . ,,
English cases . . 168
America . . . 176
Australian Colonies . 187
Austria 181
Brazil 185
Canada 193
Denmark 186
France 169
Germany 171
Holland 179
Hong Kong 193
India . . . . . ,,
Italy 182

PAGE

Foreign registration—
Japan 194
Non-European countries 192
Norway 183
Portugal 180
Russia 183
Spain 180
Sweden 183
Switzerland 184
Fraudulent registration by agent 49
Fraudulent label, Tobacco Trade 100
Fraudulent use of name by person of same name . 127
Burgess's Essence of Anchovies . . . . ,,
Holloway's case . . 128
Freeman's Baking Powder 129
Warner's Safe Cure . 131
Tussaud's case . . 138
French definition of Trade Mark 3
"Fruit Salt" Baking Powder 40

Glenfield Starch case . . 25
"Gem" Air Gun case . . . 20
Geographical word not Trade Mark 4
German definition of Trade Mark 3

Harvey's Sauce 79
Heading as Trade Mark . 4, 6
Heidsick's Dry Monopole . 94
"Hole and corner" user by defendant 112
Hudson's case 45
First adoption of Mark . ,,

Infringement of Trade Mark 64
Fraud not essential ingredient 65
Lord Westbury's definition . . . . . ,,
Lord Cranworth's definition 66
American definition . ,,
Lord Kingsdown's definition . . . . . ,,
Infringement cases—
Lord Langdale's definition of imitation in Day *v.* Croft . . 73

PAGE

Injunction restraining infringement of Trade Mark 64
Interlocutory injunction . 69
When granted . . ,,
Motion for . . . ,,
Invalidity of plaintiff's Mark 92
Invented word or words as Trade Marks . . 4, 17, 21
Inspection of books on inquiry as to account of profits 87

Jelley, Son & Jones' case . 35

Kuhn's case 41

Label as Trade Mark . . 4, 6
Lamplough's "Pyretic Saline" 37
Leonardt's case . . . 41
As to Steel Pens . . ,,
Lever *v.* Goodwin . . 74
"Linoleum" case . . . 37

Manchester Cotton Marks . 42
Mark 4
Marks need not be identical in infringement cases . 72
Matters affecting right to sue 92
"Melrose" Hair Restorer . 20
Merchandise Marks Act, 1862 3
Merchandise Marks Act, 1887 4
Definition of Trade Mark ,,
Forging a Trade Mark . 154
Falsifying a Trade Mark ,,
Proving assent of proprietor . . . . ,,
Marking dies, blocks, &c. 155
Onus on defendant to prove no intent to defraud . . . . ,,
Selling, &c., goods with forged Trade Mark . ,,
Defendant to prove his innocence . . . . ,,
Punishment . . . 157
Definition of Trade Mark ,,
Applying Trade Marks to goods . . . 158
Covering includes stopper, &c. . . . . ,,
Saving as to artificers, &c. . . . . ,,

PAGE

Mode of putting up goods, imitation of . . . 116

Name of individual or firm . 7
Must be printed, impressed, or woven in distinctive manner . ,,
Name of an individual, &c., as Trade Mark . . . 46
Name become *publici juris* . 78
Name of defendant on goods no defence 112
Name of defendant on wrapper . . . . ,,
"Sunlight" Soap case, Mr Justice Chitty's judgment . . . ,,
Judgment of Court of Appeal . . . 113
Name of new article, whether *publici juris* if registered . 110
Name open to the public after expiration of patent 111
The Linoleum case . 12
Name applied to patented article 140
Singer case 141
"Linoleum" case . 142
Nature of registerable Trade Mark 6
Needle trade of Redditch . 43
New Mark not used before 13th August 1875 . . 6
Notice of opposition . . 58
What it must contain . 59
Form of . . . . ,,
Notice to infringer before commencing proceedings 89

Old Mark, one used before 13th August 1875 . . 6
"Original," used by person not first inventor . . 77
"Osman" Turkish towels . 72
Opposition to registration . 57
Orr Ewing *v.* Johnston . 71
"Two Elephant" case . ,,
Essential particulars taken . . . ,,

"Pain Killer," Perry Davis's case 48

PAGE

"Patents, Design, and Trade Marks Act, 1883-1888" . 4
"Patent," use of word when same expired . . . 98
Cheavin *v.* Walker . ,,
Person aggrieved . . 50
Lord Justice Fry's definition . . . . . ,,
Apollinaris case . . ,,
"Pessendede" for watches . 21
Pictorial representation of article not registerable as Trade Mark . . . 30
Procedure to obtain registration 36
Publici juris, name become 78, 144
Public user, Registration equivalent to . . . 44

Rectification of Register . Removal of Mark in what cases . . 48
Registration of Trade Mark 32
Equivalent to public user 44
Register of Trade Marks varied in different cases. . 54
"Registered"—
Improper use of word . 55
Penalty for . . . ,,
Remedies for infringement of Trade Marks . . 64
Removal from the Register, Summary of different grounds 53
Removal from Register of Trade Mark if common to the trade 110
Removal of Trade Mark from Register after five years . ,,
Removal of Trade Mark from Register 32
Re Whittaker *ex parte* Behrens . . . 92
Renewal of Trade Marks . 32
Rodgers *v.* Rottgen . . 74

"Satinine" for Starch . 23
Saving of special or distinctive words . . . 5
Scandalous designs not registerable . . . 39

PAGE

Series of Marks 37
Sheffield Marks — Special legislation 149
Spencer's case 34
Statements of goods on application as to old Mark . 37
"Steinberg" on Pianos . 74
Steinway *v.* Henshaw . . ,,
"Sunlight" Soap . . 19
"Sunlight" Soap Wrapper . 118
"Sunlight" Soap case — Account of profits . . 86

Ticket as Trade Mark . . 4, 17
Tobacco Trade—Label false statements . . . 100
American case—Lorin *v.* Palmer . . . 101
Newman *v.* Pinto . . 104
Wood *v.* Lambert . . 103
"Tovril" case . . . 73
Trade Mark—
What is a Trade Mark . 1
Ancient origin . . ,,
Definition of . . . 3
Essential particulars of . 4
Word applied to—Apollinaris case . . 11
Not registerable . . 28

PAGE

Trade Mark—
Must be actually applied to vendible articles . 30
Compulsory registration of 32
Lasts fourteen years with renewal . . ,,
Assignable only with good will . . . 38
Claimed by several persons 39
Registration by agent . 49
Removal from Register ,,
Infringement of . . 64
Not being used as registered . . . 113, 114
Trade Marks Journal—
Advertisement of application in . . . 38
"Two Elephant" case . . 71

"Valvoline" for Valve Oil . 21

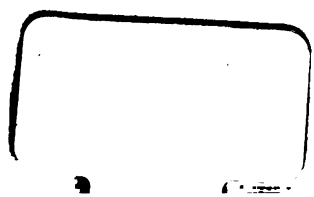
Words calculated to deceive 39
"Worcestershire" Sauce . 11
Worthington, *re, ex parte* Bass & Co. . . . 14
Wotherspoon *v.* Currie . 25

"Yorkshire Relish," Goodall, Backhouse & Co. . . 79

PRINTED BY
TURNBULL AND SPEARS,
EDINBURGH.

#1D

CL ASB DUt
Trade marks :
Stanford Law Library
3 6105 044 176 217



x5.